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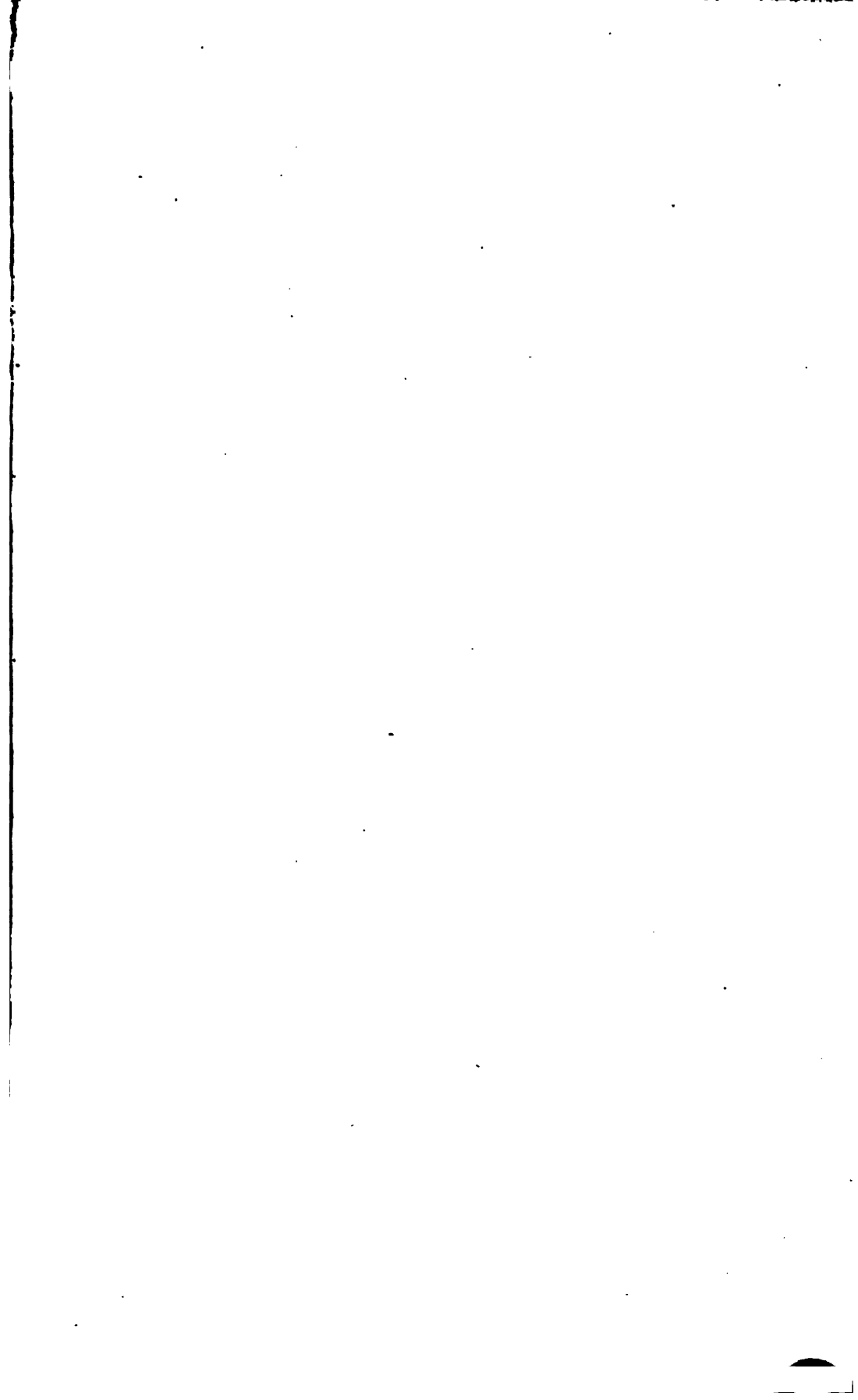
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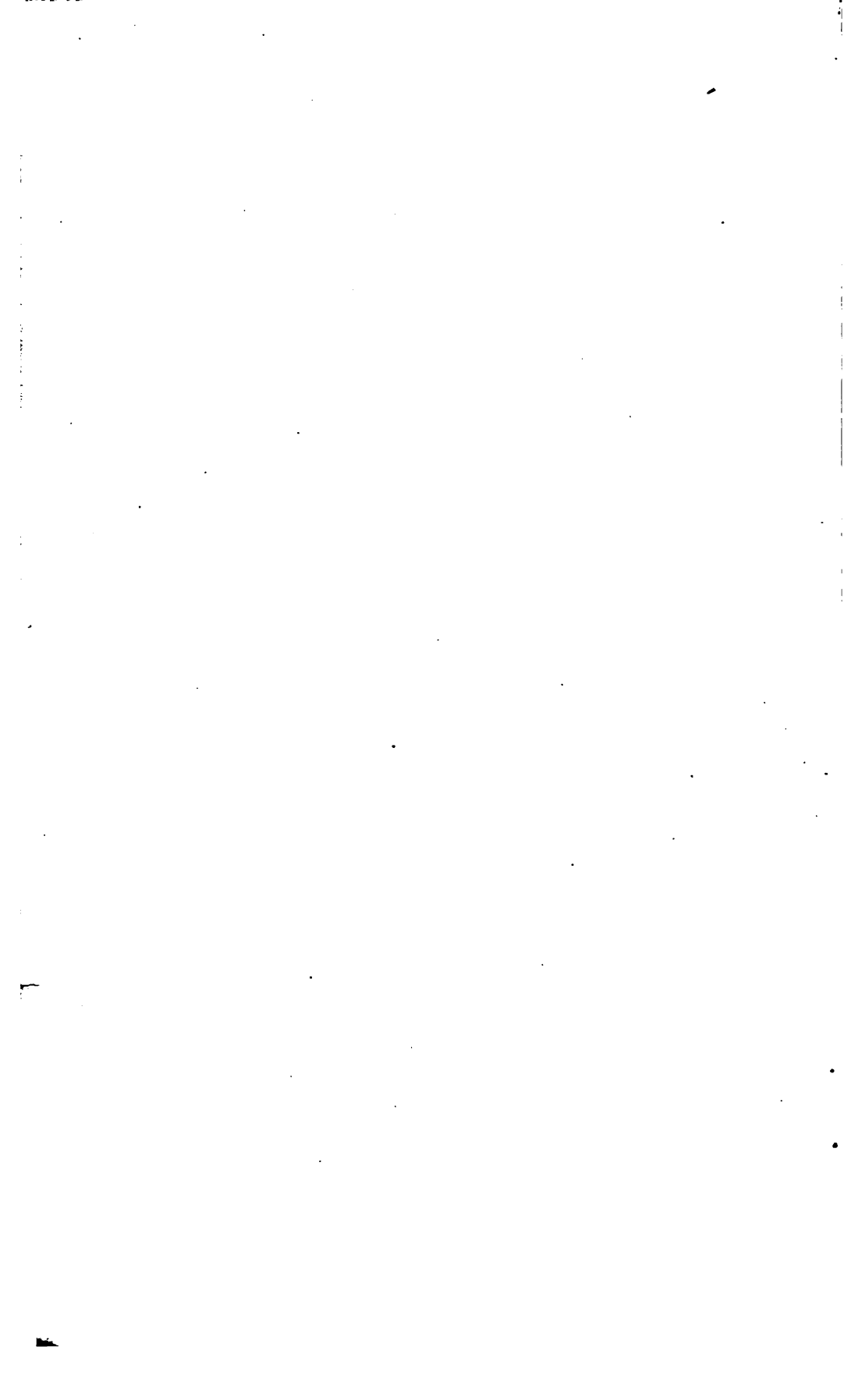
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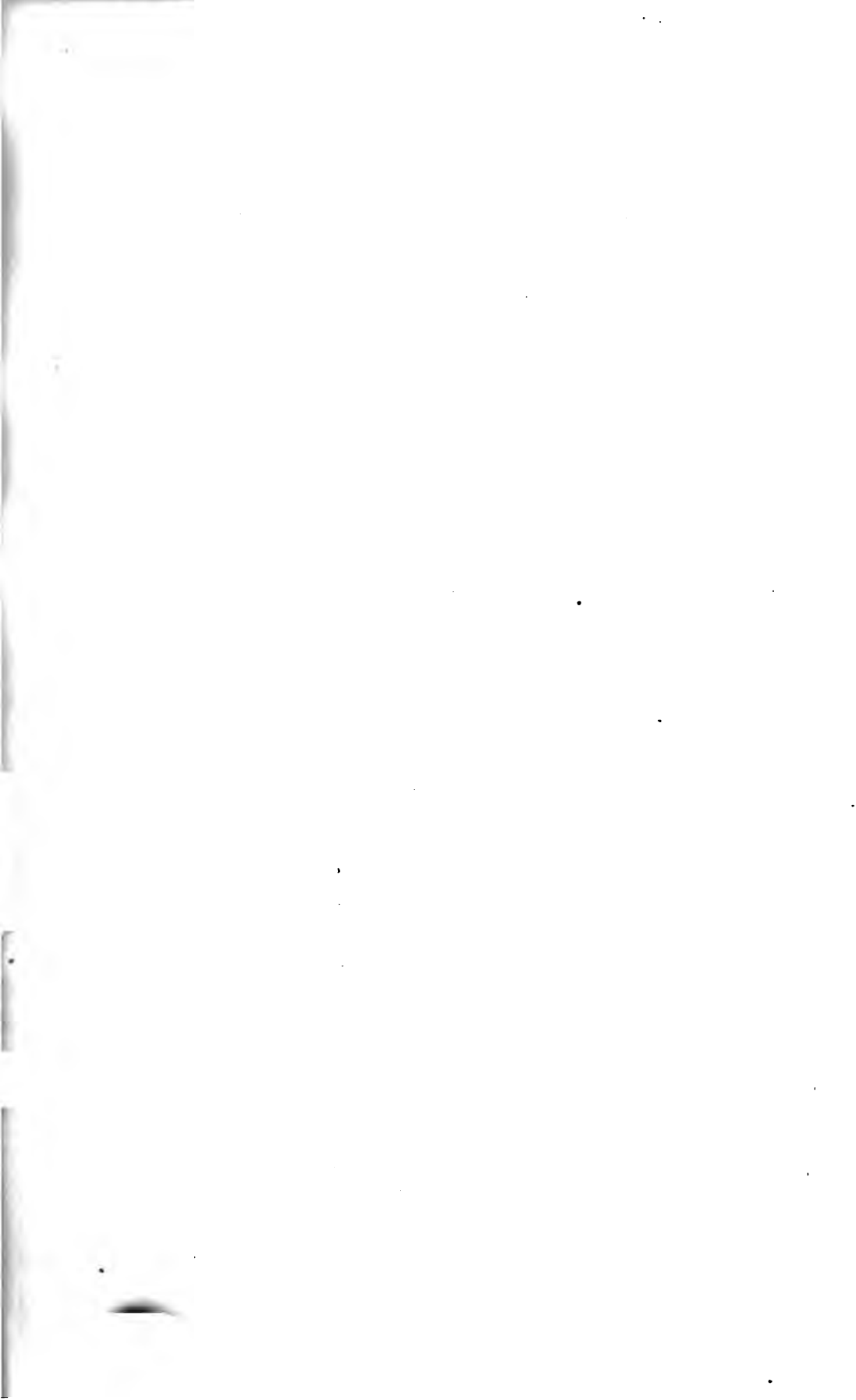
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Cases relating to
LETTERS PATENT FOR INVENTIONS.

ABSTRACT OF REPORTED CASES

RELATING TO

Letters Patent for Inventions

(BETWEEN THE YEARS 1884 TO 1886 INCLUSIVE).

TOGETHER WITH

*SOME UNREPORTED CASES, AND CASES DECIDED BY THE
LAW OFFICERS AND THE COMPTROLLER-GENERAL.*

WITH THE STATUTES AND RULES.

BY

RALPH GRIFFIN,
OF THE INNER TEMPLE, BARRISTER-AT-LAW,

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PREFACE.

THIS volume is an endeavour to abstract the cases reported since 1883, in order to put them in a convenient form for reference by extracting so much of the judgment of each particular case as may be useful for precedents in subsequent cases. In every case the original specification has been carefully studied, and the exact words of the claim of invention have been given where necessary.

I have to thank Counsel and Solicitors engaged in the various cases for their ever ready courtesy in giving me the use of shorthand notes and of other information in their possession.

I have especially to thank Theodore Aston, Esq., Q.C., for his kindness in giving me the Notes of several unreported cases, which form a material addition of great value to this volume. They will be found on pp. 40, 44, 49, 115, 138, 187, 213, 247.

As the year 1884 may be regarded as beginning a new era in Patent Law and Practice, it has been thought well to include in this volume all the Statutes and Rules now in force relating to the subject.

I have to thank Mr. W. H. Sprague, of the Patent Office,

for admirable Reports of some useful cases decided by the Law Officers and the Comptroller General under the new practice: these judgments, I have, with his assistance, abstracted from the shorthand notes of Messrs. Marten and Meredith.

I have to acknowledge the courteous kindness of the Comptroller General, of the Officials of the Patent Office, and of the Law Officers' Clerk, who have been always ready to give me any assistance in their power in the completion of the Volume.

RALPH GRIFFIN.

6, CROWN OFFICE ROW,
TEMPLE, E.C.
July, 1887.

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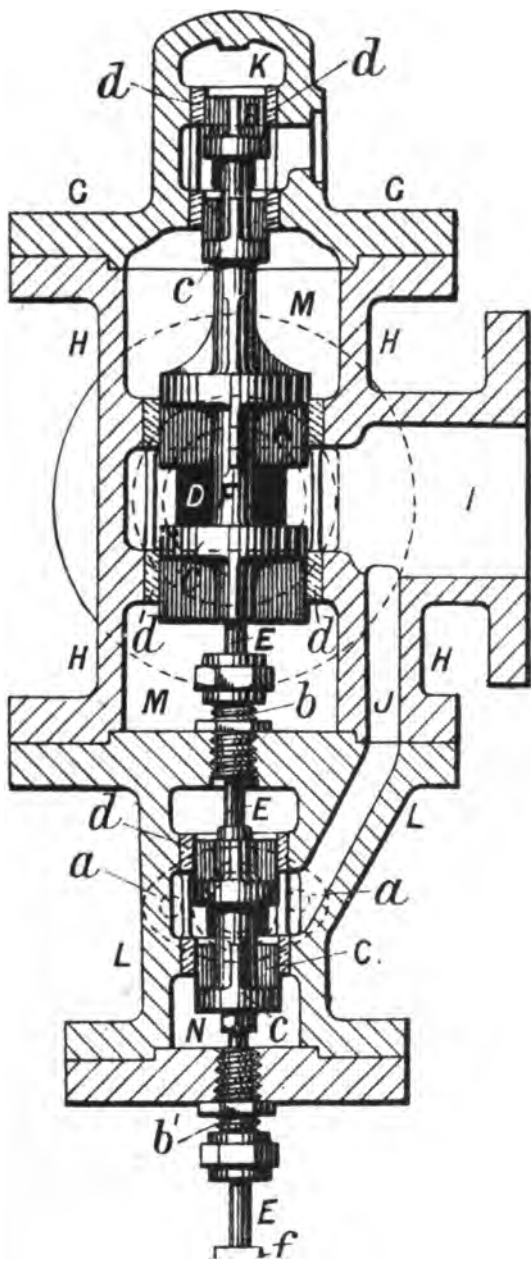
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LIST OF ABBREVIATIONS.

App. Ca.	Law Reports, Appeal Cases.
Ch. D.	Law Reports, Chancery Division.
L. J.	Law Journal Reports (New Series).
L. T.	Law Times Reports (New Series).
O. R.	Reports of Patent Cases issued by the Patent Office.
W. R.	Weekly Reporter.
Vol. I.	Goodeve's Patent Cases, Vol. I.

A. D. 1885. No. 1974. (..... Sheets)
Smith's Specification. Sheet.....

FIG. 1.



Border line ½ an inch from edge of paper.

Border line ½ an inch from edge of paper.



STATUTES RELATING TO PATENTS

THE STATUTE OF MONOPOLIES, 1623.

(21 JAS. I., c. 3.)

*An Act concerning Monopolies and Dispensations, with Penal Laws,
and the Forfeiture thereof.*

FORASMUCH as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did [A.D. 1610] publish in print to the whole realm, and to all posterity, that all grants of monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm : And whereas, your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature, yet nevertheless upon misinformations, and untrue pretences of public good, many such grants have been unduly obtained and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's royal and blessed intention so published as aforesaid : for avoiding whereof, and preventing of the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords spiritual and temporal, and the Commons in this present Parliament assembled, that it may be declared and enacted, and be it declared and enacted by authority of this present Parliament :

21 JAS. I.;
c. 3.

I. That all monopolies, and all commissions, grants, licences, charters, and letters-patents, heretofore made or granted, or hereafter to be made or granted to any person or persons, bodies politic or corporate whatsoever or for the sole buying, selling, making, working, or using of anything within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty, to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation licence or toleration to be had or made, or to agree or compound with any others for any penalty or forfeitures limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute before judgment thereupon had, and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void, and of none effect, and in no wise to be put in ure or execution.

21 JAS. I.,
c. 8.

II. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licences, charters, letters-patents, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them and every of them ought to be, and shall be for ever hereafter examined, heard, tried, and determined by and according to the common laws of this realm, and not otherwise.

III. And be it further enacted by the authority aforesaid, that all person and persons, bodies politic and corporate whatsoever, which now are, or hereafter shall be, shall stand and be disabled and incapable to have, use, exercise, or put in ure any monopoly, or any such commission, grant, licence, charters, letters-patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power or faculty grounded, or pretended to be grounded, upon them, or any of them.

IV. And be it further enacted by the authority aforesaid, that if any person or persons at any time after the end of forty days next after the end of this present session of Parliament, shall be hindered, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained by occasion or pretext of any monopoly, or of any such commission, grant, licence, power, liberty, faculty, letters-patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case the same person and persons shall and may have his and their remedy for the same at the common law by any action or actions to be grounded upon this statute, the same action and actions to be heard and determined at the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, or carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away or detained, and double costs, and in such suits, or for the staying or delaying thereof, no essoine protection, wager of law, aydeprayer, privilege, injunction, or order of restraint, shall be in anywise prayed, granted, admitted or allowed, nor [any more than one imparlance: And if any person or persons shall after notice given that the action depending is grounded upon this statute, cause or procure any action at the common law grounded upon this statute, to be stayed or delayed before judgment by colour or means of any order, warrant, power or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour, or means of any order, warrant, power or authority, save only by writ of error or attain, that then the said person or persons so offending shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the Statute of Provision and Premunire made in the sixteenth year of the reign of King Richard the Second. . . .

VI. Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters-patents, and grants of privilege for the term of 14 years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of

such manufactures, which others at the time of making such letters-
 patents, and grants shall not use, so as also they be not contrary to the
 law, nor mischievous to the State, by raising prices of commodities at
 home, or hurt of trade, or generally inconvenient; the said 14 years
 to be accounted [*or*, accomplished] from the date of the first letters-
 patents, or grant of such privilege hereafter to be made, but that the
 same shall be of such force as they should be if this Act had never
 been made, and of none other.

21 JAS. I.,
 C. 3.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

46 & 47 VICT., C. 57.

*An Act to amend and consolidate the Law relating to Patents for Inven-
 tions, Registration of Designs, and of Trade Marks.*

46 & 47
 VICT.,
 C. 57.

[25th August, 1883.]

BE it enacted, &c.

PART I.

PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade Marks
 Act, 1883.

2. This Act is divided into parts, as follows:—

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

3. This Act, except where it is otherwise expressed, shall commence
 from and immediately after the 31st Dec., 1883.

PART II.

PATENTS.

Application for and Grant of Patent.

4. (1.) Any person, whether a British subject or not, may make an
 application for a patent.

46 & 47
VICT.,
c. 57.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

See s. 5 of Act of 1885, *infra*.

Forms A,
A1, pp. 338,
339.

* Rr. 4, 6,
8, 9, 10,
27.

+ R. 19,
s. 97.

5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed * ; and must be left at, or sent by post to, the patent office in the prescribed † manner.

"Prescribed," s. 117 (1). For the practice, see notes to R. 8, p. 322, and R. 22, p. 325.

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent ; and must be accompanied by either a provisional or complete specification.

See s. 2 of Act of 1885, *infra*.

Form B,
p. 340.

Rr. 28-31.

Form C,
p. 341.

Rr. 28-31.

(3.) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

See Act of 1886, s. 2, and rr. 28-31, as to drawings.

(5.) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

S. 82 (3). 6. The comptroller ‡ shall refer every application to an examiner, who shall ascertain and report to the comptroller whether—

The nature of the invention has been fairly described, and—

The application, specification, and drawings (if any) have been prepared in the prescribed manner, and—

The title sufficiently indicates the subject matter of the invention.

"Comptroller" and "prescribed," s. 117 (1).

S. 9 (5).

7. (1.) If the examiner reports—

That the nature of the invention is not fairly described, or—

That the application, specification, or drawings has not or have not been prepared in the prescribed manner, or—

That the title does not sufficiently indicate the subject matter of the invention,

Rr. 11-14,
23, s. 94.

The comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.

The comptroller may also refuse under ss. 33, 86, 116, which see.

- (2.) Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer. 46 & 47 Vict., c. 57.
- (3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted. Ss. 38, 117 (1).
- (4.) The comptroller shall, when an application has been accepted, give notice* thereof to the applicant. L. O. rules, p. 318. Form T, p. 346.
- (5.) If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported. * Rr. 25, 26. S. 9 (5).
- (6.) Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant. Rr. 11-16. s. 94. L. O. rules, p. 318.

8. (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application. S. 98.

See s. 3 of Act of 1885, *infra*.

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

See Act of 1885, s. 4, *infra*.

9. (1.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining—

Whether the complete specification has been prepared in the prescribed * manner, and—

* S. 117 (1).

Whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2.) If the examiner reports that the conditions hereinbefore † contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction;

† Ss. 5, 9 (1).

Rr. 11-15. S. 94.

But any such refusal shall be subject to appeal to the law officer.‡

‡ Form T, p. 346. L. O. rules, p. 318. S. 38.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4.) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having

S. 98,

48 & 47
VICT.,
c. 57

been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

See Act of 1885, ss. 3, 4, p. 31.

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, other than an appeal to the law officer under this Act, unless the court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Rr. 25, 26.
Act of
1885, s. 4.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection.

Rr. 32-41.
Form D,
p. 341.
S. 98.

11. (1.) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent—

On the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or—

On the ground that the invention has been patented in this country on an application of prior date, or—

On the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application—

But on no other ground.

For the practice under this section, see note to R. 32, p. 327.

*S.117(1).

(2.) Where such notice is given the comptroller* shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law† officer.

† S. 38.
L. O. rules,
p. 318.
Form T,
p. 346.

(3.) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

It will be noticed that any one of the public may oppose before the comptroller, but on an appeal to the L. O. an opponent who has no special interest will not be heard; see decisions, pp. 285, 290.

S. §3 (2),

(4.) The law officer may, if he thinks fit, obtain the assistance of an

expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint. 46 & 47
VICT.,
c. 57.

12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office. Ss. 33, 84.

A patent may be refused under ss. 33, 86, 116, which see.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom. S. 93.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases herein-after mentioned, that is to say—

(a.) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b.) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant. S. 34

And see Act of 1885, s. 3, p. 31.

13. Every patent shall be dated and sealed as of the day of the application : S. 33.

Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification :

Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

Provisional Protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same ; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

Under the Act in force at the time of passing this Act, the words were : "The invention may be used and published without prejudice to any Letters Patent to be granted for the same," 15 & 16 Vict. c. 83, s. 8.

Protection by Complete Specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if Ss. 10, 12.

46 & 47
VICT.,
c. 57.

a patent for the invention had been sealed on the date of the acceptance of the complete specification :

Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

Patent.

S. 33. 16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

S. 33. 17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date.

Compare s. 6 of 21 James I., c. 3, *supra*, p. 2.

Ss. 24, 46.
R. 73.
Fees 14—
25, p. 337. (2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

Rr. 46, 47.
Form K,
p. 344. (3.) If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment.

(4.) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions :—

(a.) The time for making any payment shall not in any case be enlarged for more than three months.

(b.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

Fees 26,
27, 28,
p. 338.

It may be doubtful if an account of profits could be refused, but see s. 30.

Amendment of Specification.

* S. 46. 18. (1.) An applicant or a patentee* may, from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.

Rr. 19, 48.
Form F,
p. 342.

For the practice under this section, see note to R. 48, p. 330.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one

month from its first advertisement any person may give notice at the Patent Office of opposition* to the amendment.

46 & 47
Vict.,
c. 57.

(3.) Where such notice is given the comptroller shall give notice† of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

* Rr. 19,
49. Form
G, p. 342.

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

† Rr. 50-
52.
S. 38.
L. O. rules,
p. 318.
Form T,
p. 346.

See note to a. 11 (3).

(5.) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

Rr. 54-56.

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

L. O. rules,
p. 318.

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

The courts may still make the enquiry whether the new claim is substantially larger or substantially different, but this sub-section prevents any question being raised whether the person, at whose instance the amendment was allowed, was or was not the applicant or patentee.

The words of the former Act were identical; 15 & 16 Vict. c. 83, s. 39.

(10.) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.

As to "pending," see p. 72.

19. (1.) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee * shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

* S. 46.
R. 55.

46 & 47
VICT.,
c. 57.

This section is limited to disclaimer, cf. s. 18 (1). It is very difficult to construe this section and sub-s. 10 of s. 18 together. There is no provision in s. 19 or in the rules as to the steps to be taken to obtain leave at the Patent Office. The practice has in fact been to treat the action, after liberty to apply has been given, as suspended and no longer pending, and the procedure has been identical with the procedure under s. 18. See further note to R. 55, p. 331. Decisions on the section will be found at pp. 56, 72, 148, 207.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee * establishes to the satisfaction of the Court that his original claim was framed in good faith, and with reasonable skill and knowledge.

* S. 46.

The Court will probably apply this section to cases where an account of profits is asked instead of damages; see s. 30.

R. 56.

21. Every amendment of a specification shall be advertised in the prescribed manner.

Compulsory Licenses.

Rr. 57-63.

† S. 46.

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee † to grant licenses on reasonable terms—

(a.) The patent is not being worked in the United Kingdom; or

(b.) The reasonable requirements of the public with respect to the invention cannot be supplied; or

(c.) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention, and the circumstances of the case, may deem just, and any such order may be enforced by *mandamus*.

See note on R. 57, p. 332. There is no definition of "Board of Trade"; as to its meaning, see s. 65 of 24 & 25 Vict. c. 47, quoted p. 321.

Register of Patents.

Ss. 85, 87
—98.

Rr. 64-76.

23. (1.) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

There is no power given by the Act to amend a patent. It is probable that what was intended was amendments of specifications, which are in fact entered on the register.

(2.) The register of patents shall be *prima facie* evidence* of any matters by this Act directed or authorised to be inserted therein. 46 & 47 VICT., c. 57.

(3.) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office. * S. 89, 96. Rr. 10, 19, 69, 74.

Fees.

24. (1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, † prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees, p. 337. † R. 4.

(2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

Extension of Term of Patent.

25. (1.) A patentee ‡ may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent. ‡ S. 46. P. C. rules, p. 317.

(2.) Any person may enter a *caveat*, addressed to the Registrar of the Council at the Council Office, against the extension.

(3.) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a *caveat* shall be entitled to be heard by himself or by counsel on the petition. S. 28 (2).

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee§ as such, and to all the circumstances of the case. § S. 46.

(5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6.) It shall be lawful for Her Majesty in Council to make, from time

46 & 47
VICT.,
c. 57. to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

No rules have as yet been made. The existing rules will be found at p. 317.

(7.) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

The decisions of the P. C. will be found, pp. 253 to 264.

Revocation.

26. (1.) The proceeding by *scire facias* to repeal a patent is hereby abolished.

(2.) Revocation of a patent may be obtained on petition to the *S.117(1). Court.*

It will be noticed that in the form of Patent (p. 29), there is a condition that it is to be void if certain proof is given to six of the Privy Council. This clause was taken from the old form of Patent. It is believed that no such application has ever been made to the Privy Council.

S. 33. (3.) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

S. 109. (4.) A petition for revocation of a patent may be presented by—
(a.) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland :
(b.) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

See note to L. O. Rules (p. 319), for mode of obtaining A.-G.'s authority.

(c.) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :
(d.) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :
(e.) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by

leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

46 & 47
VICT.,
c. 57.

(6.) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

R. 71.

S. 35.

It is difficult to see how such a patent would be good if there had been prior user under the revoked patent. The terms of s. 35 do not seem to cover such a case. If the patent is revoked the plaintiff must in any case give notice at the Patent Office, R. 71. The decisions will be found, pp. 108, 238.

Crown.

27. (1.) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject.

S. 116.

(2.) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

Cf. s. 44,
and form
of Patent,
p. 29.

Legal Proceedings.

28. (1.) In an action or proceeding for infringement or revocation of a patent, the * Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance ;

Cf. s. 11(4).

* S. 117(1).

The action shall be tried without a jury unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

S. 83 (2).

46 & 47
VICT.,
c. 57.

Sa. 13, 15,
17 & 46, 20,
43, 117 1.

* Sa. 26 & 3.
33, 117 (1.)

29. (1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defence,* or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty must state the time and place of the previous publication or user alleged by him.

See decisions, pp. 34, 63, 100, 106, 110, 244.

(4.) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended, by leave of the Court or a judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

† S. 117 (1).

‡ S. 9 (5).
§ Sa. 17 (4b)
20.

30. In an action for infringement of a patent,† the Court or a judge may on the application of either party make such order for an injunction‡ inspection or account,§ and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

See decisions, pp. 79, 103, 133.

¶ S. 117 (1).

31. In an action for infringement of a patent, the Court¶ or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs charges and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

See decisions, pp. 182, 184.

¶ S. 117 (1).

* S. 46.

32. Where any person¶ claiming to be the patentee* of an invention, by circulars advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture use sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an

injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats :

46 & 47
VICT.,
c 57.

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

See decisions on this section, pp. 47, 48, 80, 131, 142.

Miscellaneous.

33. Every patent may be in the form in the First Schedule to this Act, and shall be granted for one* invention only, but may contain more than one claim ; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

Ss. 12, 16,
17, Form
p. 28.
* R. 23.

This section is awkwardly worded. The claim appears in the specification and not in the patent.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

S. 12 (3b).

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Rr. 24, 77,
ss. 98, 99.

Act of
1885, s. 2.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

S. 26 (8).

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

Ss. 46, 87.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

There is no special rule on this point, see Fee 30 (p. 338), and Form N, p. 345.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act ; and in any proceeding before either of the law

L. O. rules
p. 318.

46 & 47
VICT.,
c. 57.

officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.

Costs.—When there is no opposition, and the question is only between the C. G. and the applicant, the L. O. does not give costs against the C. G. ; under exceptional circumstances the L. O. has recommended the fee payable on appeal (fee 4, p. 337) to be returned.

Act of
1885, s. 3.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

R. 17.
Fee 31,
p. 338.
Form O,
p. 345.

(a.) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so ; and

(b.) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

See note to s. 22.

S. 101.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

Act of
1885, s. 4.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

41. The control and management of the existing Patent Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as Her Majesty in Council may see fit to give.

42. The Department of Science and Art may at any time require a patentee * to furnish them with a model of his invention on payment to

* S. 46.

the patentee of the cost of the manufacture of the model ; the amount to be settled, in case of dispute, by the Board of Trade.

46 & 47
VICT.,
c. 57.

43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.

44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to Her Majesty's Principal Secretary of State for the War Department (herein-after referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention, and of any patent obtained or to be obtained for the same ; and the Secretary of State may be a party to the assignment. Sa. 27, 116.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the patent office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

46 & 47
VICT.,
c. 57.

S. 117 (1).

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

(8.) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the patent office, but before the publication of the specification or specifications, the application specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

S. 26.

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Existing Patents.

S. 113.

45. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the pro-

visions of this Act relating to patents binding the Crown, and to compulsory licenses.*

46 & 47
Vict.,
c. 57.

(3.) In all other respects (including the amount and time of payment of fees)† this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

* Ss. 22, 27.

† Fees,
p. 337.

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the patent office.

Definitions.

46. In and for the purposes of this Act—

“Patent” means letters patent for an invention :

“Patentee” means the person for the time being entitled to the benefit of a patent :

Cf. s. 87.

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within s. 6 of the Statute of Monopolies (that is, the Act of the 21st year of the reign of King James I., c. 3, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”), and includes an alleged invention.

Supra,
p. 2.

In Scotland “injunction” means “interdict.”

PART V.

GENERAL.

Patent Office and Proceedings thereat.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

31 Dec.
1883.
S. 3.

It is situate at 25, Southampton Buildings, Chancery Lane, London, W.C.

(3.) The patent office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

S. 95.

(4.) Any act or thing directed to be done by or to the comptroller

46 & 47
Vict.,
c. 57.

may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

There is no definition of "Board of Trade" in this Act. Its meaning is settled by 24 & 25 Vict. c. 47, s. 65.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

S. 12. **84.** There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.

Rr. 11-14. **86.** The comptroller may refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality.

From such refusal no appeal is provided.

Under this section the C. G. has refused a patent for an apparatus for a lottery.

Rr. 64-74.
Form L,
p. 344.
Fee 29,
p. 338.
S. 23.
S. 46.
S. 36.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent in the register of the patents. The person for the time being entered in the register of patents as proprietor of a patent, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent may be enforced in like manner as in respect of any other personal property.

Ss. 23, 96.
R. 75.
Fee 32.
Form Q,
p. 345.
Fee 35,
p. 338.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Ss. 23 (2),
96.
R. 76.
Form Q.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or

from patents, specifications, disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

46 & 47
VICT.,
c. 57.

90. (1.) The Court may on the application of any person aggrieved— S. 117 (1).

By the omission without sufficient cause of the name of any person from any register kept under this Act, or

By any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry, as the Court thinks fit ;

Or the Court may refuse the application ; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

R. 71.

91. The comptroller may, on request in writing accompanied by the prescribed fee,— R. 18.

(a.) Correct any clerical error in or in connexion with an application for a patent ; or Form P, p. 345.

(b.) Correct any clerical error in the name, style or address of the registered proprietor of a patent.

See note to R. 18, p. 323.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Rr. 11-15.
Form E,
p. 342.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law * officers for directions in the matter.

S. 82 (3).
*S.117(1).

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie*

Ss. 23 (2),
89.
R. 76.
Form Q.

46 & 47
VICT.,
c. 57.

evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

R. 19.
L. O. R. 14,
p. 319.

97. (1.) Any application, notice, or other document authorised or required to be left, made, or given at the patent office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Rr. 7 47,
75.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

R. 77.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act, or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

S. 40.
Act of
1885, s. 4.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland, and in the Isle of Man, without further proof or production of the originals.

101. (1.) The Board of Trade * may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

46 & 47
VICT.,
c. 57.

- (a.) For regulating the practice of registration under this Act : * See note, s. 82 (4).
- (c.) For making or requiring duplicates of specifications, amendment, drawings, and other documents : See Rules, *infra*.
- (d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents : S. 40 (2). Act of 1885, s. 4.
- (e.) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the patent office ; and providing for the inspection of indexes and abridgments and other documents : S. 40 (3).
- (f.) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies, and institutions at home and abroad :
- (g.) Generally for regulating the business of the patent office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.
- (2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

See Rules of 1883, 5 & 6, and Rules of 1885, 4 & 5.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule, or to the making of any new rules or rule.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules

46 & 47
VICT.,
c. 57.

made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

International and Colonial Arrangements.

* Now
date of the
applica-
tion.
Sec. 6 of
Act of
1885.
S. 98.

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, then any person who has applied for protection for any invention in any such state, shall be entitled to a patent for his invention under this Act, in priority to other applicants ; and such patent shall have the same date as the date * of the protection obtained in such foreign state.

Conventions have been made with various countries under this section.

Provided that his application is made, in the case of a patent within seven months from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification.

(2.) The publication in the United Kingdom, or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, shall not invalidate the patent which may be granted for the invention.

(3.) The application for the grant of a patent, under this section, must be made in the same manner as an ordinary application under this Act.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

It is believed that rules under this section are in course of preparation ; none have as yet been issued. The practice is for the applicant to file with his application a certified copy of the specification filed in the foreign state ; to obtain priority of date, the English specification must be a translation or transcription of the original one, as modifications will not be allowed, though clearly within the ambit of the original specification.

The patent will, by s. 17, expire 14 years after the date of the application in the foreign state.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession † has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last

preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

46 & 47
VICT.,
c. 57.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

A person who has provisional protection cannot mark his article patented.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Has a patentee in consequence of his patent the right to use the Royal Arms?
It may be argued that such patent is authority from H. M.

Scotland; Ireland; &c.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

For the purposes of this section "court of appeal" shall mean any court to which such action is appealed.

46 & 47
VICT.,
c. 57.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

S. 26.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

111. (1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those courts;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal; Transitional Provisions; Savings.

46 & 47
VICT.,
c. 57.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

Infra,
p. 30.

- (a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or
- (b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or
- (c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

See decisions, pp. 67, 207, 255, 310.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

S. 23.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

R. 78.

116. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

Cf. ss. 27,
116.

General Definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

“Person” includes a body corporate :

R. 70.

And therefore a company registered under the Act of 1862, 25 & 26 Vict. c. 89,
s. 6.

“The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England :

Ss. 28, 107
—112.

46 & 47
VICT.,
c. 57.

"Law officer" means Her Majesty's Attorney-General or Solicitor-General for England :

"The Treasury" means the Commissioners of Her Majesty's Treasury :

S. 82 (3). "Comptroller" means the Comptroller General of Patents, Designs, and Trade Marks :

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act :

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act :

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

FIRST SCHEDULE.

Form A, *infra*, p. 339. Form B, *infra*, p. 340. Form C, *infra*, p. 341.

FORM D.*

FORM OF PATENT.

S. 33.

No fee is payable on this.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:

Whereas *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, hath by his solemn declaration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere

* It will be seen that there is a Form D annexed to the rules, p. 341.

46 & 47
VIOT.,
c. 57.

S. 27.



Seal
of Patent
Office.

This is referred to in s. 24, and contained Fees on Instruments for obtaining Patents and Renewals. They were Fees 1, 2, 8, 14-25 in the List, *infra*, p. 337.

46 & 47
Vict.,
c. 57.

THE THIRD SCHEDULE.

S. 118.

ENACTMENTS REPEALED.

21 James I. c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Ss. 10, 11, and 12.
5 & 6 Will. 4, c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— S. 11.
5 & 6 Will. 4, c. 83. [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of 5 & 6 Will. 4, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.
7 & 8 Vict. c. 69 (a). [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely,— Ss. 2 to 5, both included.
13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70. [1858.]	An Act to amend the Act of 5 & 6 Vict. to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870. In part; namely,— S. 65, and in the Schedule the words and figures. "Certificate of the registration of a design . . . £5 0 0 And see section 65."
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.

(a) Note.—Sections 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.	46 & 47 Vict., c. 57.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.	
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part ; namely,— S. 5.	
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part ; namely,— S. 16.	

THE PATENTS, &c., ACT, 1885.

48 & 49 VICT. C. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14th August, 1885.]

48 & 49
Vict.,
c. 63.

BE it enacted, &c. :—

1. This Act shall be construed as one with the Patents, &c., Act, 1883 (in this Act referred to as the principal Act).

46 & 47
Vict. c. 57.

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

2. Whereas sub-s. 2 of s. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that :

The declaration mentioned in sub-s. 2 of s. 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835,* or not, as may be from time to time prescribed.

Rules of
1885, r. 5,
infra, and
Forms A,
A 1, pp.
338, 339.

3. Whereas under the principal Act, a complete specification is required (by s. 8) to be left within nine months, and (by s. 9) to be accepted within twelve months, from the date of application, and a patent is required by s. 12 to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times: Be it therefore enacted as follows :

* 5 & 6 W.
4, c. 62.

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller

Rules of
1885, r. 6.
Forms U,
V, pp. 346,
347.

48 & 49
VICT.,
c. 63.

Fees 39,
40, p. 338.

may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Act of
1883,
ss. 8 (2),
9 (4).

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

S. 4.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

S. 103 (1).

6. In sub-s. 1 of s. 103 of the principal Act, the words "date of application" shall be substituted for the words "date of the protection obtained."

THE PATENTS ACT, 1886.

49 & 50 VICT. c. 37.

49 & 50
VICT.,
c. 37.

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.
[25th June, 1886.]

WHEREAS by s. 5 of the Patents, Designs, and Trade Marks Act, 1883, specifications whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

Be it, &c.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

Rr. 28-31.

2. The requirement of sub-s. 4 of s. 5 of the Patents, &c., Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provi-

sional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification.

49 & 50
VICT.,
c. 37.

3. Whereas by s. 39 of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by s. 57 of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so.

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows :

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that ss. 39, 57, of the Patents, &c., Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

PATENT CASES.

ANGLO-AMERICAN BRUSH LIGHT CORPORATION *v.* CROMPTON.

[1886. 56 L. J. Ch. 167; 35 W. R. 125; 4 O. R. 27.]

Particulars of Objections.

Action for infringement of a patent granted the 18th *May*, 1878, to *H. J. Haddan* for "improvements in apparatus for the generation and application of electricity for lighting, plating, and other purposes," in part disclaimed (a communication).

The defendants (*inter alia*) by their particulars alleged that the invention described in the complete specification as amended was a different invention from that described in the provisional specification.

BACON, V.C., made an order for further and better particulars of this objection.

Appeal to the Court of Appeal (Cotton, Bowen, L.JJ.). Order affirmed.

COTTON, L.J.—The defendant ought to give such particulars as would inform the plaintiffs of the nature and scope of this objection of non-conformity. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them. Each case must depend on its own circumstances.

BADISCHE ANILIN FABRIK *v.* LEVINSTEIN.

[March 18, 1885. 29 Ch. D. 366; 2 O. R. 73, 143.]

Sufficiency of Specification—To whom addressed—Utility—Evidence—Costs.

This was an appeal from a decision of PEARSON, J., reported Vol. I., p. 24.

The order of the learned judge as drawn up (*inter alia*) provided

that the shorthand notes of the evidence whereby the defendant's secret process was disclosed, and all the printed copies in the possession of the plaintiffs or their agents, should be sealed up and impounded in Court till further order.

The Court of Appeal (Fry, Bowen, L.JJ., *diss.* Baggallay, L.J.), allowed the appeal on the ground that the patent was invalid, and dismissed the action.

BAGGALLAY, L.J.—If the language of the specification can be fairly construed, so as in the one case put, to support the validity of the patent, if challenged on the ground that the use of beta naphthylamine would lead to failure, and in the other to protect the patentee against an infringement by the use of that substance, it would be fatal to the plaintiffs' case in the present action, whether the language had been adopted *per incuriam* or of set design. 29 Ch. D.
379.

Though the term "the literature" has been conveniently applied to the documentary evidence admitted in the present case, it is clear that publications of this nature must be regarded as of two classes, those addressed to the scientific world, and those addressed to working or practical men, a distinction which cannot, in my opinion, be more simply and clearly illustrated than it was by Dr. *Odling*, who, being asked by PEARSON, J., when the body, now known as alpha naphthylamine, but formerly known as naphthylamine without any prefix, first acquired its present name, replied as follows:—"My Lord, there are two distinct forms of literature upon the subject. There is the systematic scientific literature, and there is the technical literature, and in the technical literature it is called naphthylamine up to the present day; but in the more scientific literature you may find the distinction, although it is very rare." The distinction between the information given by scientific literature and that given by technical literature is one very important to be borne in mind when we are dealing with questions such as that now under consideration; publications having reference to chemical science and intelligibly expressed will always be inquired after and studied in their laboratories by scientific chemists, ever on the alert to make themselves acquainted with the newest compounds, with the view of putting them to some useful purpose; but, speaking generally, it is not the fact that such publications are sought after and studied by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained. 29 Ch. D.
384.

It has been urged that the first claim is too wide, as claiming 29 Ch. D.
387.

not only all sulpho acids then known of naphthylamine and naphthol, but all which might be discovered at any future time. As regards this objection, I deem it unnecessary to say more than that I entirely agree with the views expressed by PEARSON, J., in the course of his judgment, that the specification must be construed as having reference to such acids only as were known at the date of the patent.

29 Ch. D.
400.

An argument has been addressed to us on behalf of the defendant, which, though I am unable to accede to it, requires notice from me, and the more so as it has found favour with my colleagues. If I rightly appreciate it, it may be formulated in the following propositions:—1. Assuming the defendant to have infringed the plaintiffs' patent in so far as he has followed the directions given in the specification, those directions, though wide enough to cover what the defendant has done, are not in themselves sufficiently explanatory for the instruction of those classes of the public for whom they were or ought to have been intended. 2. That the defendant, by his own experiments and exertions, has discovered how those inadequate directions may be, and have been by him, successfully carried out. 3. That, without the assistance derived from the defendant's discovery, the plaintiffs' invention was, and would continue to be, useless.

As at present advised, I am not prepared to admit that, even if these propositions were supported by the evidence, they would be sufficient to justify the infringement or to protect the defendant from the consequences.

FRY, L.J., read the judgment of BOWEN, L.J., and himself, and after referring to the questions of utility and sufficiency of specification, continued:—

29 Ch. D.
405.

The course pursued by the plaintiffs has made the answer to these questions very difficult: for the first thing to know is, what in fact was the inventor's invention; and yet the plaintiffs have not put into the box Dr. *Caro* (the communicator) or any witness to prove what the real invention was, or to show that the patent has been worked by the plaintiffs or anyone else, although Dr. *Glazer*, one of the principals connected with the plaintiffs' works, and Dr. *Scraube*, also from the same works,—and both, according to Dr. *Griess*, gentlemen familiar with the manufacture of the sulpho acids of naphthylamine by the plaintiffs,—were in Court during the trial, and the defendant invited the plaintiffs to call some witness from their works. Furthermore, the plaintiffs have produced no specimen of brown colouring matter at all. They

have produced a specimen of red colouring matter, as if from their works, but have not shown that it has been made in accordance with the patent, nor do they prove the manufacture or sale of a single ounce of any colouring matter before the defendant's product was in the market, nor have they shown that any subsequent improvement in the manufacture has put their patent of 1878 out of date.

The invention in question is one arising out of the application of principles of organic chemistry, a subject of great complexity. It deals with substances all of them of comparative novelty to science, and many of them not yet familiar to the ordinary chemist; and all or many of the substances dealt with exhibit the phenomena classed together under the word "isomerism;" that is to say, there are substances whose percentage composition or chemical constitution, so far as revealed by chemical analysis, is the same, which consists of the same number of parts of the same substances, and yet differ from one another,—sometimes in their physical properties only, sometimes in both their chemical and physical behaviour,—and are often the results of different modes of preparation. The most important of these differences for the present purpose is a difference in value as dyeing substances, so that different isomers will give different shades of colour or different colours. It appears to be the result of the evidence that the different modes of producing the same substance chemically will produce different isomers; and that the different proportions of substances employed, the differences of temperature or of time, may all result in differences in the isomeric form; and that, whilst the laws of chemical combination are so far known as that the results may in many cases be predicted so far as relates to the percentage composition of the resultant body, the laws which regulate the production of the different isomers are unknown, and consequently that the results cannot be predicted except empirically. It follows that the principle of equivalence must be applied to the construction of the specification with great care, because two processes producing the same result, so far as chemical analysis goes, may produce different isomers, and unless the same isomers be arrived at by both processes the result will be different for the purpose in hand. It further follows from what we have said, and also from the character of the specification itself, that the specification cannot be considered as addressed to any ordinary workman but rather to one of those advanced students of organic chemistry who are usually attached to dye manufactories, and of whom Dr.

29 Ch. D.
406.

Caro or *Dr. Liebman*, or the defendant himself, may be taken as samples. To any other reader than such a chemist, the specification cannot, we think, be deemed to be addressed at all.

29 Ch. D.
407.

The evidence in the case leads us to the conclusion, that for a dye to be of any real value, its production must be certain, *i.e.*, the product must be uniform, or variable only according to a law known to and capable of being used by the maker. It appears that buyers cannot judge of the colour resulting from the dye from the external appearance of the colouring matter itself, and therefore they rely on the manufacturer, and expect to be able to get the same shade on successive purchases. And the fact that the plaintiffs and defendant alike appear to sell only one red dye, and no brown dye at all, goes far to convince us that many or all of the shades or colours are useless. The mere production in the laboratory of a varying series of red and brown colouring matters being instances of the production of such matters from the diazo compounds which *Dr. Griess* had, long before the plaintiffs' patent, pointed out as a frequent result of his process, was not, we think, an invention of any public benefit, though it might be an important step towards some useful discovery; and if this was the invention of *Dr. Caro*, we think that it had not the needful predicate of utility.

29 Ch. D.
409.

With regard to the 3rd process, we must observe that in the cases of Professor *Dewar*, *Dr. Armstrong*, and Professor *Odling*, their attention was first called to the product of the defendant and to the examination of this product, and not till afterwards and with the light thrown on the specification by the examination of a successful article, was their attention drawn to the terms of the specification itself. It is evident that these laboratory experiments thus conducted, after the defendant's success had shown the use of naphthionic acid, are quite inadequate to prove that a competent reader could by the specification alone have discovered without further experiment what course he ought to pursue. None of the plaintiffs' experts appear to have followed the third way of the third process. If they had, they would have worked, not with naphthionic acid, but with another, and, for aught that appears, useless isomer. They were kept from wandering into this third way by the light thrown on the process by the examination of the defendant's product, and not by any note of warning in the specification itself.

29 Ch. D.
412.

No doubt that the older form of naphthylamine was the better known and the cheaper; but it appears to us that there was at

the date of the patent every probability that the new isomer might, at some time during the life of the patent, become, as in fact it has already become, of commercial importance, and of use in the manufacture of dyes. No doubt that some writers may have used the expression naphthylamine as signifying the alpha form after the date of the discovery; no doubt it is probable that any dealer in the article at the date of the patent would have understood by the word naphthylamine the older form; but we have arrived at the conclusion that any organic chemist of the class to whom the specification is addressed would have known of the two isomers; that any careful writer of such a class would have used the discriminating mark, and that any careful reader of such a class would have felt the ambiguity of the language used in the present instrument; that he would, to use Dr. *Odling's* expression, have felt that it was a question what was meant by it. The care used in discriminating between the two isomers of naphthol in the specification made its silence as to the naphthylamine, if possible, more embarrassing. In our opinion an obligation rests on a patentee to use clear and unambiguous language: that duty the patentee in the present case has, we think, neglected to perform, either from carelessness or from design. The present instance is, we think, a forcible illustration of the necessity of upholding this obligation; for as beta naphthylamine has been found to produce yellowish tints, and not to be adopted to use under the specification, the plaintiffs contend that it is not included in the word naphthylamine, whereas if the beta isomer had been found useful, it would have been open to him to take the other line of argument, and to contend, as he probably would have done, that both isomers were within the scope of the specification. It is not, however, necessary for us to consider whether this ambiguity would have been fatal to the present patent if it had stood alone. We regard it as only one instance of a want of exactitude which runs through the whole specification, namely, the want of discrimination between useful and useless isomers.

The order directed that the plaintiffs, having proved infringement, should be allowed the costs of particulars of breaches, both in the Court below and in the Court of Appeal, giving the defendant all other costs.

BOWEN, L. J.—It seems to me that, without laying down any hard-and-fast line, or trying to fetter our discretion at a future period, in making that direction in this case we are acting on a sensible and sound principle, namely, the principle that parties

ought not, even if right in the action, to add to the expense of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest that they should raise issues in which in the end they are defeated; it may help them in certain events in the conduct of the action; and it is prudent that they should do this in their own interest; but the defendant who does so, does so in his own interest, and, if he does so, I think he ought to do it at his own expense.

The order is given 2 O. R. p. 143; 29 Ch. D. 420.

BAMLETT v. PICKSLEY.

[1875. Not reported.*]

Subject-matter.

Case for the infringement of a patent granted the 17th Oct., 1870, No. 2734, to the plaintiff for improvements in reaping and mowing machines.

The invention consisted of an improvement in machines for mowing, by which the cutting-knife might be made to revolve quicker for mowing grass than for cutting corn. This was accomplished in the following way. A shaft was mounted parallel to the axle of the wheels of the machine, and from this shaft, by means of a bevel wheel, the knife was driven. At either end of this shaft were pinions of unequal sizes. The shaft was not so long as the axle: on the latter were mounted wheels internally toothed of different diameters, and it was so arranged that by a longitudinal motion of the shaft in one direction, the large pinions would gear with the large wheel, or by a motion in the other, the small pinion geared with the small wheel, so as to drive at different speeds. Other improvements were also described.

Claim: The several improvements in combined reaping and mowing machines.

It appeared at the trial that one *Nicholson* had invented a hay-making or tedding machine, in which the tossing rakes were driven slower or faster by the driving axis by an arrangement of shaft and wheels identical with that adopted by the plaintiff.

Verdict for the defendants.

The Court of Exchequer refused a new trial on appeal to the Court of Exchequer Chamber (BLACKBURN, MELLOR, LUSH, BRETT, ARCHIBALD, GROVE, DENMAN, JJ.).

Judgment affirmed.

* For the notes of this case I am indebted to T. Aston, Esq., Q.C.

BLACKBURN, J.—The question is, whether in the present case there has been shown to be some novelty in what has taken place here. It is a matter in which the use of language would require to be very precise and accurate, in order to use language such as would express the precise idea. I do not profess to express any-one's idea except my own, and I do not, even in expressing my own idea, think it necessary to endeavour to use language that would apply to every case, for I think it is quite sufficient that I should use language which will apply to the present case.

* * * * *

The object which the plaintiff sought to discover was a mode or means of causing the revolution of the wheel on the ground sometimes to cause the other wheel to move quickly so as to be fit for cutting grass, and sometimes to cause the other wheel to revolve slowly so as to be fit for cutting corn. He invented a mode (no doubt he *bonâ fide* found it out himself, and in that sense it was an invention) by which, by taking two cog-wheels, he could cause the revolution of the revolving wheel, and when the revolution of that wheel was applied to the purpose of moving the cogs, it would make them go sometimes quickly for mowing purposes, and sometimes slowly for reaping.

* * * * *

What *Nicholson* did was this, he discovered the identical mode which the plaintiff afterwards applied to a reaping and mowing machine for the purpose of causing the revolution of the wheel of a hay machine. That really is the identical matter which is the identical invention in this case. Whether the wheel revolving quickly was to move knives which cut the grass, or was to move prongs which tossed the hay, or was (if we may suppose such a thing could be) to put in motion machinery in order to spin cotton; all that in my mind is utterly immaterial. The thing which was the thing to be discovered was what *Nicholson* had done before when the same motion of the revolving wheel caused sometimes the one axis to move quickly, and sometimes the other axis to move slowly, and it is done in the identical way.

Counsel endeavoured to argue that there was an invention in this; that although *Nicholson* discovered the identical way of making the movement, he had never applied that to the purpose of reaping and mowing machines, and that it was a new discovery for a man to say that mode which was to cause the wheel to move slowly and quickly applied to one purpose I will now apply to a new one, and that is a discovery. I must own it is exactly

identical with Lord *Abinger's* simile : an old broom has been used for sweeping an old carpet, and he said it is no discovery to say now that a new carpet is found out, "I will apply the old broom to sweep the new carpet." It is identically the same case, the very same thing.

Then, if I understood the argument as to the evidence which was given, as far as my knowledge goes it is the evidence which is given in every patent case that ever was. There was the evidence that everybody wanted to discover how to do this thing and that it was a desideratum, and then that this particular plaintiff found it out; and that is proved by the further evidence that people had tried to do the thing and had made inventions which did not or would not work so well. The effect of that is to say that the Court cannot say that there is no novelty in the thing because some people at least thought that the thing was wanted. I will not enquire whether the failure to apply *Nicholson's* invention to this case arose from ignorance, or whether they had it not present to their minds; I do not enquire into that at all. I do not care to enquire into the question whether there was or not any merit in his discovering this machine as far as it has gone, or whether he has shown any cleverness or not in its construction, because he has not discovered that which was not known before; he has taken the identical thing which was known before and has applied it to another purpose no doubt, but still it was completely the same thing that was done before, and whether for one purpose or another to my mind in that case it makes no difference.

There may be cases in which a thing is used which would be identically the old one to produce a new product altogether, but applied to something so totally different that there is an obvious invention in it. Take this example:—It was discovered that by taking flour and making it into tough dough by means of machinery you could spin it into a pipe known as macaroni pipe. An ingenious man, knowing how to spin flour into a pipe, it occurred to him to take red-hot iron and spin that into pipes by machinery in the same way as the flour was spun into a pipe for macaroni. That was not an invention as it turned out, but had that been so, and had he been able to spin the iron in the same way as the flour was spun into pipes for macaroni, few men, I think, would deny that there was an invention there, it being a product so completely new, and that it would be an invention for making a new manufacture which others did not make, because the result was so totally different, even although in fact the

machinery which was used for the purpose, except that it was made stronger, would be identically the same as the machinery originally used for the purpose of making the macaroni. But that is a totally different thing to this case. In this case the same thing was used clearly for the purpose of producing a quicker or a slower motion to the revolving axis which is afterward to be used (and in that there is no novelty at all) to be applied to a purpose to which already a revolving axis had been applied.

GROVE, J.—The real difficulty which occurs in this case is in the application of the law rather than in the law itself. The application of a given machine to a cognate purpose is a phrase which involves the question what is a cognate purpose, and as that may be a question of degree, it is difficult rather in the application than in the definition of the law. As far as I know, no terms can be used which will so absolutely exclude any possible misconception as to lay down an abstract definition of what is not the subject-matter of a patent because it must involve something plus the mere terms used in the limited definition. The question is, is the purpose to which this is applied a cognate purpose? It has been admitted that if a man had *Nicholson's* machine and had the patented machine in this case, that he could (supposing them to be of the same size) take off the wheel of *Nicholson's* machine and apply it to this machine, and it would produce the required effect. That is to say, *Nicholson's* being a machine for tedding hay, that the same change of velocity effected in the hay-tedding machine by identically the same wheel being applied to a well-known machine in other respects to which the plaintiff applies this wheel, would produce the effect desired of the patentee. Is that or not a cognate purpose? The purpose is being able by the same wheel with the same axis, not changing laterally the position of the pinion, but only changing it longitudinally in the direction of the axis to enable it to work on the inner periphery, which is larger than the periphery of the composite wheel, precisely the same identical wheel, and produce the same effect as the identical wheel of the other, that is to say, to enable it at will, by altering the pinion, to work on one or other at a greater or a diminished velocity. That appears to be something very much nearer than a cognate purpose. It is mechanically considered the same purpose identically.

Crane v. Price has been cavilled at, and only can be upheld on the ground that there a new product was produced of a different

class and character. Whether it is supportable upon that ground or not, some learned judges have doubted. But that is the ground, if any, upon which it is sustainable.

It is true that in the present case the patentee in the introductory part of his specification does call it a combined reaping and mowing machine, and that constitutes his claim, no doubt because the claim at the end is merely the usual flourish put into patents, but the real claim is the first part of the specification; but a patentee cannot make a combination within the meaning of the patent law by calling it a combination any more than in the case of a lock on the door. A lock might be put on to a window which had been put on to a door, and it may be called a combined door and window lock. But that is not a combination in point of law, which must be a combination producing a new and useful result. I do not see anything to show that this is a new combination, because the wheel being admitted to be old, the working of the wheel being admitted to be old, and the mode being the same in which it applied in the one case as in the other, what was required being a different velocity for one purpose, whereas it was applied to a machine before which required a different velocity for another purpose.

BARLOW v. BAYLIS.

[1870. Not reported.*]

Anticipation by useless Machine.

Case for infringement of patent, granted the 22nd April, 1854, to *H. B. Barlow*, for "improvements in manufacturing metal nuts and in machinery for stamping, forging, and rolling the same" (a communication, &c.) The part of the machinery material to this report was for cutting nuts from a heated bar of metal: by one operation it cut from the bar the blank or piece to be formed into the nut, pressed or swaged it into shape, and punched the eye through it while still highly heated. The specification gave a description of the machinery employed, and stated:—*I claim* as of the said invention . . . 2. Manufacturing nuts by cutting off a portion of a heated bar or plate, swaging it into shape, and punching a hole or eye through it as described.

The action was tried at *Manchester*, before BRETT, J., and a special jury. The main contest at the trial was whether a machine which one *Berry* had patented in 1852, No. 494, was an anticipa-

* For the notes of this case I am indebted to T. Aston, Esq., Q.C.

tion of the plaintiff's machine. It was a subject of contention whether *Berry's* machine would or would not work.

BRETT, J., directed the jury :—

The first thing to be considered in the matter is, what is the invention which the plaintiff says he has introduced into this country? That depends, of course, upon the specification of his patent; and it is for me to lay down what the invention is which he claims.

He first says, what I claim is that I have invented a machine, which by a single operation will cut from the bar or plate the piece which constitutes the blank, which will swage it into shape, and punch the hole or eye through it while highly heated; but then he goes on and says that there are particular means by which he arrives at those results—that is, that in order to swage these nuts properly he will compress the nuts to make them solid, and to shape them with smoothness and precision by subjecting them, while heated, to powerful and sudden compression between a pair of swages while in the punching die; and then he says that “in compressing the nut before the hole or eye is punched, in order that any surplus iron that may be in the die box may escape into the holes in either swage,” he will compress the nut so as to do that; and then he says that, having got into that position, he will, while it is confined in a die or press box, by which it is firmly supported and prevented from bursting or straining during the operation, punch the eye.

It seems to me, therefore, that what he claims is this: he claims to have made a machine which, by a combination of instruments, will perform an operation, and will perform what he wants by a single operation; but then he does not say, as I understand him, that all the means are old means. He says that some of those means are new in an instrument or in a machine used for the purpose of making nuts. He says, I introduced certain new instruments into a machine for making nuts, and then I used those new means by a new combination, so as to produce my result in a single operation. Now, then, I take his view of it to be this. He says up to the time when I introduced this machine nobody had used a machine in England at all for the purpose of making nuts; nobody had commercially used any machine for making nuts—they had been made practically by hand. It is true that before I introduced this machine a Mr. *Berry* had very nearly invented a machine which would work, but he had not quite; he had made experiments, as it is said in one sense he had tried to

invent a machine, but he had failed in making a working machine at all, and he had given it up; but then I introduced this machine, and my machine would do what I say I intended it to do, or the inventor intended it to do.

* * * * *

Now the first question about *Berry's* machine which I will ask you is this: Was *Berry's* ever a machine or invention in this sense, that a workman could, from his specification and drawings, make the machine described by him so that it would more or less badly do the work required of it? I will give you the questions afterwards. Was *Berry's* ever a machine or invention in this sense, that a workman could, from his specification and drawings, make the machine described by him so that it would more or less badly do the work required of it? Because, in my opinion, if it would not, I do not say perfectly, but if it would not do the work required of it, it was not an invention at all, or a machine in a business sense.

* * * * *

It has been asked by both sides that you should look at the specifications and the drawings, and therefore you shall, and it will be for you to say; and that is the first question I will put to you, whether, in your opinion—for it comes to that at last, taking the evidence on both sides—you are of opinion that *Berry's* machine ever was a machine or invention in the sense I put it to you, that is, that a person of competent skill, from his specification and drawings, could make a machine described by him, so that it would more or less badly do the work required of it? I put the words "more or less badly" because I do think that if the only defect in the machine was some defect in the levers, which any workman could find out at once, if it would make a nut, though badly, that would not prevent it from being a machine.

There is one other point to which it is necessary to call your attention. The defendants say, we will show you that it will make a nut, for we will make a nut before your face. Then they bring in that model. But then it is said on the other side, "You do not make a nut as a matter of business by that model brought into Court; you may make a nut of clay, that is not a nut for business purposes; you may make a nut of lead, that is not a nut for business purposes; what we want is an iron nut, and that you cannot make with that machine or any machine described by *Berry*." They say that that is not a fair test, and more than that, they say you have not made that model according to the

drawings and specification, because you have made the lower plunger so as to make it meet the upper one; whereas *Berry* had not seen that; therefore you have not made your model by *Berry's* machines, you have made some other machine which is an improvement, that is, you have, by the help of the plaintiff's machine, discovered the mistake *Berry* made and the defect there was in *Berry's* machine. That is what they say. If you think *Berry's* was not a machine in the sense I put it to you, then it seems to me the defendants cannot rely upon it at all as a prior invention—it is not an invention at all.

The jury found that *Berry's* machine would not do the work more or less badly. Judgment for plaintiffs.

A rule for a new trial was discharged by the Court of Common Pleas.

BARNETT v. BARRETT'S SCREW STOPPER BOTTLING COMPANY, LIMITED.

[Feb. 15th, 1884. 1 O. R. 9.]

Threats—S. 32—Interlocutory Injunction—Practice.

Action under s. 32 (*supra*, p. 14) to restrain the issue of circulars by the defendants, stating that certain stoppers for bottles made by the plaintiffs infringed the defendant's patent, and threatening legal proceedings against all persons who used such stoppers. Motion for an interlocutory injunction.

It appeared that since this action was brought, *Barrett*, a patentee of an invention for screw stoppers, had brought an action against the plaintiffs for infringement. The defendants had an exclusive licence to use *Barrett's* invention within twelve miles of Charing Cross, except for bottles for mineral and aerated waters. It was contended that as the defendants could bring no action for infringement, they could not justify the issue of the circular though *Barrett* had brought an action.

PEARSON, J.—I do not mean in the slightest degree to suggest any impropriety; but I do see this, that a motion of this kind being made, a defendant might, simply to stave off proceedings, issue a writ and nothing more; and then, when it had served his purpose, he might discontinue the action, and the Court might be in great difficulties to know what to do. If a new motion were made, the defendant might say, "I do not mean to continue writing any more letters or circulars;" and then the answer to the motion would be, "You cannot get an injunction; because

we have told you we do not mean to write any more letters or circulars ; and the mischief is done." Therefore I think the wiser and better course will be simply to adjourn this motion until the result of the action is known, with liberty to any person to apply ; and reserving all question of costs.

BARNEY v. UNITED TELEPHONE COMPANY.

[Feb. 6th, 1885. 28 Ch. D. 394 ; 52 L. T. 573 ; 33 W. R. 576 ; 2 O. R. 173.]

Threats—S. 32—Interlocutory Injunction—Practice.

Action to restrain threats brought under s. 32 (*supra*, p. 14).

The plaintiff having advertised that he was prepared to supply customers with the Boulton telephone, the directors of the defendant Co. issued an advertisement warning the public that they were advised that the Boulton telephone was an infringement of their patent rights, and that proceedings would be taken to protect their rights. Thereupon correspondence ensued ; but the defendants' solicitors refused to make the plaintiff sole defendant in an action for infringement, on the ground that he was not in a position to pay damages or costs. Thereupon this action was commenced, and the plaintiff now moved for an interlocutory injunction.

CHITTY, J.—I will assume for the purpose of this judgment that it comes within s. 32. Under that section the Court can grant an injunction against the continuance of the threat ; and that I am now asked to do. But the section contains this condition : " If the alleged manufacture, &c." Now it appears that there is a serious question between the parties as to whether there is in fact an infringement or not. There is a conflict of testimony on the point, and it is a question which I cannot decide on the present materials. That being so, there can be no injunction granted, because the plaintiff is unable to prove that there was not in fact an infringement, and he is not able even to present to the Court such a case as would show that probably even at the trial that result would be brought about. That being so, I have nothing to do with the proviso at the end. I only deal with that condition precedent which is found in the section itself ; and I refuse the motion. Under the circumstances of the case, I will let the costs be costs in the action.

BINNEY v. FELDTMAN.

[1871—5. Not reported.*]

Subject-matter—Infringement.

Suit by assignee for infringement of two patents, the first granted 5 *Mar.* 1867, No. 613, to *G. Haseltine*, for “Improvements in the manufacture of packing for joints of steam engines” (in part disclaimed); the second granted the 29th *April*, 1867, No. 1234, to *G. Davies*, for “An improved packing for stuffing boxes” (both being communications, &c.).

Haseltine’s specification pointed out the difficulty of using the ordinary hemp packing, on account of its being rapidly destroyed by the action of the heat and being reduced to a powder, and that in his invention he used dry powdered substances combined with fibrous materials, which withstood the heat and rendered lubricants unnecessary; he then went on to shew how he made his packing, taking a mixture of dry powdered soapstone and asbestos, and mixing it with suitable fibrous material. The specification stated:—“A braided, twisted, or plaited packing is used, and the powder may be worked well into the fibrous material while it is being manufactured into the required form, such as a gasket or rope; or the fibrous material may be first plaited or braided, and the dry powdered material afterwards worked into it.”

Claim: “A packing composed of dry powdered substances, combined with braided, twisted, or plaited fibrous material substantially as set forth.”

Davies’ packing consisted of a core of fibrous strands, impregnated with powdered mineral lubricant, and surrounded by a woven, knitted, or braided covering or stocking, through which the powder gained access to assist in lubricating the surface with which the packing was in contact. By his specification he pointed out a mode of impregnating the fibre with lubricant by taking the fibrous strands and passing them through the powder: they were then collected and formed into a loosely twisted rope. He stated he did not claim the application of dry powdered substances as a lubricant, nor the combination of such substance with fibrous materials for the manufacture of packing.

Claim 1: A packing composed of fibrous strands impregnated with powdered mineral lubricant, combined with a cover of braided, woven, or knitted fabric.

The defendant manufactured under a patent granted to him 15th

* For the notes of this case I am indebted to T. Aston, Esq., Q. C.

March, 1871, No. 692, for "improvements in packing for the joints of steam engines."

He used a woven cover of fibrous material lined with one or more layers of cotton wick, the central space filled with soap-stone or lubricating material either dry or moist.

Wickens, V.-C., gave judgment for the plaintiff.

On appeal the Lords Justices (James, Mellish, L.JJ.) entered judgment for the defendants.

JAMES, L.J.—The use of packing composed of fibrous materials woven, braided, or knitted, or in any other form, is nothing new; everybody knows that if you want to pack a thing close you may pack it either with unwoven or untwisted material, or with material braided, twisted, or plaited. It is nothing new to use a mineral lubricant instead of oil, and therefore it could not be, in my view, the subject of a patent to use either fibrous strands or rope, or any other braided, woven, or knitted fabric, combined with mineral lubricant, that is to say, in the sense of mainly using the two things together. A person might put the packing into the box, might put the powder into the box, might put in both these; it would be impossible for him to say I put the powder and fibrous material in a particular form together: that would not be sufficient to sustain the patent.

At first it occurred to me that *Haseltine's* patent was clearly bad, because it seemed to be in terms claiming a packing merely composed of the joint use of a powdered substance and the braided materials; but it appears to me that that view is not the correct view, and giving that benignant interpretation which every instrument is entitled to have, and looking to the words "substantially as set forth," I think the patent was for a manufacture substantially of the character which he has described before, that is, a manufacture of a braided packing, twisted or plaited, in which the powder was worked into the fibrous material while it was being manufactured into the required form, such as a gasket or rope, or in which the fibrous material being first plaited or braided the dry material is afterwards worked into it; in both members of that sentence there being a process of manufacture or a process of working by the manufacture. Everybody knows that the practical result of putting the fibrous material, whether woven or not, and the powder together is that the powder would get through the fibres in the same way as flour does through a sack. But a man cannot say, "I claim a particular mode of manufacture. I therefore prevent a conjoint use of the two materials together, in

which, as the result of the use of them in the ordinary course of use, the same thing would happen which I say was done by me intentionally."

It was open to *Davies* to invent new modes of transporting the powder in conjunction or combination with the materials of the packing so as to be useful for the desired purpose. It was open for him to do it, and if he invented any convenient combination for doing it of course that would be the subject-matter of a patent. But as the only thing that could be patented was the mode of manufacture and the particular mode of combination, it was open to all the rest of the world to exercise their ingenuity in the same way to see if they could not invent some other mode.

On appeal to the House of Lords, appeal dismissed.

CAIRNS, L.C., referred to *Haseltine's claim*, saying :—

Departing from the general reference to the fibrous material, when he comes both to his description and to his claim, he limits himself to fibrous material in this form—braided, twisted, or plaited—and he points out that the powdered lubricating substance might be either worked into that braided, twisted, or plaited material in the course of its manufacture, or might be worked into it after it was manufactured. There is no pretence for saying here that the defendant used any braided, twisted, or plaited fibrous material which had been saturated with the powdered lubricating substance in the course of the manufacture, or into which powdered material was afterwards worked in as a braided, twisted, or fibrous material prepared to receive it.

I have already said that *Haseltine's* patent may have been an extremely ingenious and extremely useful one; but it was open to this objection, that the powder having been worked into this plaited or braided material in the carriage of the material, the powder which had been so worked in and so saturated would be liable to escape before it was put into the stuffing-box where it was to be used. It appears that by *Davies'* covering to my mind this is provided for in the specification which I am now about to refer to. His Lordship referred to passages from it, and continued :—

We are carried to the course of manufacture in which the strands are taken and introduced into a trough or box where the powder is already provided. They are opened, separated from each other, and they are covered with and rolled in the powder until they are thoroughly saturated with it. And, accordingly, if your Lordships will look at the drawings you will find that you

have a fasciculus of strands which have been twisted together. After they have been thus saturated and impregnated with the powder, then the fasciculus of strands receives a twist; and so saturated and so twisted, the strands are then enclosed in the stocking or covering which is placed about them of web-work.

His Lordship then read a passage from *Davies'* specification—"Although a mode of manufacturing the packing has been described it will be evident that the process may be varied and different appliances used in carrying the invention into effect,"—and said:—The inventor therefore does not limit himself to any particular mode of producing his new manufacture. I refer to that, my Lords, merely for the purpose of observing that that cannot give him a greater right than to that which he has substantially before described, and in fact those are merely the comprehensive words which occur in every patent, but which really do not carry the patent farther than in substance is described. There is no question here as to a claim of these powdered substances as a lubricant; there is no question as to a claim of mere combination of this lubricating substance with fibrous materials.

His Lordship then read *Claim 1*, and said:—

As I understand the meaning of words, this is a claim—a distinctive claim—of a packing of fibrous strands already saturated with the powdered lubricant, and then after they have been so saturated and so prepared, enclosed and combined with a braided cover of wool or hemp.

The respondent prepares a bag or cylinder of woven textile fabric. That bag or cylinder has a lining. The lining is a lining made of parallel strands of fibrous material or cotton wick. The effect of the whole is that he has a bag or cylinder, the external surface of which is of a soft, spongy, fibrous character; and then having that bag or cylinder he fills up the bag or cylinder with powdered lubricant. He has therefore a bag or cylinder, larger or smaller as the case may be, filled up with an internal column or pillar of the powdered lubricant; and then the bag being fastened, or the cylinder being fastened or closed at the top and bottom, this is put into the stuffing-box. The powder, of course, will naturally work its way out by a mechanical process with greater or less rapidity through this enclosure, and will carry to the outer surface some of the lubricating material which is enclosed within.

Well, now, is that or is it not any infringement of the previous patents to which I have referred? Of *Haseltine's* patent there

can be no infringement. There is no braided, twisted, or plaited material in the case. Is it an infringement of *Davies'* patent? The only way in which it could be said to be an infringement of *Davies'* patent is that which was argued by Mr. *Lindley*, and with great skill and ingenuity by Mr. *Aston*.—He said, “You have got here strands—the strands, namely, playing the part of the lining of the textile bag or enclosure for the powder. Those strands may not be saturated when they are, in the first instance, placed as a lining of the cylinder; but if you put inside of them a pillar of powder, that pillar of powder will saturate them by mechanical consequence as the cylinder is carried about, taken from place to place, and placed finally in the stuffing-box. And therefore,” said the learned Counsel, “you will have, not at first—not when the article is manufactured, not when it is sold,—but after it has been carried from place to place,—you will have strands saturated or impregnated with the powder, and enclosed in a cover or stocking of webwork which is placed around them.”

I think it is fair and better to assume that there will be that communication to a considerable extent. I think it better to assume that the effect of filling up a cylinder such as I have described with powder, will be that with the natural friction the mechanical operation of movement with the outside lining, the cover and the face of that cover—whatever it be composed of, be it strands or any other absorbent material—the powder will be absorbed into and will saturate the inside face of the covering. Let that be assumed, I ask, is there any infringement of *Davies'* patent?

My Lords, I do not so view it. As I view *Davies'* patent, it is a claim purposely, clearly, and designedly made, not as to what may be the consequences of the mechanical contact between the powder and the outside lining, but to cover a designed impregnation and saturation of fibrous strands before they are inclosed in any covering at all, placing them together in what I have termed a fasciculus, and then afterwards inclosing them in an outside covering. Then, my Lords, it appears to me that the ground was perfectly open and perfectly clear to any person who might discover that it was a much better thing not to impregnate strands at all—not to impregnate any braided or plaited material with powder—but to provide a bag or cylinder with an inside surface of an absorbent or spongy description, and then to fill up that bag or cylinder with powder in bulk without any change, without any previous application of the powder. It appears to me that the

result of that discovery would be the production of an article useful and more easy of application, more beneficial in its application, and more cheap in its application, than the old or previous patent.

Lord HATHERLEY referred to the defendant's article, saying :— It corresponds with *Davies'* patent in having an outer covering for what you are about to use, but within that outer covering he has nothing at all which interferes either with *Haseltine's* or with *Davies'* specification; because he has not there any braided fibrous material saturated with powder, he has no rope or cord or gasket saturated with powder; but he simply lines his bag with the fibrous material; and then he has the powder separate and entirely apart from the fibrous material, and in no way worked into it. That is the state in which he sells his article; and I apprehend that the accidental circumstances of the carts in moving this powder—possibly combining it to a greater or less extent with the fibrous material, a combination which would differ according to the distance for which it was carried, and according to whether it was carried by railway or by a jolting waggon—I apprehend that that circumstance can have no effect in ascertaining whether or not he is selling an article which is the invention of another.

BRERETON v. RICHARDSON.

[1883—4. 1 Off. R. 166.]

Anticipation—Experimental user.

Action for infringement of a patent granted the 18th September, 1879, No. 3756, to *W. & J. Brereton* for "a new or improved tricycle." The invention related to a mode of dispensing with driving bands or chains or cog-wheels by adopting a method of driving by means of pedals and cranks.

The action was tried before FIELD, J., sitting without a jury, who dismissed the action, holding that the alleged invention had been anticipated by the user by one *Jackson* and his family of a tricycle constructed by him. It was argued that this was mere experimental user, but as to this the learned Judge said :—Their driving to Cheam, Worcester Park, and Malden; going about on business night and day, and for pleasure; and the public notoriety which the thing had excited in the neighbourhood, so that it was called "*Jackson's* patent threshing machine," all satisfy me that, provided I am right in holding that the thing was substantially the same, it was publicly used. A question of difficulty

occurred to my mind as to what degree of public user is enough when you have to deal with a thing like that. I quite understand that if there were at this moment an axle running under an omnibus which I could not see, it might or might not be a public user. I think it would be a public user.

The learned Judge therefore dismissed the plaintiffs' action with costs.

BRIGGS v. LARDEUR.

[1884. 1 O. R. 126, 192; 2 O. R. 13.]

Interlocutory Injunction—Adding Defendants.

Action for infringement of a patent granted to *John Briggs and others* the 30th December, 1874, No. 4471, for "improvements in ornamenting and transferring patterns to fabrics." The invention related to a mode of printing patterns on paper so that such patterns could be transferred by heat from the paper to the material to be ornamented.

The action was commenced on the 8th May, 1884, and on the 20th May the plaintiffs gave notice of motion for an interlocutory injunction, which was granted.

FRARSON, J.—Whether this is a good patent or not, I think I ought not to consider at all on the present motion, unless I can see, on the face of it, that it is so irretrievably and hopelessly bad that it is absolutely impossible that it could be supported. In a case so plain as that, I doubt not I might consider it on interlocutory motion; but when the patent has been in existence for ten years, and has not been challenged at the end of ten years, I think this Court ought to give credit to the patent, and ought to assume, at all events, upon the interlocutory motion, that for the purposes of the interlocutory motion the patent is a good patent; of course, leaving it entirely open till the case comes on for trial to determine that the patent is as bad a patent as was ever taken out. 1 O. R.
128.

The defendants appealed, and offered to keep an account, and an undertaking to sell all patterns until the trial with a direction that they are to be transferred by chemical solvents only, and not by heat: this was accepted by the plaintiffs. 1 O. R.
192.

By their defence the defendants alleged that they had, since action brought, sold their business to a company, and they obtained an order at chambers to add the company as defendants. This was a motion to discharge the order. 2 O. R.
13.

PEARSON, J.—This is a novel proceeding altogether; not included in any rule, contrary to all principle. The defendants go and ask that some persons to whom they have assigned in the meantime, *pendente lite*, may be made defendants. The plaintiffs say, “We have no case against them or any evidence that they have done anything of which we complain, and we decline.” Then *brevi manu* an order is made against them to add the company as defendants in the action. The order must be discharged with costs.

Codd v. BRATBY.

[1884. 1 O. R. 209.]

Amendment of Specification under s. 19.

A patent was, on the 24th November, 1870, No. 3070, granted to *Hiram Codd* for “improvements in bottles and in the mode of stopping the same.” In 1883 *Codd* commenced an action against one *Bratby* and another for royalties and for infringement of the patent. On the 7th July, 1884, *Codd* applied at the Patent Office for leave to amend. This was opposed by the defendants in the action and refused by the Comptroller, see *infra*. The plaintiff thereupon, on the 8th July, gave notice of motion for liberty to apply at the Patent Office under s. 19, *supra*, p. 9.

CHITTY, J.—It is conceded for the applicant, first, that the amended specification is not to be put in evidence at the trial; secondly, that no evidence is to be given of any infringement prior to the amendment of the specification. Besides that, it is conceded that the applicant must pay the costs of this application, and all the costs that have been thrown away in the action.

His Lordship then referred to the contention that a condition should be imposed on the plaintiff that he should not in any way sue the defendants on the amended specification, and said:—The result of my acceding to this part of the argument would be, that I should be giving to the defendants, practically and substantially, a license to infringe the plaintiff’s patent when amended, and it seems to me that, in the circumstances of this case, that would be going too far, and that is a term which I do not propose to impose upon them. There may be cases in which it would be right to impose such a term. I am not satisfied in the case before me, on the evidence, that the defendants are right in their attempt to impute knowledge to the plaintiff many years ago of the invalidity of his patent; if that point were made out, I think

the case might stand on a different footing, because then I should have the case of a patentee with knowledge of a defect in his patent, lying by until within a very few months of the expiration of his patent, and I should have on the other side, the defendants saying that they were aware of the invalidity of the patent, that they were advised that the patent was invalid, and that they set up a trade and incurred great expenditure on the faith of the invalidity of the patent. If this case had been brought up to that point, I think it would have been a matter of very grave consideration whether I should not have acceded to the application. It is alleged on the part of the plaintiff that the defendants have been the licensees under this patent for a period of seven years before the commencement of the action. I cannot take that as proved, because that is one of the issues in the action. The other alternative is that if the plaintiff does not succeed in establishing the license, then it is an action for infringement. The terms which I have proposed will clear the defendants entirely of any infringement prior to the amendment, and as against the defendants, of course I cannot hold that the license is established, but if the license is established, then the case would be still harder on the plaintiff if I were in fact to grant to the defendants, as I should be doing by imposing the terms asked for, a license to work the patent.

The order provided that the plaintiff should pay the costs of the previous application to the Comptroller.

COLES v. BAYLIS.

[April 21st, 1886. 3 O. R. 178.]

Injunction—Proposed Licensee—Sufficiency of Specification.

Action for infringement of a patent granted the 11th July, 1884, No. 10,073, to *Lake* (a communication from *Eberle*), for "Improvements relating to the preparation of lithographic printing surfaces."

The complete specification was left at the Patent Office, on the 26th February, 1885. In July *Coles* acquired the patent, but the patent was not assigned by deed till the 3rd October, 1885.

This action was commenced the 1st February, 1886, and the plaintiff moved, before BACON, V.-C., for an interlocutory injunction.

The invention related to a mode of preparation of printing surfaces, and consisted in applying designs thereto with materials, which were then fused by an open flame, so that they formed

enamelled reliefs. The defendants had been in correspondence with the plaintiff with a view of taking a license. The invention as specified was useful, and the infringement was not denied; but it was said that the specification did not shew the best way known to the inventor of carrying out the invention, and reliance was placed on certain instructions how to work the etching process after the stones had been prepared, sent by *Coles* to one *Smith*, to whom a license had been granted, dated 18th *February*, 1885.

Injunction granted.

BACON, V.-C.—These are instructions for working the invention; the invention is completed when the conditions of the specification have been carried into effect. There is nothing in the specification that proposes to show persons how they may work this (the etching process). It shows them how to make a stone, which, if they followed the specification accurately and distinctly, they can work with, that is to say, any competent man can work with. And it must be borne in mind that in this art part is merely mechanical, and part is eminently artistic. The artistic part of it of course applies to competent workmen. It is to be said that the specification not lodged by this plaintiff, but lodged by a person from whom he bought it, and therefore bought it with all its infirmities, if it had any, is bad, because he knew a mode by which a stone prepared according to the specification may be more conveniently or more usefully worked than anybody but himself knew, that he was bound to put that into the specification. I know no authority for saying that. The plaintiff is entitled to an injunction to restrain the defendants, to whom he has communicated the mode of working this invention, from practising it till the action shall be heard.

COUCHMAN v. GREENER.

[1881—4. 1 O. R. 197.]

Test of Infringement.

Action by assignee of a patent, dated 11th *May*, 1875, No. 1756, to *W. Anson* and *J. Deeley*, for “Improvements in breech-loading small arms,” against a licensee for royalties. The invention related to guns in which the barrels turn on a joint, the open breech-ends being raised from the break-off during charging, and shut down and fastened against the break-off during discharge, and consisted essentially in prolonging the fore-arm

backwards so as to act on the hammer lever and cock the gun.

The specification described the invention in detail with figures.

Claim 1: "The construction and combination of the parts of lock mechanism hereinbefore described and illustrated in figures 1, 2, 3, 4, 4A, 5, and 6, of the accompanying drawing for cocking the said guns and pistols by the raising of the breech-ends of the barrels for charging; that is to say, converting the ordinary fore-end into a lever by prolonging the said fore-end backwards into the body of the gun or pistol, the said prolonged part constituting the short arm of a lever, which short arm, on the raising of the breech ends of the barrels, acts upon and cocks a hammer or a striker lever substantially as described and illustrated, whether the said hammer or striker lever act directly upon the cartridge or upon a loose striker."

The defendants denied that the guns manufactured by them were within the patent. At the trial, before Pollock, B., the action was dismissed with costs. Appeal to the Court of Appeal (Brett, M. R., Lindley, Bowen, L.JJ.).

Appeal dismissed.

BRETT, M. R.—The case of the plaintiff is that, as the gun of the defendant is made, it is the same gun as his; and that the fore end of the defendant's gun, used as it is, and so joined as it were, although not actually joined, but working as if joined to that movable rod and then to the movable hook,—working, I say, in that way,—the plaintiff contends that it is the same lever as the plaintiff's lever. It seems to me that if two things are alike, and you do the same thing to both, that the same thing ought to have the same effect upon both. That seems to me to be a logical proposition, and I am about to act upon that proposition. If it be a true proposition, when you put a pin through that movable rod which is part, according to the plaintiff's case, of the lever, if you put a pin through the short arm of the plaintiff's lever (because I am putting the pin upon the defendant's gun through what is called the short arm of the lever by the plaintiff),—if you put a pin through the corresponding arms in both guns, it seems to me it should have the same effect upon both, whereas if you put a pin through the plaintiff's short arm, nevertheless the plaintiff's gun will not act if you take the fore end away, and in the defendant's gun it will. Therefore, doing the same thing in exactly the same equivalent position to both, it produces a different effect, and that shows, to my mind, that the two things

1 O. R.
200.

are not alike. That is the chain of reasoning by which I arrive at that conclusion; and it shows to me, and convinces my mind as a matter of mechanical fact, that although the fore end of the defendant's gun is used for the purpose of cocking, and, as I say again and repeat, although without the use of it the defendant's gun could not be cocked,—that chain of reasoning convinces me, as a matter of fact, that the fore end upon the defendant's gun is not used and does not act as the long arm of a lever, and therefore it is outside the combination as claimed by the plaintiff.

Appeal to House of Lords (Lords Blackburn, Watson, Fitzgerald). Appeal dismissed.

CROPPER v. SMITH.

[1882—5. 26 Ch. D. 700; 53 L. J. Ch. 891; 51 L. T. 729; 10 App. Ca. 249; 55 L. J. Ch. 12; 28 Ch. D. 148; 54 L. J. Ch. 287; 1 O. R. 81, 254; 2 O. R. 17, 61.]

Validity—Benevolent construction—Estoppel—Joint Defendants—Particulars of Objections—Practice—Certificate—Disclaimer—"Pending" Action.

Action for infringement of a patent granted to *James Hancock*, the 11th August, 1873, No. 2672, for "Improvements in bobbin, net, or twist lace machines." Subsequently to the grant of the patent the grantee's affairs were liquidated by arrangement, and the patent became vested in one *Mellors*, as trustee in the liquidation, and on the 20th April, 1877, the said *Mellors* assigned the patent to *Cropper* and others, the plaintiffs in this action, for a sum of £61, by a deed which was registered at the Patent Office. In the year 1880 *James Hancock* entered into partnership with the defendant *Smith*, and it was proved at the trial that they had infringed the patent by certain lace machines manufactured by the partnership, and this action was brought against them therefor. By their joint defence the defendants denied the validity of the patent, but delivered no particulars of objections. On the day before the case would have been in the paper for trial the defendants obtained leave to sever in their defences, and on certain terms were allowed to deliver the particulars of objection described in a schedule to the order, but the particulars of objection on the ground of novelty were in form delivered by the defendant *Smith* alone.

The specification of the letters patent related to improvements in the arrangement of the old parts of lace machines, which were usually constructed with two end standards, and to unite these

and to give the machine rigidity it was usual to attach rails to them rather below the middle, in front, and at the back. Part of the improvement consisted in removing these rails and replacing them by a broad floor-plate, whereby more light and space was obtained in the middle for the warp beams. The specification described the machine minutely with reference to *figures* and *letters*, the floor-plate being designated by C.

Claims: 1. The general arrangement and combination of a twist lace machine constructed as herein-before described and illustrated in the drawings annexed. 2. For one or more pair of brackets, E, which support the axles of the knocking-out levers, the two draw-shafts and the cam-shaft, and for the double-ended brackets or levers, N, carrying the arms, blocks, and trucks, which operate the point-bars. 3. The central longitudinal plate, C, connecting the end standards, and to which the front vertical stay cradle and back stay are secured.

The action was tried before PEARSON, J., who upheld the patent, and granted the relief asked for.

PEARSON, J.—I entirely agree that to claim a patent for that, 1 O. R. 85. in the largest possible sense, namely, to say that this person has invented the floor-plate, and that you could not use a floor-plate either in a lace machine or any other machine that might be invented, because of this patent, would be to make the claim perfectly ridiculous. But then the moment you have arrived at that you have arrived at this rule of law which prevents your giving this construction to that 3rd claim, because the rule, as I understand it, is as plain as can be, that no man is to be considered to have claimed something which is perfectly absurd, and which it would be foolish to suppose he had claimed, in order to make the patent a bad patent.

He then claims by his 1st claim for a new invention the general arrangement and combination as there described, and then I think in the 2nd and 3rd he merely states the different parts of the machine, which he has so arranged and combined in order to state more definitely and specifically the arrangement and combination which he claims to have patented.

Now that being so, I think it unnecessary to discuss very much 1 O. R. 86. what is the proper reading of that 2nd claim, which undoubtedly is very ungrammatical and very inaccurate, because whether you strike out the "for" and say the second "for" is a mistake altogether, or whether you leave the two in and take them in as two independent sentences, the result is just the same. There is

nothing to my mind to lead to the 2nd and 3rd claims claiming more than in fact the 1st claim, and that being so, I hold the patent to be good.

Appeal to the Court of Appeal (Cotton, Bowen, Fry, L.JJ.), who, on the 3rd *March*, 1884, held the patent to be invalid, and dismissed the action as against *Smith*.

COTTON, L. J.—I do not intend to base my judgment on the 2nd claim. . . . Whether or no that would be novel, especially if divided into two parts (upon which, if one is to give an opinion, I do not think it is), it is unnecessary to consider.

1 O. R.
88.

His Lordship referred to the claims, saying:—The object is that here the patentee may say, I claim this, disclaiming everything else; and when one does find in a claim particular subdivisions, namely, 1st, 2nd, and 3rd, I am of opinion that it would not be right to say that when the 1st is as to general combination, the 2nd and 3rd are only to be considered as pointing out, though they are put by way of claim, that which the patentee considers material. Undoubtedly in his description he may do that as he pleases, but when we do find that he claims, first of all, the general combination, with a previous declaration I declare that I claim 1st so and so, 2nd so and so, and 3rd so and so, in my opinion, according to the fair construction of the language, and having regard to the use of the claim, it would be wrong to say that he is not intending to claim as that which he protects, 1, 2, and 3; and therefore one must deal with this as if No. 3 was, as in my opinion it is, a claim to an invention, to be protected by the patent, that is to say, he treats his claim, not only as a claim for the entire combination, but also as a claim to those subordinate combinations which are introduced into it, and help together with other things to make the entire combination.

It was said, that one ought to interpret, in favour of a good inventor, benignantly the construction of his specification. Now I am not satisfied to what cases that is to be applied. If it is to be applied to cases where the objection is that the specification is of such a character that it does not describe sufficiently the nature of the invention, that language may bear perhaps the not unreasonable interpretation, that you are to get all the knowledge you can with reference to the subject-matter of the patent, and then you must, in an intelligent frame of mind, and not in a frame of mind which shuts its eyes to what is possibly not stated as clearly as it might be, consider what is the real meaning of the specification, not only of itself, but having regard to the knowledge existing at

the time, and which would exist in the minds of those to whom the specification was addressed. Of course the judicial mind does not know, without evidence, all the facts which persons engaged in the trade would know, and it is merely saying, "Now try and put yourself in the same position as regards knowledge as those to whom the specification was addressed, and then reasonably and intelligently construe it." If that is so, I quite assent to it, but, in my opinion, it would be wrong in a case like this, simply having regard to the result, whatever it may be, to give otherwise than a fair interpretation to the language which has been used by the patentee in describing, not how his invention is to be performed, but what he claims as protected by his specification,—what it is that he claims as part of the monopoly granted to him. Possibly the language was used in cases to meet what, at one time, I am afraid, was the sort of view with which these things were construed, which was,—construe them as strictly as possible against the patentee, looking at him as a sort of enemy of Her Majesty's subjects generally. But I am of opinion that one ought to construe this specification fairly and reasonably, and in my opinion, on that construction, it bears the sense which I put upon it.

One has in evidence, which one would have known if there had been no evidence, that it is a most usual way, in all kinds of machines where the parts of the machine which constitute the frames are standards and intermediate supports, to give rigidity by combining those together at or near the ground by a flat bar or plate. That is the evidence, I think of one of the plaintiffs' own witnesses, that it is usual in machinery to have a bar or floor-plate. Well, that being so, it is an old combination, not, it is true, a combination found in lace machines, but then an old combination used for one kind of machine cannot be said to be novel for the purpose of supporting a patent unless there is some ingenuity or invention in applying it to the machine in which, though it is used in other machines, it has not been previously found.

As far as I can see, there is no modification at all of the machine in order to enable this to be produced in the lace machine. It is, however, true that using this means of obtaining rigidity does enable other improvements to be made in the machine, because it gets rid of a great deal of hamper in the lower part of the machine, and enables a vast number of warp beams to be used which formerly could not be used where the rigidity was obtained,

not by a floor-plate, but by side bars running more or less up the frame-work of the machine; therefore, there was no invention and no novelty in applying this to a lace machine. The old-constructed lace machines might have had it without any alteration, but it enabled alterations and great novelty to be introduced. In my opinion, that is not a novelty in the application or adaptation of these old means for the purpose of giving rigidity to the lace machine; it is merely that the consequence is, that the entire combination which is claimed is enabled to be made effectual so as to be a useful combination, for the purpose of doing by machinery lace work which might never have been done before by machinery.

BOWEN, L.J.—The first question is what, according to the true construction of the specification, is this claim? Has the patentee in his description and claim claimed a monopoly for the subject-matter of the 2nd and 3rd claims as distinct and independent combinations and inventions apart from the machine? That question must be answered as one of construction of the documents, and we were pressed very earnestly to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to courts under circumstances which preclude the propriety of their entertaining it for a moment. It is quite true that in old times a great many judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the courts, it became necessary for the tribunal to warn itself that patentees must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Sheppard's Touchstone, to the effect that the interpretation of a written document ought to be benevolent or benign, "*Verba debent intelligi cum effectu ut res magis valeat quam pereat.*" Now, that is only a caution against excessive formalism. It only means that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is as expressed in their language, you must not allow yourself to be drawn away from the true view of the document by over-nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do some-

thing by their deed, and you must not defeat it if effect can be given to their intention by a fair construction of the whole of the document. It is almost always coupled with another maxim, which seems to me really to be the same thing in another shape, "*Verba intentioni debent inservire.*" You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim that the interpretation of documents ought to be benevolent or benign, but having said that it follows that although there may be cases in which you use it when the validity of a patent is in question, it certainly never can be used when the construction of the document is clear; that is to say, it is a guide to help you to construe a document, it is not an excuse to justify you in misconstruing it.

FRY, L.J., referring to the floor-plate, said:—Useful it was when combined with the removal of the rails which had connected the parts of the machine before, and when taken in combination with the other parts of the invention as parts of an entire combination the subordinate combination in the 3rd claim was useful; but as an independent subordinate combination I am by no means satisfied that there is evidence of utility.

On a subsequent day the Court (diss. BOWEN, L.J.) ordered the injunction to be continued as against *Hancock*, his servants and agents, and ordered the infringing machines to be delivered up on the ground that *Hancock*, not having delivered any particulars of objections under 15 & 16 Vict. c. 83, s. 41, was not entitled to raise any question except that of infringement.

COTTON, L.J.—There were several objections taken as regards *Hancock* being entitled to rely on the objection on which we gave judgment; and the first objection, which divides itself into three sub-divisions, was that the patentee was estopped from denying the validity of his patent. 26 Ch. D.
705.

The estoppel on the record was, of course, the letters patent which were recorded. But (besides this objection that estoppel is only as between parties and privies) there is nothing on the record (that is the patent) which is inconsistent with *Hancock's* alleging, if he is otherwise in a position to do so, that the specification is not a good one; that is to say, that the patent is not good on the ground of want of novelty. * * * *

Then we come to estoppel by deed, which was relied on; and that was the specification which was under seal by deed poll, but in that, in my opinion, there was nothing which prevents *Hancock* from alleging the truth, and from proving the truth, because all

that the specification professed to do was to fully declare the nature of the invention and how it was to be carried into effect. It may be that he would be estopped from taking certain objections by the specification. On that I give no opinion; but the objection which has here proved fatal to the patent, in our opinion, is the want of novelty in one of the subordinate combinations for which protection was claimed; and in my opinion, there was nothing in the specification inconsistent with *Hancock's* now showing that one of those subordinate combinations fails for want of novelty.

Then it was said that, by the petition he presented to the Crown, he was estopped, because there he did represent that this invention was a new invention, and that must mean the whole of the invention for which he claims protection in the specification, explaining what he says is protected by the patent. That would, in my opinion, so far as it is necessary to give an opinion on that, be good, as an estoppel *in pais* as against any one who is interested, and who is proved to have acted in reliance on the statements which were made in the petition which was presented by *Hancock* when he asked for his patent by petition presented to the Crown; but here there is no evidence at all that the purchasers, the plaintiffs, in any way relied on any statement therein made by *Hancock*, the patentee, when he applied for his patent. The plaintiffs gave a very small sum for this patent; and, as a rule, people do not rely on any statements made by the patentee, but they buy the patent, forming their own opinion as to whether it is good or valuable, and as to its worth; taking their chance, unless it has been established, of their failure to establish its validity when the case comes into a court of law.

26 Ch. D.
708.

BOWEN, L.J.—So far as the estoppel is concerned, the whole of the Court is at one. I think it is quite clear that there is no estoppel here. There is no estoppel on the ground of record between *Hancock*, the original patentee, and the persons who have bought from the trustee in his liquidation. There is no estoppel of record, and there is no estoppel by deed, because the people who claim against *Hancock* are not parties or privies to the deed or to the record; nor is there estoppel *in pais*, or by matter of conduct. It is perfectly true that in his petition to the Crown *Hancock* did say that his invention was new, and on that the patent was granted to him; but what sensible being in this world who buys a patent, buys it on the strength of the assertion made by the patentee in the petition that the patent is new. We know

that everybody who buys it, as a rule, takes it for what it is worth, and there is absolutely no evidence in this case that the plaintiff, who bought from the trustee in the liquidation, and who gave a very small sum for the patent, was in the least relying in his purchase on the allegations made in the petition to the Crown by the patentee that the patent was a valid one.

FRY, L.J.—That there would be an estoppel by record between the Crown and the grantee of its letters patent is, I think, probable, but I find neither reason nor authority for extending this estoppel so as to make it work between the grantee and all other of her Majesty's subjects. The plaintiffs claim as assignees of the grantee, and not of the grantors, and consequently can have no benefit of an estoppel between grantor and grantee. As to estoppel by the specification, it was argued that estoppel may arise between the maker of a deed poll and all to whom it is addressed—in this case all men. But I am not able to find in the specification either an expressed or implied assertion of the validity of the third claim in the specification, the object and scope of the specification being merely to give the best description that the patentee can give of his invention. Lastly, as to estoppel by the petition, the petition must, I think, be taken to be an assertion of the discovery by the patentee of a new invention, capable of being made the subject-matter of a patent, and if it had been shown that the plaintiffs had purchased on the faith of this assertion by the defendant, it may well be the defendant would have been estopped.

28 Ch. D]
712.

A sum of about £700 which had been assessed by the official referee as the amount of the damages, had been obtained from the defendants by an execution against the partnership property. The plaintiffs were allowed to retain the whole of the sum so recovered without prejudice to any application the defendant *Smith* might make, on the ground that the defendant *Hancock* had no assets in the partnership; and the damages were therefore paid out of *Smith's* property alone. The costs of the shorthand notes of the evidence, though used in the Court below and in the Court of Appeal, were not allowed.

51 L. T.
735.

An application was made for a certificate that *Smith* had proved his particulars of objection under s. 29 (6) of the Patents Act, 1883 (*supra*, p. 14), but the Court said that the taxation of costs of proceedings commenced before the Act would not be affected by it: s. 113 (B.).

The defendant appealed to the House of Lords, who discharged

the order of the Court of Appeal (save so far as it declared the patent invalid), and dismissed the action with costs.

10 App.
Ca. 253.

SELBORNE, L.C.—The Court below has held that if there are joint defendants sued together for a joint infringement, by their common acts, of a patent, unless each of them and both of them deliver the particulars required by the statute, the Court may consistently and properly declare the patent absolutely void and null as against one of them, and treat it in effect as if it were valid against the other, by one and the same decree. If the statute had made that necessary, the statute, of course, must be obeyed. But it would be a most singular result that, whilst as to one of the defendants, and all the rest of the world, the invalidity of the patent is established, one particular defendant is dealt with as if it had been good during the whole of its so-called duration,—that is to say, what would have been its duration if it had been valid,—and is separated from his co-defendant and the rest of the world, and made singly and solely the person who cannot carry on this business or use the manufacture on the ground of his having failed to comply with the requisites of the statute, which would entitle him to the benefit of the defence. I think that before we admit such consequences it is necessary to examine carefully, first of all, the provisions of the statute; secondly, the facts of the particular case as bearing upon those provisions; and thirdly, the consequences of the decree which has been made.

10 App.
Ca. 254.

His Lordship read 15 & 16 Vict. c. 83, s. 41, and continued:—No express notice is taken, on the face of that section, of the possible case of there being more defendants than one. It does not say in terms that if there are more defendants than one every defendant shall, unless they all join in their defences, deliver separate particulars, whatever may be the circumstances of the case or their relations to each other. It does not say that they shall or shall not: and I apprehend that in determining the question whether, in a particular action, the statute has been in substance complied with or not, we must look to the nature of the case, to the position and relations of the parties, and to the case made against them by the plaintiffs. If it so happened (I will put aside the question under what circumstances it could happen) that the defendants were persons whose cases were wholly distinct, who had nothing to do with each other, whose acts were acts for which each of them were severally and solely responsible, and in which the others of them had no interest,—if that case arose it might well be that a court of justice applying this section of the statute

might properly hold that one defendant, who had not given full particulars, was to have no benefit from what had been done by another defendant, with whom he had no connection or concern, and whose case was entirely separate from his own. What the consequences of that might be, it is not necessary at present to say. But where there is a case, as I say, not expressly noticed or provided for in terms by the section, of co-defendants who are sued as being jointly liable for their joint and common acts,—whose cases, on the face of the plaintiff's pleadings and their own, are not separate as to the substance, though they may sever in the conduct of their defences,—then as to that case, if the substance of the statute and its substantial objects are complied with, I see no words in it which say that substantial justice is not to be done in the case because one of the defendants has neglected, or omitted, or refused in point of form, to put in the particulars which have been put in by the other who is *in pari casu*. The substance of the statute, its substantial objects, are plainly answered, because the object is that the plaintiff may know what case he has to meet; that the plaintiff may not be taken by surprise; that he may be informed, if it be a question of novelty, of the place or places at which, and the manner in which, the invention has been used, or is alleged to have been used, or published, before the date of the letters patent; and if he has that information from one of two parties who stand together *in pari casu*, so far as the substance of the case made by the plaintiff is concerned, and so far as the substance of the defence is concerned, everything intended and aimed at by the statute has been done, and there can be no reason whatever for saying that evidence in that case, which must be allowed to be given in support of the objection, so far as relates to the person who has put in the particulars, being so received in a case which is substantially common to both, is not to be attended to as applying to the whole of the case. I think that if it be the fact here that there are two parties sued as partners, for infringements as partners, in their partnership business, as to whom no separate case is made or sought to be made by the plaintiffs, and if one of those partners has put in the necessary particulars, it is obviously for the defence of the case in which he is interested, and which is necessarily common to him and the others; and I certainly am not prepared to hold that the fault or the neglect of the other partner to put in similar particulars, though he does not defend jointly, is to result in separate judgments against the two. That fault or neglect might, as was

suggested by your Lordships during the argument, arise in various ways. It might be, in the first instance, because one of the partners might be at variance with his co-partner, and not willing to help him in his defence,—willing even to throw obstacles in his way. It might be because he was a mere trustee with no real beneficial interest at all, and at the same time not choosing to entrust the conduct of his defence to his *cestui que trust*, and yet he might be liable, in point of law, for infringements. Other cases might be put, such as absence abroad, or possibly incompetence through imbecility of mind, and, again, the want of sufficient authority to defend together.

10 App.
Ca. 258.

When we come to the final Order of the Court of Appeal, we find not only that *Hancock*, because he did not put in a separate particular, and double the cost, whatever it might be, of that proceeding, is saddled with damages and costs, but also that, because he gave no particulars, his servants, agents, and workmen are restrained, until the end of the time for which the patent would have endured if it had been valid, although it is declared to be invalid and void, from making anything according to the patent. *Hancock* is a partner of *Smith*; and although in form the injunction is against *Hancock*, it is in substance an injunction against the partnership as long as it continues, that is, against *Smith* as well as *Hancock* doing this. It is in substance an injunction to stop the partnership, while it is a partnership, from doing that which *Smith* is declared to be at liberty to do. No doubt, my Lords, it may be said that the partnership might be dissolved. Is it of no importance to *Smith*, who has pleaded his defence correctly, that he should be forced to dissolve the partnership, or be treated, as bound by *Hancock's* omission to deliver particulars, and in that way as if the patent, which in his favour was declared to be void, had been declared to be good?

It appears to me perfectly clear that there was no estoppel in this case.

2 O. R. 61.

Subsequent to the judgment of the House of Lords the defendants applied to PEARSON, J., for a certificate, under s. 43 of the Act of 1852, that they had proved their particulars, as under that section the certificate could only be given by the judge who tried the case.

The plaintiffs opposed and PEARSON, J. directed an application to be made to the Court of Appeal, saying :—I have endeavoured to find out, after a long discussion, what is the certificate that I ought to give; I should be exceedingly obliged to the Court of

Appeal, should they think they can do so properly, if they would intimate to me what the certificate is that I should give, and then I will give it, but I really am quite in the dark. All I should have to do would be to hear a long discussion about matters of which I am absolutely ignorant, because I do not know what took place in the Court of Appeal. It is one thing to take a judgment of the Court of Appeal and find out what the judges said in the judgment, and quite another thing to take shorthand notes of what passed between the bar and the judges in the course of the case.

Such application was made *ex parte* to the Court of Appeal (Cotton, Fry, L.JJ.)

COTTON, L.J.—FRY, L.J., has seen PEARSON, J., and explained that there is no respondent here, and that this is not a matter which we can entertain. If you wish to bring the other side here by serving notice of motion upon them, you can do so at your own peril. But should you not desire to do that, if you will hand up the shorthand writer's notes we will communicate with PEARSON, J. so as to enable him to decide any matter which is brought before him by simply telling him, if there is any doubt on the shorthand writer's notes, what we did.

The latter course was adopted, and on a subsequent day PEARSON, J., gave a certificate, saying:—Knowing nothing of my own knowledge as to what was proved or what was not proved in this case, I thought it right to communicate with the L.JJ., and acting upon the information that they have been good enough to give me, I determined that the defendant *Smith* proved his particulars of objection of want of novelty in the 3rd claim, and that is the decision I shall give. This is a case in which there can be no argument and there can be no appeal, and for this reason, that the judge has to satisfy his own conscience, and nothing else, as to what he will certify, and that it is impossible for the Court of Appeal to direct or instruct a judge to certify something against his conscience.

Being then asked by counsel whether, inasmuch as the House of Lords had held that *Hancock* was to have the benefit of the particulars which *Smith* delivered, *Hancock* and *Smith* were to be regarded as one defendant, the learned Judge said:—Upon that I adjudicate nothing. I am desired to give a certificate according to conscience, and giving a certificate according to conscience, I certify that *Smith* proved his particulars for want of novelty under

the third claim. What may be the result of the judgment of the House of Lords I know nothing.

While the appeal to the House of Lords was pending on the 29th April, 1884, the plaintiffs applied at the Patent Office for leave to amend under s. 18 (*supra*, p. 8). The defendants opposed the application. The Comptroller declined to proceed without the consent of the Court. The plaintiffs took out a summons for liberty to apply at the Patent Office for leave to amend. No order.

28 Ch. D.
151.

CHITTY, J., read the 10th sub-s. of s. 18, and proceeded:—The important words are “action for infringement.” The words “other legal proceeding in relation to a patent” are intended evidently to refer to a proceeding for the revocation of a patent. I say that, because I consider, as I have already stated, s. 19 to be correlative. His Lordship read s. 19, and referred to s. 117 as to the meaning of “the Court,” and continued:—It appears to me that reading s. 18 (10) and that section together, bearing in mind also s. 20, which I need not read at length, the result is, that “pending action” means an action before judgment; because, if the amendment takes place after judgment, it is quite clear that it cannot be made use of, or it is not available, for any purpose of the action. If it is an ordinary judgment in the Queen’s Bench Division, and damages were awarded, there is an end of it. If, on the other hand, instead of damages being awarded, there is an injunction and an account, then the account is taken, but the account is taken on the footing, of course, of the patent. But still in an action such as this, where there is no account and no judgment (there is no account at any rate directed), I am quite clear that any amendment which is now being made of the specification could not be made use of to the detriment of the parties to the action. The words “may direct that in the meantime the trial or hearing of the action shall be postponed,” show that the meaning of the legislature was that the power which is conferred on the Court or a Judge was shown to be a power which must be exercised before the trial of the action. I think, on considering the matter and putting the Act together, that is right, and the result therefore is that this application fails. For the defendants the suggestion is, first, that there is a power in s. 19, and that power is not exerciseable by the Court or a Judge according to the definition—that is, the High Court or a Judge of the High Court,—but that the application must be taken to the Court of Appeal. It seems to me, if the application were to be taken to the Court of

Appeal, it would be refused at once. Then it is said it must be taken to the House of Lords, because there the appeal is pending. It seems to me it would be refused on the ground that the House of Lords have no jurisdiction to act upon it. The meaning of all that is this, that there is no power to give the leave. But that is the very argument which is adopted on behalf of those who are making the application. And this is only another curious incident in these proceedings; because here the applicant makes an application which he says is wrong, and asks for the opinion of the Court in order that the Comptroller may know whether he can proceed or not. I think, for the reasons that I have given, I ought to refuse the application; but, in doing that, I ought to state my opinion that there is no pending action. Then as to costs: I will not give the plaintiffs their costs, because they have succeeded through their failure. I will not give the respondents their costs, because I think they might as well not have come here at all. They have failed substantially. They have failed through their success, whereas the applicants have succeeded through their failure.

CROYSDALE v. FISHER.

[1883—4. 1 O. R. 17.]

Prior User—Subject-matter.

Action for infringement of a patent granted to *T. Croysdale* on the 31st March, 1880, No. 1324, for “improvements in the manufacture of manure.” At the date of the plaintiff’s patent it was well known that shoddy could be so mixed with sulphuric acid as to form manure, but the result was a pasty mass, and had then to be treated anew to reduce it to a powder, and thereby a quantity of nitrogen escaped. The object of the plaintiff’s invention was by one operation to arrive at a powder without losing any of the valuable matters. For this purpose he used a patented machine known as *Forrest’s* machine, which was described with certain necessary modifications in the specification. *Claim*: “The treatment substantially as described of shoddy, &c., with a mineral acid in a steam-heated vessel, with constant mechanical agitation in such manner as to obtain from the said materials a dry pulverulent product, suitable for use as manure.” The action was tried before POLLOCK, B., without a jury, who gave judgment for the defendant on the ground that he had proved prior user.

POLLOCK, B.—The patent, I think, can only be supported on 1 O. R. 19.

the ground that it is for the use of *Forrest's* machine in the limited mode I have mentioned, namely, worked by steam, and for the purpose of producing a new result such as I have described.

Now then, upon the plaintiff's specification and the plaintiff's evidence, the question is, can such a patent be fairly supported? I certainly think that it can, because it is not the mere application of a well-known machine to a purpose which is cognate to that for which the patentee of that machine originally claimed an invention and specified it, it is the application of that machine substantially and fairly to a new object. I think the fair test of whether that is so or not is this, whether, if persons who are acquainted with the trade or business, whether as chemists, engineers, or manufacturers, were asked this question—Given the desideratum of manufacturing this powder, given the existence of *Forrest's* machine, given the knowledge which previously existed with regard to what could be effected by the admixture of sulphuric acid in any proportions with shoddy; given all these as data, is there anyone who could say that the application of *Forrest's* machine in the mode in which it was specified for by the plaintiff would produce not only that which he claims, but which he proves by his witnesses to have been carried out?

1 O. R. 21. Whether a patent is anticipated by a previous specification or by previous publication in a book, or by previous user, the principle is the same, because in each case it must be shown, in order to effect a good anticipation, that some person before the date of the patent has communicated to the public that which the patentee now claims. But, still, there is a vast difference, when you come to look at the observations of the learned judges, in the application of the principle to cases in which the alleged publication is by means of a previous specification, or, still more, by means of a previous printed book.

His Lordship then referred to *Hills v. Evans* (vol. i., p. 248), and to *Plimpton v. Malcolmson* (vol. i., p. 374), and continued: But when you get to the question as to whether there has been a publication by user a very different question practically and in fact arises, because it is obvious that in almost all cases of user it does not profess that there is a publication to the world, as there is in the case of a specification or in the case of a book that is largely disseminated; because the more perhaps as different modes of refinement and variations and improvements continue to multiply, the more does it happen that one portion of the manufacturing world does not know what is going on or what is being done by

another portion of the manufacturing world. Certainly still more does the public not know with very great nicety, unless concerned either as manufacturers or traders, what is going on in the different laboratories or manufactories attached to any particular trade. When it is said that a process has been disclosed or an invention has been disclosed by means of user, it is not necessary that such user should be a user by the public proper, provided only there is a user in public, that is to say, in such a way as contra-distinguished from a mere experimental user with a view of patenting a thing which may or may not be existing. In this particular case the desideratum was long known, and a great number of persons not only tried different modes of attaining to it, but they succeeded more or less.

DAVIS v. FELDMAN.

[1884. 1 O. R. 13, 193.]

Combination—Construction of Claim—Anticipation—Comparison of Specifications.

Action for infringement of a patent granted to *H. A. Davis*, the 7th May, 1881, No. 1991, for "improvements in umbrellas." The defendant denied the infringement, and alleged that the plaintiff's invention had been anticipated by one *Weeks*, who filed a provisional specification in 1864, No. 1777.

The patent related to an improved form of the ribholder (also called the upper notch), which encircles the stick of umbrellas near the end and has the ribs connected to it. The object was to make this notch of exactly the same circumference as the stick, so that the ribs of the umbrella, when closed, should lie flat to the stick.

The stick of the umbrella was divided into two parts, which were united by the ribholder, which had a solid piece in the middle and sockets on each side, one end of each piece of the stick being tapered off to fit into its socket, and they were secured to the ribholder by cross screws.

Claim 2.—An umbrella stick formed in two parts, united by a ribholder which has a solid portion containing recesses for the reception of the rib-ends between the two parts of the stick as set forth.

The defendant had used the ordinary ribholder, and had divided the stick of his umbrella and united the parts by a screw which went through the ribholder.

Weeks described the short end of his umbrella as formed entirely

of hollow metal of smaller diameter than the stick. Round this hollow end he fixed a ribholder of the same diameter as the stick; the end of the stick was tapered and secured in the hollow end by rivets.

The action was tried without a jury and was dismissed with costs.

POLLOCK, B., said as to the 2nd claim: Now if that is to be set up, not merely as forming a part of the combination, but as a substantive claim in respect of which the plaintiff would be entitled to say to the defendant, "You shall not do that, nor the like of it in any sense; that is to say, you shall use no mechanical equivalent or other process by which you shall arrive at the same result;" then I think that 2nd claim ought to be read somewhat strictly, and I am by no means certain, apart from any previous publication of the idea that may be conveyed by this 2nd claim, whether the plaintiff could say that there had been an infringement by the defendant of his patent, because he must be held to this. It is not as if he had said, "I claim an umbrella stick, formed in two parts, united either in one way or in the other, or by any well-known process or what not;" but he condescends upon a particular mode by which the object is to be attained, and he says, "united by a ribholder, which has a solid portion containing recesses for the reception of the rib-ends between the two parts of the stick as above set forth."

But had there been anything which before had indicated that the stick might be so divided? Now here I am not entitled for this purpose to go into any evidence, but I am entitled to read, as one of the public might read, not with any knowledge, or as explained by any knowledge of the makers of umbrellas, but I am entitled to read, as one of Her Majesty's subjects, and to bring to bear my own mind on the subject, *Weeks'* patent.

Appeal to the Court of Appeal (Brett, M.R., Bowen, Fry, L.JJ.). Appeal dismissed.

BRETT, M.R.—Then it is said that as to that, he has, in a material part, been anticipated by *Weeks*. Now what is the other way of always stating that a man has been anticipated by another? Why, that if *Weeks* had had a patent, this plaintiff would have infringed that patent of *Weeks* in a material part. It is true *Weeks* had not a patent—as I understand, he had only a provisional specification; but if that had been turned into a final specification, what then? Then the question whether the plaintiff had been anticipated by *Weeks* in this part of the matter would be the same

question as if you had had to try—Had the plaintiff or would the plaintiff have infringed *Weeks's* patent?

Would what the plaintiff had done, if *Weeks* had taken out a patent, have been an infringement of that? Surely the plaintiff could not be entitled to take all this essential part of *Weeks's*, namely, the upper notch of the same diameter as the stick—that upper notch fixed in the tube, which tube is tapered to be of the same size as the stick, so that the stick is to go into it, and then say, “I have not infringed *Weeks's* patent because I have added to that which is his invention, which I have taken bodily and absolutely, because I have added that tube at the side and put that in.” That would have been an addition; and if it was a combination, it would have been an infringement of *Weeks's* patent.

If what he did would have been an infringement of *Weeks's* patent if *Weeks* had taken out a patent, then he is anticipated by the description which *Weeks* gave of his invention. Therefore it seems to me that POLLOCK, B., was right in saying, “In construing these two documents, which it is my duty to do, I do not want the assistance of experts.” It is plain from the proper construction that the plaintiff had been anticipated in a material part of his invention, and the part which substantially he is now claiming, not the combination but this peculiar invention, is anticipated by *Weeks*.

DOWNES v. FALCON ENGINE WORKS.

[1885—6. 2 O. R. 197; 3 O. R. 70.]

Construction of Specification.

Action for infringement of a patent granted the 9th July, 1872, No. 2066, to *John Downes* for “improvements in steam engines.” The invention had special reference to the condensing of the steam and the utilizing it in heating the boiler water and improving the blast. The patentee claimed to have attained by his improvements a smokeless and noiseless engine. The description given in the specification related solely to condensing the steam by water.

Claims: 1. “The arrangement or combination of parts herein-before described and illustrated in the accompanying drawings for condensing and utilizing the exhaust steam of the said steam engines and making them noiseless or nearly so. 2. The arrangement or combination of parts herein-before described and illustrated in the accompanying drawings for conveying the exhaust steam and condensed water from the condensing tank to the boiler of the engine. 3. The arrangements or combinations of parts

herein-before described and illustrated in the accompanying drawings for conveying the exhaust steam to the furnace or smoke-box of the engine, or a mixture of exhaust steam and heated air, for the purpose of promoting the draught of the furnace and the economizing of the fuel therein and preventing smoke."

The defendants' apparatus was one for air condensation of steam, and by their defence they raised the usual issues.

Trial at Birmingham Assizes, when the Judge, sitting without a jury, dismissed the action.

DAY, J.—It is not new, considered with reference to the parts, and in my judgment it is not new with reference to the combination. It is not the subject-matter of a patent, because it was not a new invention of the plaintiffs. I will say no more than this, that it seems to me to fail in novelty, so far at least as its specific structure is concerned. Having regard to the specified mode of construction of the engine, it seems to me to fail also in utility.

Appeal to the Court of Appeal (Esher, M. R., Lindley, Lopes, L.JJ.). Appeal dismissed with costs.

ESHER, M.R.—If the 1st claim of the three claims more than is claimed in the 2nd and 3rd, I think then that the 1st claims the mode of condensing steam by passing it through water in a tank. And if it does claim that, I think that the 1st claim is too large, and the patent is bad for want of novelty. If the 1st claim only claims what is in the 2nd and 3rd, I cannot say whether the patent is novel or not, because there does not seem to be evidence which has been distinctly pointed to that view of the case. I cannot say whether it is bad for want of novelty. But then, if the 1st claim is only equivalent to the 2nd and 3rd, or the 2nd and 3rd combined, there has been no infringement by the defendants of the patent, and therefore, in either view, this action fails on the part of the plaintiff. The better view for the plaintiff, probably, is that the 1st claim combines the claims of the 2nd and 3rd and no more, and if so there is no infringement. I think the appeal must be dismissed.

DRAKE v. MUNTZ'S METAL CO.

[1886. 3 O. R. 43.]

Inspection before Statement of Claim.

The plaintiff was the grantee of letters patent dated Feb. 15, 1883, No. 840, for an invention of "an apparatus for bending or forming lead tubing into bends."

This action was commenced in 1885 to restrain the defendants from infringement of the said patent and for other relief.

Before a statement of claim was delivered, the plaintiff took out a summons under s. 30 (*supra*, p. 14), for an order that the manager or proper officer of the defendant company should make and file an affidavit verifying the machines and processes used by the defendant company in bending metal tubes since the 15th of February, 1883, and that such machines should be produced, and that the plaintiff should be at liberty to inspect such machines and to inspect the defendants' process and to take samples.

The defendants had offered the plaintiff inspection of the processes by which they were making bends.

Order for inspection. Costs in the cause.

BACON, V.-C.—I have no authority, even under the wide terms of the Act, to require the defendants to make an affidavit. What the plaintiff is entitled to under the Act is an inspection of the machines made by the defendants, which he says are an infringement of his patent. The way they make them he has nothing to do with. If they are an infringement of his patent it does not signify how they are made. If they are not an infringement of his patent he has no right to see them. The plaintiff has a right to inspection. He has a right to ascertain by inspection how many machines are used by the defendants; he has a right to give evidence of the result of his inspection at the hearing of the cause; and then the whole matter will be before the Court; but he has no right to require that an affidavit should be made. The plaintiff can take an order for inspection of all the machines used by the defendants, the manufacture of which the plaintiff says is an infringement. If, as was done in *Flower v. Lloyd*, the parties agree that some scientific persons on both sides, or one on each side, shall conduct the inspection, it may be done; but that must be by agreement. In the meantime all I can do is to order that the plaintiff has a right to inspection at the works of the defendant company of the machines which are produced, at all reasonable times, and as often as may be requisite, upon giving three days' previous notice, (I have no right to order them to work the machines in the plaintiff's presence, nor is it necessary I should, because any expert, or a person acquainted with this business, can tell what work the machines produce and are capable of performing) and then to an order to produce the machines upon any examination of witnesses in the action.

DRIFFIELD LINSEED CAKE COMPANY v. WATERLOO MILLS
CAKE COMPANY.

[1886. 31 Ch. D. 638; 55 L. J. Ch. 392; 54 L. T. 210; 34 W. R. 360;
3 O. R. 46.]

S. 32—Threats—"Other Person"—Damages.

Action under s. 32 (*supra*, p. 14), to restrain threats.

The solicitors of the defendants, on the 17th *Dec.*, 1884, wrote to the plaintiffs, saying they had been consulted by the defendants with reference to the infringement by the plaintiffs of the patents held by the defendants, and further saying, "We have been instructed to give you notice, as we now do, that you have been and are infringing those patents, and that unless you forthwith discontinue such infringement legal proceedings will be taken to compel you to do so." Further correspondence followed, and on the 13th *Jan.* 1885, the defendants' solicitors wrote a letter confirming the notice previously given, but refusing to give any particulars of the alleged infringement, and stating that the defendants would take the necessary steps to protect their rights. This action was commenced on the 16th *March*, 1885. The defence stated that the plaintiffs had infringed the defendants' patents, and admitted that no legal proceedings had been commenced for such infringement. Subsequently the allegation of infringement was struck out.

Trial of the action:—Injunction granted with costs.

BACON, V.-C.—The law, as it stood, enabled persons who were patentees or alleged they were patentees to fulminate their threats against any person they liked, cautioning them, at the peril of their lives almost, not to invade the rights which the patentees thought they had. To put a stop to that this alteration in the law was made. His Lordship read s. 32 (*supra*, p. 14), and proceeded:—The defendants, saying that they are patentees, have threatened another person (the company being a person for this purpose) with legal proceedings * * * The first letter of the defendants has never been departed from or qualified, and it has been in every sense continued. It never has been withdrawn, and therefore it has been continued. It has been continued down to the present time, except only for the change which has been made in the pleadings by striking out the assertion that the plaintiffs have infringed. Can I reject those words "any other person?" Can I from the nature of the case confine the section to circulars and advertisements? Each circular must

be directed to some person in order to be useful, and the words "any other person," in my opinion, plainly bring the letter which was written in the first instance within the provisions of this section. Without straining the words or having any hesitation or doubt about the meaning of the words, this is a case in which a patentee or alleged patentee threatens another person that he will take proceedings against him. In my opinion that gives the person so threatened a clear right under this clause of the Act to bring his action, since the threatener does not avail himself of that last provision by which the *onus* is thrown on the alleged patentee of taking proceedings. He is protected from the consequences of his threat if he takes proceedings to enforce his threat, otherwise it remains only that sort of annoyance and unjust threat which it is the object of this section to check and control, and punish if necessary.

The notion of damages is in my opinion out of the matter. When the plaintiffs receive that notice they set themselves to look into their patent—their title-deed—and to look over their machinery, all of which they ought to know very well. They ought to know their patent and the terms of it, and they ought to know their machinery and what it is capable of doing, without requiring the assistance of engineers or solicitors or anybody else to enable them to know whether what they are doing is within their rights or not. I think there is no case whatever for the inquiry as to damages. It has not been alleged in any way, that I can notice, that any damage has been sustained. The business has not been suspended. Certain works contemplated have not been carried out with the vigour which it was conceived at first would be necessary, but the business has not been stopped; and that is the whole case for damages. In my opinion the plaintiffs are entitled to the injunction which they ask for.

EASTERBROOK v. GREAT WESTERN RAILWAY COMPANY.

[1885—6. 2 O. R. 201 ; 3 O. R. 94.]

Utility—Where Claim enlarged.

Action for infringement of a patent granted to *Walter Easterbrook* the 29th March, 1867, No. 927, for "improvements in machinery and apparatus for actuating and controlling railway points and signals." The invention related mainly to a method of locking the catch-rods instead of the main levers used in rail-

way signalling, the object being to get rid, as far as possible, of any chance of a conflict of signals, or of signals and points.

The specification described the invention in detail.

Claim.—“Locking the catch rods or spring hand levers instead of the main levers used in railway signal apparatus, and in such manner that such catch rods shall be secured as required in their respective notches, substantially as and for the purposes herein specified and shown by the drawings annexed.”

The defendants raised the usual issues, and the evidence at the trial went to show that the absolute mechanical impossibility of conflict was secured by apparatus known at the date of the patent. The plaintiff's apparatus had only been used at a siding at Leigh.

WILLS, J., sitting without a jury, held that the patent was bad for want of utility and novelty, and that the defendants had not infringed.

2 O. R.
205.

WILLS, J.—The evidence is strong that anything short of impossibility of conflict is a source of great danger. I discard for this purpose the cases of intentional misuse of apparatus, or misuse by the application of extreme violence. It is of course desirable to provide against even such cases as far as possible. But complete protection against such sources of danger appears to me to be too much to expect from any system, and I certainly should not treat a failure in this respect as a ground for saying that a patent was void for want of utility. On the other hand, it seems to me that the constructor of an apparatus which professes to render conflict of signals impossible must expect to encounter almost every form or degree of human carelessness, as well as every lapse from a strained attention due to fatigue, hurry, or confusion. The very fact that such apparatus, possessed of this power of protection against the results of human weakness or incompetence, is in habitual use, tends to lay to sleep the vigilance and intellectual activity of the signalman, who trusts for safety to the perfection of the mechanism he works rather than to his own ceaseless wakefulness and care. Apparatus which professes to secure impossibility of conflict challenges a high standard of criticism, and it is not in my judgment enough—particularly when we bear in mind the fearful nature of the possible consequences of failure—to show that if properly and carefully worked it will answer its purpose, or that the combinations of movements necessary to bring about disaster are in each particular instance improbable, or even highly improbable. It was demonstrated by actual experiment in Court upon a model, to which no exception was taken,

that it was possible, with the plaintiff's apparatus in perfect order, and without straining in the least any of its working parts, to have the whole of the signals which protect the main up line, the main down line, and the branch into each of them respectively lowered at once, so that four trains could be invited simultaneously to a common destruction. It was suggested that this was a case so extreme as to be in the highest degree improbable. Indeed it was admitted that it could only be done by malice; but the first stage in the operation, which simply involved the simultaneous movement in opposite directions of two levers, put the points right for the main line, and gave the signal for the train to come in from the branch line. It was not a likely thing that one signalman should do both things at once. So far as strength is concerned, there was or might be no difficulty. The mechanical habits of the signalman could not lead him to do such a thing; but signalmen get drunk sometimes, sometimes are thinking of other things, and we know that every now and then a man does a thing which, from his habits, is the last thing you would expect him to do. Two men frequently, and sometimes three, are employed in the same box. If two of these men should happen at the same instant of time to grasp the catch-rods of two conflicting levers, and to actuate them together, there is nothing to prevent conflicting signals from being given; and the sum and substance of the evidence in favour of the plaintiff's invention in this respect is that it is much more likely that all things will go right than that something should go wrong. The mechanical impossibility of going wrong by anything short of violence or malice, which appears to me to be an absolute condition of usefulness in an invention of this kind, has, in my judgment, been demonstrated not to exist. It was admitted by Mr. *Cowling Welch*, the engineer upon whom the stress of the plaintiff's case was thrown, that an apparatus by which it is possible, whilst it remains in working order, to give, by accident or negligence, conflicting signals, is useless and dangerous.

The idea of locking the spring catch instead of the lever was new, and it appears to me to be pretty clear upon the authorities that although there cannot be a patent for an idea or a principle apart from its physical embodiment in adequate apparatus, yet, that, if the specification discloses the idea, shows a method by which it can be carried out, and does not limit the claim of the patentee, any apparatus which by different mechanical means carries out the same idea is an infringement of the patent, though

2 O. R.
207.

the method used, and even the purpose to which the principle or idea is applied, be different from those embodied in the specification. This seems to me to be the fair result of the authorities cited. His Lordship referred to *Househill Company v. Neilson*, vol. i., p. 265, *Jupe v. Pratt*, vol. i., p. 274, *Badische Anilin Fabrik v. Levinstein*, vol. i., p. 24.

It is, however, as it appears to me, impossible for the patentee to go beyond the claim in his specification. The office of the claim is to protect the patentee from the danger of being supposed to make claims beyond those which he elects to make (*Kay v. Marshall*, vol. i., p. 276), and it must therefore limit his patent rights to what it fairly embraces. I am of opinion that it is impossible to read the plaintiff's specification as claiming more than the specific mode of locking the catch-rod which he describes. Had the larger claim to any method of locking the catch-rods been intended, the claim should have stopped at the words "respective notches." I do not understand for what purpose the subsequent words should have been introduced, unless it were with the intention of limiting the claim, as I have suggested. The plaintiff in July of the same year took out a patent, which on grounds unconnected with the present discussion could not be sustained, in which he made the larger claim to "locking the catch-rod." It appears to me that in the present instance he designedly abstained from doing so. In the subsequent patent it seems to me to have been properly claimed. The idea was then new, the filing of the provisional specification in March not being a prior publication—a method of effecting it was described—and taking the specification altogether, it seems to me clear that what he meant to claim was not the mere idea, but any method of putting it in practice, he having shown one method by which it could be done. *Neilson's* specification is set out in 1 Webs., p. 273. It describes his idea and his process, but contains no words of claim, and the fact that he claims no specific method of applying the principle is referred to by the Lord Justice Clerk *Hope*, at p. 682, as one reason for giving to the patent the wider interpretation adopted in that case. Here, on the contrary, limiting words are used, and I cannot see upon what principle of construction they can be discarded.

2 O. R.
210.

It was strongly urged, however, that inasmuch as the apparatus, when applied to very simple constructions of points and signals at Leigh, had performed its work for three or four years without accident, it was shown to have some utility, and that, as a very

small degree of utility is enough to support a patent, it is not bad in the present instance on the ground of inutility. There are two answers. It is not the fact that with this apparatus, tried in its simplest form and under the easiest conditions, you may go on for a good while without accident, but the alleged fact that it is safe under all circumstances that constitutes the particular kind of usefulness needed and aimed at in such apparatus. And further, the specification here points to its universal application for railway signalling, including its use at the most complicated junctions and sidings. If it be useful for one very small and insignificant section of its proposed work, and for the rest is, as, in my opinion, it is proved to be, fraught with danger and death, the specification is bad, as not distinguishing between its useful and its useless applications. It is as consonant with good sense as I believe it to be with good law that an inventor, who invites the indiscriminate use of apparatus sure to bring about disaster in the long run if generally applied according to his invitation, cannot maintain a patent for his invention because it will do some useful work at places and under circumstances where mechanical appliances for preventing conflict of signals are scarcely necessary at all, whilst elsewhere it is full of danger to the public.

The objections first discussed, as to the impossibility of making a safe apparatus by following the plaintiff's specification, all but dispose of the question of infringement. The defendants urge that all apparatus which will do what the plaintiff's will not do, upon the critical element of the patent, can scarcely be said to infringe it. This may not be totally correct, but the discussion is of no moment, for the question of infringement is here so inseparably connected with that of utility and with that of the meaning and object of the patent, and it would have been so impossible to try the question of utility without going over all but the same ground as was involved in the question of infringement, that whichever way I decided the question of infringement I should not take away from the successful defendants any of the costs of the cause, or give any of the costs to the unsuccessful plaintiff. It is wholly unlike the case of a plaintiff succeeding on the question of infringement of what would have been a meritorious invention but for some flaw in the specification. In this instance, the plaintiff cannot do what he professes to do. He ought not to block the way for other inventors, and to harass them with actions when they have succeeded where he has failed.

An appeal to the Court of Appeal was dismissed, no one 30 R. 94. appearing for the appellants.

EDISON AND SWAN ELECTRIC LIGHT COMPANY v. HOLLAND
AND THE JABLOCHKOFF COMPANY.

[1886. 33 Ch. D. 497; 3 O. R. 395.]

Indemnity.—Third Party.

This action was brought for infringement of two patents: 1878, No. 4847 and 1879, No. 4576. The writ was issued 20th *July*, 1886, and the Jablochkoff Company took out a summons under O. XVI., r. 48, for leave to issue a notice to the Brush Electric Light Corporation, who were the persons who manufactured the infringing articles, and who, on the 20th *July*, 1886, had covenanted to indemnify the Jablochkoff Company.

33 Ch. D.
498.

BACON, V.-C., made an order: this is set out in full in 3 O. R. p. 396.

The *Brush Corporation* entered an appearance and the *Jablochkoff Company* took out a summons for directions; on which KAY, J., made an order that the *Brush Corporation* should attend the trial and take such part therein as the Judge might direct. The order is given in full 3 O. R. p. 397.

EDISON AND SWAN ELECTRIC LIGHT COMPANY
v. WOODHOUSE.

(1st Action.)

[1885—6. 32 Ch. D. 520; 55 L. J. Ch. 943; 3 O. R. 167; 4 O. R. 79.]

Infringement—Construction—Sufficiency—Best mode—Publication.

Action for infringement of patent granted 10th *Nov.* 1879, No. 4576, to *Thos. Alva Edison* for “improvements in electric lamps and in the method of manufacturing the same.” The invention related to a new electric lamp, being a vessel made entirely of glass containing a carbon filament attached to conducting wires, which wires were sealed through the glass. The vessel was exhausted of air to a high degree, though one-millionth of an atmosphere might be left. On passing an electric current through the filament it became incandescent. The carbon filament was described in the specification as having flexibility and resiliency as of a small cross section, so as to offer a high degree of resistance to the passage of the electric current, and as presenting a small surface from which radiation of light could take place.

A method of making the carbon filament was also described.

Claims: 1. An electric lamp for giving light by incandescence,

consisting of a filament of high resistance, made as described and secured to metallic wires as set forth. 2. The combination of a carbon filament within a receiver made entirely of glass through which the leading wires pass, and from which receiver the air is exhausted for the purposes set forth. 3. A coiled carbon filament or strip arranged in such a manner that only a portion of the surface of such carbon conductor shall radiate light as set forth.

The defendants denied they had infringed, as they had not used a carbon filament made as described in the patent. They relied on a provisional specification of *Edison*, 15th Dec. 1879, No. 5127, as showing that at the date of the final specification of No. 4576 he knew another method of preparing a carbon filament. They further relied on *Pulvermacher's* specification, 1878, No. 4774, as anticipating the invention, and also for the same purpose on a lamp exhibited in public by *Swan* before the date of *Edison's* patent. That was a lamp constructed of glass entirely, containing *in vacuo* platina leading wires hermetically sealed into the glass, between which wires was suspended a pencil of carbón not so slender as a filament. The defendants further denied that the invention was subject-matter of a patent. The defendant's mode of manufacture was a secret, and they objected to answer questions as to it, and the questions were not pressed.

Burr, J., gave judgment for the plaintiffs, holding that, in order to infringe the second claim, the defendants need not use a carbon filament made as described in the patent.

Burr, J.—It is said that a carbon filament, when taken to mean that which I have held it to mean, is a description too vague and indefinite, or too large. That is an argument to which I cannot accede, for I see no reason why a carbon filament having the properties mentioned in *Edison's* patent, which the patentee tells the public how to make, may not properly be the subject of a patent, although it is capable of being made by methods and of materials other than those set forth in the specification. This observation certainly does not lose any of its force when the filament in question is not the thing patented, but only one of the several parts of a combination patent. s O. R.
174.

Referring to the provisional of *Edison*, 5127, the learned Judge said:—It is perfectly true to say that at the time of the final specification *Edison* knew—I do not know whether I ought to say, of a better mode—but he knew, at all events, of another mode of manufacturing his carbon filament. Therefore the argument is, he ought to have disclosed it in his final specifica- s O. R.
175.

tion, because a patentee is not entitled, upon the authorities and as a matter of good sense, to withhold from the public a discovery of which he was aware forming an important integral part of his patent, and then take out another patent afterwards for that. It was said that so to do would be to put the public, or those, at all events, who dealt in such matters, to the inconvenience and expense of taking out a licence to use two patents, whereas they ought to have had the whole benefit of the user by taking out the licence for the one. It must, however, be borne in mind that *Edison* does not claim in his patent 4576 for the manufacture of the carbon filament. His claim is for the union of a carbon filament possessing certain properties with the other parts of his combination. There is no evidence that at the time of filing his provisional specification 4576 he had discovered or knew of the process in 5127. I agree that an inventor has no right to put in his final specification as part of his invention a discovery which he had not made at the time, and of which he was ignorant when he filed his provisional specification.

It is perfectly correct to say that we have in *Pulvermacher's* specification a description of a carbon rod or thread which, if taken by itself, is very like *Edison's* coiled carbon filament mentioned in claim No. 3 taken by itself; but it is used by *Pulvermacher* in a totally different way and for a totally different purpose. That, as I understand *Pulvermacher's* specification, was to be applied not to an incandescent lamp but to an arc light. The spiral in question was to be coiled round an inner core, also of carbon, there being insulation between the two. It was not to be attached to wires at both ends. Of course, that would be inconsistent with the notion of the arc light. Curiously enough, too, *Pulvermacher's* patent deals with two modes of lighting, the arc light and the incandescent; and it is very remarkable that, having described in detail this spiral rod and thread for the purpose of his arc light, when he comes to state what his mode of procuring the incandescent lamp is, he discards his carbon conductor altogether, and resorts to metallic wire. Whatever likeness there may be between *Pulvermacher's* spiral rod and *Edison's* coiled carbon filament mentioned in claim 3, it is perfectly clear to my mind that *Pulvermacher* was wholly unaware that a coiled thread of carbon could be applied for the purpose of incandescent lamps, because if he had been aware of it, he certainly would not have discarded it when he came to make his incandescent lamp, which is provided for in the very same patent.

Appeal to the Court of Appeal. Appeal dismissed (Bowen, 40 R. 79. Fry, L.J.J. ; *diss.* Cotton, L.J.).

FRY, L.J.—In our opinion this second claim ought to be construed with all the generality which its words seem to convey, so that it may be paraphrased as a claim to every combination of any carbon filament with any receiver made entirely of glass, through which any leading wires pass, and from which the air is exhausted. The words “for the purposes set forth” at the end of the claim may govern either the whole claim or qualify the antecedent word “exhausted.” In the former case the purpose is the production of light by incandescence resulting from high resistance; in the second case it described the exhaustion of the receiver as introduced for the purpose of preventing alike chemical and mechanical destruction from the presence of gas—a purpose which *Edison* has enunciated and explained in the course of his specification.

In this view the second claim differs from the first in not embracing the coiling or other similar arrangement which is the first element of the invention—nor the use of platina as distinguished from other leading wires—nor the mode of attaching the metallic to the carbon conductors. But this second claim embraces a combination of the five elements following, namely:—(1) a carbon conductor (2) in the form of a filament; (3) a receiver wholly of glass; (4) a vacuum; (5) the entrance of the leading wires through the glass receiver * * * *

His Lordship referred to the evidence as to *Swan's* lamp, and continued:—This produced incandescent light for a short while, and then the carbon-rod bent and bulged downward, in consequence, as it appears, of the electric motive-force being too great for the cylinder of carbon; and the inner side of the glass was lined with a sooty deposit which, on subsequent examination, proved to consist of platinum, carbon, and iron. As between *Swan* and *Edison*, the difference is only between a rod and a filament, that is a difference of degree and degree only. *Edison* has in his specification given no definition of a filament, and he has nowhere drawn the line between it and the rod. The specification is therefore, it is argued, bad, as being too indefinite and vague. To this argument it may, in our opinion, be properly replied that in a patent of this description definition is required only to such an extent as would enable a practical workman to construct the required apparatus; that there is distinct evidence that such a workman could make the required apparatus from the specification; that no witness of the defendant's alleges that such a workman would

have any difficulty or require any further experiments; and that the specification itself contains descriptions of six forms of filament, and these descriptions, it is obvious, would afford material assistance to any workman in doubt.

It is urged that the mere variation in the size of a part of a lamp is not the subject of a patent. It may well be that no patent could be sustained for the use of a filament of carbon alone, but when that filament is part of a combination which is useful, and replaces a rod in the earlier apparatus which was useless, we can see no reason why the new and useful combination may not be good subject of a patent.

It was strongly argued that the mere change of the size of the part of a combination cannot constitute a new manufacture so as to be the subject of a patent. In most instances this may be true, but the present case is peculiar. Two, and so far as we have learned only two, specimens of the earlier form of the instrument had been constructed, and in both of those a rod, and not a filament of carbon, had been adopted. *Edison* used the filament instead of the rod for a definite purpose, and by the diminution of the sectional area made a physical law subserve the end he had in view. The smallness of size therefore was no casual matter, but was intended to bring about and did bring about a result which the rod could never produce, and so converted failure into success. The point at which *Edison's* instrument departs from *Swan's* was crucial, and the departure, though slight, had all the merits of a new invention, and produced a new apparatus * * * *

His Lordship then discussed various cases, and continued:—It does not appear to us that any of these decisions show or tend to show that the introduction into an old combination of a new shape of one of the old elements of that combination which invokes a law of nature otherwise left on one side, may not be the good subject of a patent * * * *

EDISON AND SWAN ELECTRIC LIGHT COMPANY
v. WOODHOUSE.

(2nd Action.)

[1886. 3 O. R. 183; 4 O. R. 98.]

Sufficiency of Specification—Prior Publication by a Scientific Curiosity.

Action by assignees for the infringement of a patent granted to *F. J. Cheesbrough*, 28th Nov. 1878, No. 4847, for "improvements in and relating to electric lamps and to a method of charging such

lamps with an artificial atmosphere and purifying the same, and to the production of a carbon for use in electric lamps *and for other electric purposes*" (a communication, &c.). On the 12th Nov. 1884, amendment was made by striking out the portions of the title in italics and all parts of the specification relating to the matters so struck out. The specification as amended related to a mode of treating ordinary carbon pencils for use in electric lamps: they were immersed in a hydro-carbon gas or liquid, a strong electric current, increasing in intensity as the process went on, was passed through the carbon, whereby the carbon of the surrounding matter was detached and entered into the carbon pencil and filled up its pores and deposited a homogeneous layer upon the exterior. The current had to be increased to keep up the temperature, as the resistance and the heat varied inversely as the size of the cross section of the carbon. Ordinary carbon pencils not so prepared, when subjected to a strong current, shew lines and points of unequal brilliancy, due to want of homogeneity, the most brilliant parts being at the points where the sectional area is least. The specification stated, "In this process it will be seen that the carbon is never in contact with the liquid in which it is immersed, but surrounded by a carbonic gas of very high temperature. Beeswax, balsam, and most oils, if pure, operate satisfactorily; almost any hydro-carbon, in fact, will answer."

Claims: 1. "The herein described method of preparing the illuminating part of an electric lamp consisting of electrically heating the same, while it is surrounded by a carbon gas, or liquid. 2. A material for the manufacture of the illuminating conductors of electric lamps, produced by electrically heating carbon in a carbon gas."

The defence raised (*inter alia*) the issue that carbonic acid and carbonic oxide, though included in the term "carbon gas or liquid," would, if used, fail. Novelty was also denied; and the defendants relied especially on some experiments in volatilising carbon which had been carried out by one *Despretz*, and described by him in articles, of which a translation had appeared in *The Chemist* of 1849—50.

BUTT, J., gave judgment for the plaintiffs.

BUTT, J.—It is said that the patent is void, because the specification describes various methods of making the material, some of which methods will not answer; in other words, that it would mislead the public. * * * His Lordship referred to what the patentee stated in the specification, and continued:—He speaks

of a hydro-carbon gas, he speaks of a carbon gas, and a carbonic gas. From the evidence I do not think he meant exactly what he said in using any one of those expressions. * * * Strictly speaking, as I understand the matter, hydro-carbon gas consists of carbon and hydrogen alone, without any other elements mingled with it. That is clearly not what the patentee was referring to. I do not know whether very much turns on that, but when you come to the other two things mentioned, carbonic gas or carbon gas, probably the same thing is indicated. * * * If the specification is to be read as a direction to the public to use either one of those gases (carbonic acid or carbonic oxide), then I should agree that a process is described which is a futile process, which would be misleading to the public, and the objection would assume a very serious proportion indeed. But I do not think he really meant that. * * * Having regard to the expressions used,—having regard to Dr. *Tidy's* statement on oath (which is absolutely uncontradicted), that no person of ordinary knowledge in his senses would think of applying carbonic acid or carbonic oxide to this operation—it seems to me it would be an exceedingly hard and unjust construction and interpretation of this specification to hold that the patentee had invited the public to use carbonic acid or carbonic oxide, and so had rendered his patent void.

Appeal to the Court of Appeal (Cotton, Lindley, Lopes, L.JJ.).
Dismissed with costs.

4 O. R. 98. LINDLEY, L.J.—In considering the experiment it is important to observe that *Despretz* was attempting to fuse and volatilise carbon and not to produce it or make it in any shape or form. With reference to his objects the experiment was a failure, and he treats it accordingly. He gave no direction as to the best method of making carbon of any kind for any purpose, nor did he point out what precautions ought to be taken in order to avoid a general deposit of carbon over the whole apparatus. He saw that the carbon which was trying to fuse and to volatilise became smooth, bluish gray, and larger, and that sugar charcoal became denser, harder, brighter and more solid, but his observations as to the changes undergone by the carbon went no further. He did not examine the porosity of his product; he was not aware of the fact, if it be a fact, that the carbon experimented upon had become less porous or had undergone any change which made it peculiarly useful for any purpose whatever. * * * The rest of the evidence relating to *Despretz's* process consists of the testimony

of the scientific witnesses on behalf of the plaintiffs. It is worthy of remark that no carbon produced by *Despretz's* process ever appears to have been made. No one has ever seen it. The defendants did not produce any carbon so made. No one, in truth, knows anything more about it than *Despretz* himself published. The burden is on the defendants to show that *Despretz's* process is the same as the patented process, and to show that the substance obtained by him was in all respects the same as the substance claimed by the plaintiffs. The defendants have adduced no evidence to establish either of these propositions beyond what the plaintiffs' witnesses themselves stated on cross-examination. We have therefore only to examine their evidence, and we have carefully done so. Without referring at length to it, we consider : (1) that before the date of the plaintiffs' patent no one had ever intentionally made or attempted to make carbon for any purpose whatever by *Despretz's* process ; (2) that *Despretz's* process is not a practicable method of obtaining non-porous carbon for any useful purpose ; (3) that so far as can be inferred without actually making carbon by *Despretz's* process the carbon experimented on by him must have been superficially charged with graphite similar in all respects to that obtained by the plaintiffs ; (4) that there is no difficulty in making carbon fit for incandescent electric lamps by following the directions contained in the plaintiffs' patent ; (5) that carbon made according to the plaintiffs' patent is better adapted for incandescent electric lamps than any other form of carbon known at the date of the patent, and that this fact was never known to or suspected by *Despretz* or anyone else until discovered in 1878 by *Sanyer* and *Mann*, who communicated the discovery to *Cheesbrough*, the plaintiffs' assignor. In this state of the evidence we can only come to the conclusion that for all useful and practical purposes the processes are different and the products are different. By following *Despretz's* process carbon, resulting from the decomposition of carburetted hydrogen, is deposited over the whole apparatus, and is wasted ; whereas by following the plaintiffs' process the carbon is deposited where it is wanted and utilised. The substance obtained by *Despretz* was a mere scientific curiosity of no known utility whatever ; whereas the substance obtained by the plaintiffs is shown to be a valuable article of commerce, of great utility for the purpose of illuminating by incandescent electric lamps. It may be true that *Despretz* produced graphite, and that the plaintiffs produced graphite, and that long before 1878 graphite was used for incan-

descent electric lighting, but the fact still remains that of all the known forms of graphite that made by the plaintiffs' process was, in 1878, the best for the purpose they mention, and the carbon got by *Despretz's* process is not shown to be structurally the same as that made by the plaintiffs, nor that that which *Despretz* got was non-porous.

Such being the view we take of the evidence, it becomes unnecessary to decide what the consequences would have been if the defendants had succeeded in showing that the material produced by *Despretz* was non-porous and in all respects the same as that produced by the plaintiffs' process. We express no opinion whether in the case supposed the plaintiffs' patent would be bad, inasmuch as it showed how to apply to a useful purpose carbon which neither *Despretz* nor anyone else was aware had the specially useful qualities discovered by the patentee. When such a question arises it will be necessary to consider such cases as *Walton v. Potter*, vol. i., p. 488; *Walton v. Bateman*, vol. i., p. 490; *Muntz v. Foster*, vol. i., p. 312, on the one side; and *Losh v. Hague*, vol. i., p. 289, and *Harwood v. The Great Northern Railway Company*, vol. i., p. 224, on the other.

It remains to consider the objections to the specification and claim. One is that the expression carbon gas or liquid in the claim is ambiguous and too wide and misleading, and it is urged that the expression includes carbonic oxide and carbonic acid, neither of which will do. But every claim in every patent must be read and construed with reference to the specification and not as if the claim were an isolated sentence having no connexion with or reference to what precedes it. To see what is meant by carbon gas or liquid we must turn to the specification; and when we do so we cannot conceive that anyone reading this patent fairly, with a view to understand it, would ever dream for a moment that carbonic oxide or carbonic acid could answer the purpose or could be meant by carbon gas. The specification clearly points out that carbon is to be deposited, and the presence of oxygen is to be avoided. The evidence shows that in its technical sense a hydro-carbon is a chemical combination of hydrogen and carbon and nothing else; and that beeswax, balsam, and oils are not technically hydro-carbons. But the evidence also shows that, so far as is known, every substance which is a hydro-carbon either in its technical sense or in the looser sense in which the patentee uses the expression, does answer the purpose; and there is no evidence that anything which answers the description

of hydro-carbon in either sense will not answer the purpose. In this state of the evidence it is impossible for the Court to say that the specification is open to serious objection, or is insufficient on this ground. The next objection that requires notice is, that it is contended that the evidence shows that it is essential to success to increase the temperature gradually, and that the specification is insufficient because it does not point this out. Now the evidence certainly shows that the maintenance of a high temperature is that which distinguishes *Cheesbrough's* process from *Despretz's* experiment, and although *Prof. Demar* points out the importance of a gradually increasing current, neither he nor any other witness says that the temperature ought to be low to begin with and be gradually raised. Their evidence comes only to this—that the temperature must be kept up and the electric current must be increased or the temperature will fall. But the patentee himself tells you this. He says that the temperature must be as high as 7,000° Fahr., and the sentence in the specification “as the carbon increases in size more current is required to maintain the temperature,” is shown by the evidence to be useless and an obvious truism to those who understand the subject, unless the sentence is understood to be a direction to keep up the temperature; and when we find that in fact no difficulty is experienced by reason of defective instructions on this point, the Court cannot hold as a matter of law that the specification is not sufficiently explicit. If the defendants had shown that the directions as to temperature were not practically sufficient to enable a competent person to make the patented articles the case would be very different; but they have not attempted to do this; they rely on the words used and on the evidence as to temperature already alluded to. This, in our opinion, is not sufficient for our purpose. If the language of a specification is clear enough to guide a competent workman and enable him to obtain the desired result, we cannot see how a court can hold the language insufficient in point of law. No doubt it is for the court and not for a workman to construe the specification; but if a workman says it is a sufficient guide to him and the court believes him, the court must hold that as regards clearness of description the specification is, in point of law, sufficient. For the foregoing reasons we are of opinion that there is sufficient originality and novelty in the patented process to support the first claim, and sufficient difference in the thing produced to support the second claim.

ELSEY v. BUTLER.

[1886. 1 O. R. 189.]

Particulars of Breaches.

Action by assignee for infringement of a patent granted 12th Feb. 1883, No. 761, to *G. Bentley* for "improvements in the manufacture of lace in twist-lace machinery and in apparatus employed therein." The plaintiff delivered particulars of breaches alleging that the defendant had infringed "by the production in a twist-lace machine or in twist-lace machines of lace fabrics in the manner described in the specification of the said patent, p. 3, l. 22, to p. 9, l. 39, or in a manner only colourably differing therefrom; and by the use of the improved combinations of apparatus therein described, and also in particular by the production in a twist-lace machine or in twist-lace machines of fabric known as 'Double tie Swiss net' in the manner described in the specification of the said patent, p. 6, l. 57, to p. 7, l. 38, or in a manner only colourably differing therefrom, and by the use of the improved combinations of apparatus therein described."

The specification was somewhat long, consisting of 7 pages of description and 8 claims.

The defendant applied for leave to deliver interrogatories, or for further and better particulars of breaches. PEARSON, J., refused both applications.

FAIRBURN v. HOUSEHOLD.

[1885. 2 O. R. 195; 3 O. R. 128, 263.]

Infringement by taking part of a combination—Construction.

Action for infringement of a patent granted to *Joseph Hall* 18th Nov. 1880, No. 4757, for "improvements in tram-car engines partly applicable to other purposes."

The action was commenced in the Chancery Division; place of trial, Manchester. On the 27th July, 1885, MANISTY, J., made an order at Manchester under O. xxxvi. r. 34, that the action should be tried before KAY, J., in London. The plaintiffs appealed from this order and the Court of Appeal (Cotton, Lindley, L.JJ.) discharged it.

The action was tried Feb. 5th, 1886, at Manchester. The invention related to an injector for forcing the exhaust steam in a steam engine back into the boiler after pumping it from the

2 O. R.
195.3 O. R.
128.

condenser. The specification showed a means of lifting the water from the condenser in a column divided by central parts of the apparatus to the orifice leading to the boiler. It was here met by another jet of steam which forced the water so raised into the boiler. The specification stated :—" the object of this invention is to return all exhaust steam back to the boiler after being used in the cylinders by apparatus which I call a double rotary knuckle pump, which acts as an exhauster, steam condenser, and double pump for returning the whole of the steam to boiler partly or wholly condensed by the one combined apparatus ;" and went on to describe it with reference to drawings, especially to Fig. 2, in which was shown a transverse horizontal pipe J for the steam, the water rising on both sides of it.

Claim 8. The double lift and force injector, shown on Sheet 3, Fig. 2, for creating a vacuum in the suction pipe, inhaling the water into the injector after passing the water lifter, and by the single manipulation performing the double effect of lifting the water and forcing the same into the boiler by the aid of a jet of steam at one and the same time substantially as described and illustrated.

DAY, J. (sitting without a jury), gave judgment for the defendants.

Appeal to the Court of Appeal (Cotton, Lindley, Lopes, L.JJ.). 3 O. R.
263.
Appeal dismissed.

COTTON, L.J.—The only question which has been argued before us is whether *Hall* has sufficiently indicated that the water-lifting part of his apparatus is to be a water-lifting apparatus where the water will rise into the vacuum chamber in a divided column ; that is to say, in two columns. It is said that that is the effect, and undoubtedly it is the effect, of putting J into the centre of this column which we have here. If there is a space on each side of J, which if it was put in the centre there would be, the water must go up in a divided column, and not unite until it gets to about M.

When one comes to look at the claim one finds this, the patentee does not in any way claim the lift as a double lift alone, but what he says is : (his Lordship read *Claim 8*). Now, what is relied upon by the appellant here is that expression " double lift " ; and it is said that what is here described with reference to these drawings, and what it is in action, is a double lift. In my opinion it is not a double lift at all, it is merely a lift by means of which the water rises into the vacuum chamber in two columns. That is not a double lift in the sense of a lift which, having two

parts, each performs the process of lifting. When one looks in the other part of the specification to see how he has used the word "double," we find he uses the expression "a double knuckle rotary pump," and "each double rotary knuckle pump;" that means that he has two rotary knuckle pumps combined together in one machine. That is what he calls a double rotary knuckle pump; and taking that, in my opinion, this lift is in no sense a double lift, although the result, in fact, of it is that the water rises in two columns. Well, undoubtedly here the word "double" is not used in the same sense as it is in the previous part of the specification to which I have referred. How is it used here? The learned Judge has held that it means an instrument which performs the double function of lifting the water and forcing the same into the boiler; that is to say, that the "double" refers not only to the lift, but to the whole combination of the lift and force injector. In my opinion, that is the right view. It is very true that that is not using the word "double" in the sense in which it is used in a different part of the specification; but that other sense will not really properly describe what we have here, even if the word "double" applied only to the lift. And when we look at the previous part of the specification the patentee does not refer to the lift as a double lift, but he refers to it in this way: "The object of this my invention is to lift or draw water by suction," (nothing said about the two columns or the effect of raising the water by its being divided,) "and to force the same into steam boilers." How? "By one combined instrument." That is the same as, by the single manipulation, performing the double effect of lifting the water and forcing it into the boiler by the aid of a steam jet at one and the same time.

But what is urged is this,—the patentee refers here to his drawing, and he says, "as described and illustrated." Well, I think, looking at fig. 2, a man following that would probably assume that pipe J did go through the centre of K, M; but, in my opinion, that is not enough. A man, in his specification, ought to point out that which he says is the essential invention comprised here in more definite and explicit terms, so as really to show what his invention is and what he has claimed by the specification. In my opinion, that is not done here; and as the plaintiff's claim against the defendants is put solely on the ground, that they are using a lift which consists of a pipe dividing the column of water, he has not described that in his specification in such a way as to enable him to maintain his action in respect of what the defendants are

so doing. In my opinion, if that is his invention, the specification has not described it.

LINDLEY, L.J.—I think it is quite impossible to read this specification and come to the conclusion that this patentee has claimed as an important part of his invention, or as a thing which is the essence of his patent, the division of the column of water by means of the steam pipe J. It is quite true, if you look through the drawings, you may see that the steam pipe J, with the transverse pipe running across the much larger pipe, will divide the column of water into two; but not only has he not claimed it, but he has never pointed out the importance of it. What he has claimed is not that at all, but what is set out in claim 8 * * *. He does not point out, either in fig. 2, still less in his claim, that the essence of his invention is what he now says it is—this transverse tube J—but his invention is this transverse tube J, plus a great deal more that the defendants have not copied. And, it appears to me, it would extend the scope of patents to a degree which would be alarming to inventors and other persons engaged in scientific pursuits if you were to hold, with regard to a patent like this, that a small portion of it, adopted by somebody else, not in combination with the rest of the invention, but solely and separately, and without in fact ever having pointed out that the part so taken solely and separately was of the essence of the invention, is to be held to be infringement.

FOWLER v. GAUL.

[1886. 3 O. R. 247.]

Particulars of objection.

Action for infringement of a patent granted the 2nd October, 1883, No. 1667, to *James Fowler*, for “improvements in vessels for holding oils.”

The defendants, by their particulars of objections, alleged (*inter alia*) (5) That the alleged invention was published prior to the patent by certain patents and the specifications thereof (naming them); (8) The plaintiff’s specification claims some of the matters specified or patented in certain specifications (naming them).

The District Registrar ordered better particulars showing in detail what part or parts of the patents or specifications respectively referred to in the 5th and 8th objections showed prior publication, and what parts were relied on as being claimed by the plaintiff’s specification. In default of delivery, objections 5 and 8

to be struck out. The Judge at Chambers confirmed this order, and on appeal the Divisional Court (Denman and Hawkins, JJ.), dismissed the appeal.

DENMAN, J.—*Fowler v. Lloyd* (vol. i., p. 196) was decided under an earlier statute. At present the Act which is operative upon the matter is the 46 & 47 Vict. c. 57 (his Lordship read s. 29 (3), *supra*, p. 14). The defendant wished us to construe that to mean this, that where one of the grounds is want of novelty the one thing that the party who impeaches the patent on the ground of want of novelty is bound to state is, first, "I impeach it on the ground of want of novelty," and then to state the time and place of the previous publication or user alleged by him, and no more. I apprehend that that is putting too narrow a construction upon that subsection, and that it must state on what grounds he disputes it, and if one of those grounds is want of novelty, he must state reasonably on what grounds in respect of want of novelty he disputes it, and he must also state the time and place of the previous publication or user alleged by him. I do not see anything inconsistent between the two requirements, leaving to the Judge at Chambers that reasonable power which a Judge at Chambers possesses to take care that cases of want of novelty are not sprung upon the party against whom they are alleged which he may not be reasonably able to meet from the generality of the way in which the thing is expressed. In this particular case the want of novelty is suggested to be the prior publication of two specifications and of two provisional specifications. Those are alluded to, and the time of their publication is mentioned, but I do not think that that is enough in the case where the objection of want of novelty, relied on by the defendant, merely states that there are some things in those previous specifications which anticipate the invention of the plaintiff. I think where he does that, it would really be unreasonable to fling at the head of the plaintiff the two specifications alone, it being perfectly within the knowledge of the defendant and not within the knowledge of the plaintiff what parts he means really to rely on: and if there are several things, which in nine cases out of ten there are, I think it is right that he should be called upon to say, "I say that the thing shown in every part of that is an anticipation," or "in the diagram so and so," or "in paragraph so and so," or "in the explanation given in pages so and so, from line so and so to some other line," just sufficiently to enable the plaintiff to know in what respect he is to be attacked, or as to what particular part of the matter, if not the whole, he is

going to be charged with want of novelty. That seems to me to be a reasonable thing. The Judge has done it here in his discretion, and I do not think we ought to interfere with that discretion.

GANDY v. REDDAWAY.

[1883—5. 2 O. R. 49.]

Claim too large—Evidence.

Action for infringement of a patent granted *May 7th*, 1877, No. 1809, to *M. Gandy*, for “improvements in belts or bands for driving machinery.” The object of the invention was to obtain driving belts which would not stretch, were not affected by atmospheric changes, and were pliable enough to run round small pulleys without cracking. The specification stated:—“In carrying out my invention I manufacture belts or bands of cotton canvas or duck ‘hard woven,’ either in widths to suit the size of such belts or bands without folding, or in wider widths folded up so as to form the necessary thicknesses, or plies, or in part folded up and part made of separate thicknesses. The cotton canvas or duck is put together either by hand, or by folders, or guiders, and formed into a belt of the desired width and thickness, and then stitched with rows of stitching, such rows of stitching being spaced about half an inch apart the whole width of the belt. The belt or band so constructed is then soaked or saturated in oil, such as linseed oil, either boiled or raw, or a mixture of such linseed oil with other oils or spirits, such oil or mixture being thinned if necessary by heat or spirit to facilitate saturation.”

Claim: Constructing belts or bands for driving machinery of cotton canvas or duck, “woven hard” and stitched and saturated or soaked with oil such as linseed oil, or any combination thereof, as herein described or set forth, or any modification thereof.

The defence (*inter alia*) denied sufficiency of specification. At the trial the evidence showed that cotton canvas woven hard was, in the trade, divided into classes having reference to heaviness of warp and weft, and these classes were numbered from 1 to 10. Of these, only Nos. 2, 3, and 4 would practically answer to carry out the invention; anyone attempting to use the other numbers would fail; certain numbers would crack if used on small pulleys.

PEARSON, J., dismissed the action with costs.

Appeal to the Court of Appeal (Brett, M.R., Cotton, Lindley, L.JJ.). Appeal dismissed with costs.

2 O. R.
52.

ESHER, M.R.—What do you find in this claim, because that is the main point. There are descriptions given in the specification of the object the patentee had in view, but when he comes to claim and to state his invention, it is “an invention for constructing belts or bands for driving machinery.” It does not say belts or bands for driving any particular sized machinery. It is for “belts or bands for driving machinery”—that is, all machinery which is driven by bands or belts. * * * * It means this, that if you take any of that class of cotton canvas known in the market as “hard woven canvas,” to make belting for machinery in the ordinary way for an ordinary machine, that will do. There is no distinction pointed out that it will only do for machinery of one particular size, and that it will not do for another. It is that that will do for belting.

If that is the construction upon the face of it, could that construction be altered or modified by evidence? I think it might. If it could be shown that, although those words “cotton canvas woven hard” do on the face and surface of them claim the whole class, yet no ordinary workmen of ordinary skill and knowledge would think of taking any more than one part of that class, why then I should say that the effect would be that this would be a claim not for that part which no ordinary workmen would ever take, because that would be absurd and make it bad at once, but it would bring the true construction of the specification and claim, with that knowledge, to be only for that part which an ordinary workman might take. * * * *

2 O. R.
53.

His Lordship referred to the evidence and continued:—If, therefore, it is a claim for the whole, it is bad. It is bad because it will not work, and it is bad because really the claim for the whole was not the real invention. What *Gandy* had really found out was, not that the whole class of “hard” would do (he had not found that out, and it is not true, because that will not work), but what he had found out was that cotton canvas made as the No. 2 of that class is made, would do. He says: “Take that weight, that number of warps and wefts, and weave it so as to be hard, and then you can make belts of it.” That is what he found out; but he had not found out that, taking the other weights, and other numbers of warps and wefts, or whatever you please, they being hard would work. He had not found that out for a very good reason, because they will not work. Therefore he has inadvertently not properly described the invention, and I am sorry for him.

But now it is said that evidence was given which will show that a workman of ordinary skill never would have tried any but those including the Nos. 2, 3, and 4. There is not a single word of evidence from the beginning to the end that goes to that point at all—not one. The questions which were asked were asked of *Gandy* himself—what he knew, and what he would have known as to the necessity of rejecting them; but no question was asked from the beginning to the end whether an ordinary workman would have rejected all but those which will actually work. Then it is said that the defendant did not ask it. The answer is, that the person who is supporting the patent has to ask that. If that was the true solution it was for them to show it, and they never asked a question to show it. It was not for the defendant to show it. It was enough for him to point out, if he could by evidence, that the claim was a claim larger than the invention, and that he did by the evidence of *Gandy* himself. That was the reason which governed *PEARSON, J.*'s decision, and so far from differing from him I am sorry to say that from the inadvertent way in which this specification has been drawn up, that which was a real and valuable invention in itself seems to me not to have been claimed. The claim is too large; the claim is not for the real invention; and for these reasons the specification must be held to be bad.

THE GERM MILLING COMPANY v. ROBINSON.

[1884—6. 55 L. J. Ch. 287; 55 L. T. 283; 1 O. R. 217; 3 O. R. 11, 254, 399.]

Practice—Inspection—Costs of Particulars—Certificate.

Action for infringement of a patent granted the 17th *July*, 1875, No. 2560, to *T. Muir*, for “improvements in the manufacture of meal and flour from wheat, &c.”

The writ was issued on the 31st *August*, 1884. After delivery of the statement of claim, the plaintiffs gave notice of motion for an interlocutory injunction, and for an order to inspect the defendant's mills.

The motion for injunction stood over to the trial, the defendants undertaking to keep an account.

Order for inspection refused.

KAY, J.—The reason for which I think it is not proper to grant an inspection at this moment is this, that the patent, as stated shortly, seems to me to be a patent for a rather elaborate process of manufacturing meal and flour so as to separate from the meal

1 O. R.
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and flour so manufactured the germ part of the grain. I do not wish to give the least opinion upon the matter one way or the other now, but it may be that every single process of that may be old, and yet the whole process, by being combined in a new way to that in which it has ever been used before, or for other reasons, may be a perfectly good subject of a patent. On that I do not mean to give an opinion one way or the other; but the plaintiff in this case has stated that the defendants have infringed, and the only particular of breaches he gives is this: "Since the date of the assignment the defendants have manufactured, and they continue to manufacture, meal and flour from wheat and other grain by a process identical with, or substantially similar to, that described in the specification." Of course that is not a particular at all. It is as general a statement as you could put into words; and to call that a particular of breaches seemed to me to be a contradiction in terms. In his affidavit, no doubt, the plaintiff does say something a little more definite. He says, in the fifth paragraph, "The defendants are extensive corn millers at Deptford Bridge Mill, Greenwich, and they have recently introduced therein machinery for reducing wheat into meal and flour by means of rolling and sifting, and I verily believe that the defendants are now manufacturing wheat into flour by means of my said invention, and by the process or means described in my said specification, or only colourably differing therefrom." That has not been answered. The first thing I have to consider is, what sort of evidence is that? There is a rule in this Court, that where a person states, as he may in an affidavit upon an interlocutory motion, his belief of a fact, he must state the grounds of that belief. What are the grounds for that belief? There are absolutely none; I mean there are none stated. That means this, then: "I suspect" (because "I believe" without any grounds is only "I suspect") "that the defendants are manufacturing according to my process." Thereupon, without any particular, without any evidence which the Court ought to look at as being evidence of infringement, I mean even the most *prima facie* evidence of infringement, the plaintiff comes to the Court and says, "Grant me inspection." The defendants' answer in effect, because I am not giving the words, is, "I have a great many processes in my mill which are trade secrets, which I do not want people to inspect." That is a very good answer unless the plaintiff makes out a strong ground for inspection, but in point of fact the whole of this pleading and evidence before me now only amounts to

this :—for some reason, which is not expressed, I, the plaintiff, say, “I suspect the defendants are infringing this elaborate process of mine.” If he had said, “The nature of the flour they produce is such that it could not have been done by any other process,” and satisfied the Court of that, that would be one thing, and it would come very nearly to the well-known case before Lord ELDON, in which inspection was granted (vol. i., p. 74). But he says nothing of the kind; and this is really no more than this, taking the pleadings and affidavits, and everything which are before me, “I suspect, and I will not tell you my grounds for suspecting, that the defendant is infringing this elaborate process of mine, and I ask for leave to go and look into his works to see whether I can make a case against him or not.”

Subsequently the defendants consented to an order that the plaintiff should inspect their mills, and such inspection took place, the plaintiff taking 93 samples.

Thereupon the defendants applied for leave to inspect the plaintiff's process.

KAY, J.—I ask myself, will the Court be at a disadvantage at the trial if it has given inspection to one side and not given the same liberty to the other? * * * Looking at the nature of the patent and the questions at issue, it seems to me that the Court very probably will be under some disadvantage if it does not have very complete evidence as to the process which these plaintiffs actually carry out under their patent, and also and mainly on the question whether in point of fact what the defendants are doing is or is not an infringement. It seems to me important that evidence should be given of the mode in which the patent is worked and the mode in which the product is produced by the plaintiffs. I have no suggestion that there is any trade secret or any reason whatever in this case for refusing inspection. The only suggestion made is, you can tell sufficiently well what my process is from the description in the patent, or if you cannot, the patent is bad; therefore it does not matter, but I do not agree with that. It may matter, and matter very materially, when we come to have the evidence on which the plaintiffs will rely for infringement. It may very materially assist the defendants in contesting the question of infringement that they should be by inspection prepared to describe particularly the process which is carried on under the patent of the plaintiffs. Another very curious fact is this, that it is suggested the plaintiffs are not working this patent themselves. It seems to me I must take it

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on the evidence before me as admitted that they have the means of giving to the defendants inspection of this machinery either as worked by themselves, or if they do not work it at all themselves, then as worked by some licensees who at their suggestion would allow the defendants to inspect, and if they have that means it seems to me right that they should allow an inspection in the usual way by the defendants, or their scientific witnesses (following the usual order), of their machinery at work either as worked by themselves if they do habitually work it, and if they have any mill, or if they have not, then as worked by some licensees of theirs, if there be any licensee to grant the inspection. I have nothing to do with the licensee and no control over him in any shape or way, and it may turn out for anything I know that there is no licensee who will allow it; but on this evidence uncontradicted I must assume there is a licensee who will allow it, and therefore I think it right to make the usual order for inspection, and liberty to take samples.

Order.

"That *A. B.* and one other indifferent person appointed by him and *C. D.* one of the Defendant's solicitors be at liberty at all such times and as often as in the opinion of the said *A. B.* be requisite on giving three days' notice to the Plaintiffs to enter into some business premises to be selected by the Plaintiffs where the process or mode of working referred to in the specification mentioned in the statement of claim can be seen at work and to inspect and examine there the whole of the machinery fitted in such mill and to take such samples of the finished and unfinished products of the working of such machinery as in the opinion of the said *A. B.* may be necessary for the purposes of this action. And it is ordered that such machinery be put to regular work upon such inspection. The costs of this application are to be costs in the action."

The particulars of objections were :—1. That *Muir* was not the first inventor; 2. That the invention was not new; 3. Fraud on the Crown; 4. Variance between provisional and complete; 5. Not subject-matter; 6. Specification insufficient; 7, 8, and 10 gave a list of prior publications and users.

The action came on for trial before STIRLING, J. The patentee being called, admitted he had made flour by the process and sold it in the ordinary course of business before the date of the patent. The Judge, holding this to be user for profit and not experimental, dismissed the action with costs on the higher scale, which costs were to include shorthand notes of the evidence as he had referred to them.

Application was made for certificates by both sides.

STIRLING, J.—It seems to me the Legislature have thrown on me a very difficult task indeed. Whether it was contemplated by the framers of the Act that s. 29 (3) (*supra*, p. 14) should apply

to a case of this sort I do not know. The case stops, and comes to an end without it being formally intimated that the plaintiffs' case was concluded (though, I believe, in point of fact, *Muir* was the last or almost the last witness), and without the defendants' case being gone into. Therefore I am now called upon to say what particulars delivered by the defendants are reasonable and proper, without having tried the case to the end so as to enable me to form a clear judgment on the subject.

There are two remarks which I desire to make on the language of the Act. In the first place, I must be satisfied that the particulars are reasonable and proper. It is not enough for me to say that they are not unreasonable. I think that the reason of that is not far to seek. It was intended by the Legislature that the Judge or the Court should exercise a certain amount of control over these particulars, remembering what we all know to be the practice when particulars are framed. Not unreasonably—far be it from me to say so—when a patent comes in question, the solicitors or the advisers of the defendants raise every possible objection to the patent, consider all sorts of things which in various views of the case may turn out to be useful to them, and they deliver particulars of objections accordingly. In this case I am far from quarrelling in any way with the manner in which the advisers of the defendants have discharged their duties to them in that respect. But I must be satisfied, having regard to what knowledge I have acquired in the conduct of the case, that the particulars which they have delivered are reasonable and proper. I conceive it is no part of my duty either to put myself back into the position in which the advisers of the defendants were when they framed these particulars of objections, or, on the other hand, to carry myself forward by having additional evidence brought before me in order that I may judge of the validity of these particulars of objections. The tree must lie where it falls, for better or for worse, and I must do the best in determining what particulars of objections ought to be allowed.

It appears to me this is a task of very considerable difficulty in the present case. The proper line at which I can hold that the particulars are reasonable and proper on the one hand, and at which I can hold certain others to be not unreasonable, is one which I have found it extremely difficult to satisfy my mind about. I can only say that, having looked into them as best I can, I state the conclusions which I am prepared to certify to. The learned Judge then dealt with the particulars subsequent to the 6th.

I come to the cross-application, if I may so call it, made on behalf of the plaintiffs, namely, with respect to certifying to his particulars being reasonable and proper. If I had arrived at the stage at which I properly could give costs, if I were giving any costs to the plaintiffs, I am bound to say that, treating the action as far as it has gone, and dealing with it in favour of the plaintiffs in the same way I have done as to the defendants, I should hold that the particulars of breaches were reasonable and proper. But the case has not been tried out, and I cannot give any costs. I do not think it is a proper case, not having heard the defendants and not knowing their case, in which to give the plaintiffs any costs at all, and therefore I cannot see that I am entitled to give a certificate, which is only available, as I read the section, in case costs are allowed to the party in whose favour the certificate is made. Therefore I refuse to give the certificate.

On the learned Judge's attention being called by defendants' counsel to the objections numbered 1 to 6 in the particulars of objections, he stated that his certificate would not extend to those, because the costs relating to them would be part of the general costs of the action.

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The plaintiffs appealed to the Court of Appeal for a new trial, on the ground that the patentee was in error in the evidence he had given. The Court (Cotton, Bowen, Fry, L.JJ.) not being satisfied of this, dismissed the appeal.

HADDAN'S PATENT.

[1884—5. 54 L. J. Ch 126; 51 L. T. 190; 2 O. R. 218.]

Practice—Revocation—Communicated Invention.

Petition under s. 26 (*supra*, p. 12) for revocation of a patent granted the 21st June, 1883, No. 3096, to *H. J. Haddan* for "improvements in the preparation of food for infants and invalids." The specification described and claimed a mode of macerating cereals in fresh milk and gradually heating up to 150° Fahr., and so converting the starch into dextrine and grape sugar. The petition was presented in April, 1884, by one *Mellin*, and asked for revocation on the ground (*inter alia*) that the petitioner had publicly manufactured, used, and sold food for infants substantially as specified before the date of the said patent. The petition also alleged fraud, but no evidence was given of this at the hearing. The respondent was in the first instance *Haddan*, who had patented the invention as a communication from *William Horlick* in America, but subsequent to the petition being pre-

sented *Haddan* assigned the patent to *Horlick*, whereupon it was ordered that *Horlick's* name should be substituted for *Haddan's* as respondent, *Horlick* and *Haddan* paying each into Court £25 as security for costs. The petition, which was one of the first under the new Act, was ordered to go into the general paper.

The petitioner took out a summons for leave to interrogate the respondent, which was adjourned into Court: KAY, J., gave leave, saying after reference to sub-s. 5, 6, and 7, of s. 26 :—Subject to that the new Act leaves the practice to be governed by the ordinary practice upon a petition to the High Court. The learned Judge then referred to O. lxxi. r. 1, and s. 100 of the Judicature Act, 1873, said :—Clearly “plaintiff” in O. xxxi. r. 1 means “petitioner,” and that rule applies to petitions of this kind just as much as to any other kind of petition * * * * On the usual terms of the petitioner making the usual deposit, I shall allow him to administer interrogatories to the respondent.

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Ch. 126.

The petition came on for hearing before KAY, J., who held that *Mellin* had used the invention before the date of the patent, and ordered the revocation prayed. He further ordered the petitioners' costs, save in so far as they were satisfied by the £50 in Court to be paid by the respondent.

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HARRIS v. ROTHWELL.

[1885—6. 3 O. R. 243, 383.]

Particulars of objection—Evidence of prior publication.

Action by assignees for infringement of a patent granted the 16th April, 1880, No. 1555, to *T. Coltman* for “improvements in knitting machines.” The specification of the invention was of great length, there were 19 figures and 6 claims.

The defendant by his particulars relied on prior publication in eight specifications, stating further as to each that he relied on the whole specification, but more particularly on certain parts which he referred to. He also relied, for the same purpose, on a German book in the library of the Patent Office, as “containing a description accompanied by drawings of the plaintiffs' alleged invention, or some part thereof, especially as set forth at pp. 339 to 341.” The plaintiffs applied for further particulars, stating what portions of the invention were alleged to have been published prior to the date of the patent in each of the publications in the particulars mentioned by reference to the claiming clause of the specification of the said patent; also by stating more specially the parts of the

alleged publications relied on by defendant, and leave was asked to administer interrogatories.

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CHITTY, J.—The point is whether, under the special circumstances of this case, the particulars of objections point sufficiently to the claims in the plaintiffs' specification which are intended to be attacked. The object, of course, of these particulars, whether particulars of breaches or particulars of objections, is fairly to inform the other side of the nature of the points intended to be raised. This case is a somewhat special one, because the invention relates to matters of considerable intricacy and complication. * * * I think that though these objections would be in the ordinary course sufficient, yet inasmuch as there are six claims, and having regard to the nature of the particulars in each claim, and the nature and intricacy of the invention, it will be right for the defendant to show in his particulars of objections to which of the said six claims he intends to address the objection. That, it is said, will throw a great deal of labour upon him, but he is necessarily in possession of the nature of the objections he intends to raise, and he is bound to give the other side, the plaintiffs, fair information on the subject. He must have that information more or less at his command, that is to say, if the particulars of objection are, what they ought to be, honest and serious objections. Of course if they are not that, then it will give him a little more trouble than apparently he has been disposed to take up to the present time.

Order.

"Better particulars to be given by the Defendant stating to what claims in the Plaintiffs' specification each of the objections in his particulars was pointed and striking out the words denoting reliance upon the whole of the various specifications on which he relied as anticipations he having liberty to refer to other pages and lines of such specifications in addition to those already referred to, and not referring generally to the book on which he relied but only to specified parts thereof. Leave to both parties to administer interrogatories. Costs to be costs in the action."

A case was subsequently stated for the opinion of the Court, whether under circumstances mentioned in the case there was sufficient evidence, if not rebutted, of publication prior to the date of the plaintiffs' patent in this realm of two German specifications, either of which if translated into English, would with the drawings afford sufficient information to a competent workman to enable him to carry out in practice the invention which was the subject of the plaintiffs' patent. The drawings of either specification were in themselves insufficient to give such information.

The Patents Journal is a periodical published at the Patent Office. It is supplied to a large number of subscribers, and copies are placed in the library of the Patent Office on the day of publication. Copies of the Journal are from time to time collected in consecutive order, and are bound into volumes and placed on the shelves of the library of the Patent Office, and are open to public inspection.

In the Journal of 27th *Sept.*, 1878, in a list of patents granted in Germany, was a mention of the first specification thus :—2372, *G. F. Grosser*, of Markersdorff, near Burgstadt, Saxony, for “a thread guide for knitting machines.” Dated 25th *August*, 1877, class 25. A foot-note stated :—The specifications may be consulted at the Free Public Library of the Patent Office. This foot-note was erroneous, as the specification did not arrive at the Patent Office till 9th *Dec.*, 1878, when it was entered in a book of gifts, in which book an entry was made of all the German specifications received.

The second specification was thus mentioned in a similar list in the Journal of 28th *Nov.*, 1879 :—8281, *Seyfert and Donner*, of Chemnitz, for “a thread guide for knitting machines.” Dated 17th *April*, 1879, class 25. It had a similar foot-note, but the specification did not arrive at the office till 5th *Feb.*, 1880, when it was entered in the gift book.

After being so entered the course was as follows :—The specifications were placed in boxes in numerical order, and put upon the shelves of the library in such a position as to be accessible to the public. They were kept in such boxes until the number of specifications requisite for binding into a volume had been received. The specifications were then taken out from the boxes and bound into volumes, which volumes were placed upon the shelves of the library. The two specifications were in due course bound into volumes with other specifications. The volume containing 2372 was sent to the binder on the 25th *July*, 1879, and returned 27th *Aug.* 1879. The volume containing 8281 was sent to the binder on the 19th *Mar.* 1880, and returned 28th *July*, 1880.

CHITTY, J.—A question of this kind is a question of fact ; and really the only matters that I have to consider are what are the fair inferences to be drawn from the facts admitted. Have these German specifications been published in this country in such a way as to become part of the public stock of knowledge in this country ? For that purpose it is not necessary to show that the knowledge has been acquired by the public in general, or by the

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bulk of the public, or by any large number of persons; but if a sufficient number, as the late M. R. said, in *Plimpton v. Malcolmson* (vol. i., p. 377), knew it, or if the means of communication are such that a sufficient number may be presumed or assumed to know it, that will do. Some comments have been made upon the language used in that case, and probably if the M. R. had been asked to re-write his statement of the law he would have stated it not as a matter of presumption or assumption, but as a matter of fair and legitimate inference to be drawn from the facts proved. Of course, the M. R. did not mean any such thing as that an assumption was to be made without sufficient grounds.

His Lordship then discussed the statements as to the dealings at the Patent Office with 2372, and said:—It appears to me that the description that is given is sufficient to afford considerable facility to any member of the public who desires to find the book or the document in question. * * * * There is a period of considerably more than two years during which the document lies in the public library ready for inspection. What is the fair inference with regard to the question whether the public did or did not avail themselves of these facilities?

His Lordship referred to the comments in *Otto v. Steel*, *infra*, on *Plimpton v. Malcolmson*, and said:—I do not find any difference between the two learned Judges. What the M. R. was speaking of was, as I understand it, an inference of fact to be drawn from the facts proved, and with reference to the British Museum the M. R. certainly went the length of saying the fair inference was that a book in the British Museum was read. It is quite consistent with that, that PEARSON, J. was right in saying, in the case before him, the fair inference was that his book was not read, because the circumstances were different; and when you come to draw an inference of fact from the facts that are proved, you must carefully attend to the facts which are proved before you can say what the inference is. I do not understand the late M. R. to have been expressing a proposition of law, but merely saying what he considered to be the legitimate inference to be drawn from the circumstances proved before him. It appears to me, having regard to the length of time, having regard to the facilities which are offered by the fact that it is in the free public library, and having regard particularly also to the information which the Commissioners consider to be sufficient, and which, in my opinion, was sufficiently afforded to the public by means of the Journal to lead the public to the discovery of these particular

documents, the fair inference is that the public did avail themselves of the facilities thus afforded.

I have to draw the inference here from the actual facts that are proved, and it appears to me that the fair inference is that the public did avail themselves of the knowledge which was thus placed within their reach readily available to the public, and it is not necessary for me to go into the question whether any person did actually do it; but the fair inference is that it was done. Of course I take it as part of the facts of this case that it is admitted by the plaintiffs that for the purpose of the action in the event of the court answering either of the questions I have mentioned in the affirmative no rebutting evidence can be given by the plaintiffs. It would be absurd for the plaintiffs to give evidence that no person had read the document or gone there. That is out of the question, such negative evidence as that could not be given, and I am left to draw the inference on the facts that are agreed, and I am not at liberty to supply any other facts, but I simply take them as they are stated.

I have dealt with the main question in regard to the first specification subject to one argument, that the specification was in the German language, and I heard some argument with regard to the probability of men in this country being acquainted with a foreign language. The Commissioners of Patents evidently think—although this is only a matter to be borne in mind and is not a matter on which my decision would turn—that it is useful to communicate to persons in this country the fact that there are patents obtained in Germany, and to say, “You can come and read the specifications here in a public office in the German language.” That at least shows that the Commissioners consider there are a considerable number of the public who are competent by reason of their knowledge of the German language to avail themselves of the information which is contained in this foreign language. But shall I rely upon that? I am entitled, sitting here as a Judge of fact, to say that there are a considerable number of persons in this country who are acquainted with the German language, and I am entitled also to say that there are a considerable number of Germans in this country, and I should be wrong in excluding those who are Germans by origin who happen to be settled or resident in this country from being considered as part of the public for the purpose of the question I have to decide. I decline to do that, and I say they are part of the public.

Then this matter appears to me to be entirely covered by decision. His Lordship referred to *Lang v. Gisborne*, vol. i., p. 278, and the *United Telephone Company v. Harrison*, vol. i., p. 475, and said:—PEARSON, J., in his judgment in *Otto v. Steel*, expressed no dissent from that, but appears to treat the case as if there were no difference between a document in the English language and any one of what I may call the ordinary European languages. By that I mean the European languages which are to some extent known in this country. German is not Japanese and is not Chinese. I am not bound to say what inference I should draw even if it was in Hebrew or in some characters which were not intelligible except to some few very learned pundits in this country. That is not the point for me to consider. German is a language that is sufficiently known, and I have upon the authorities the opinion of three learned Judges that no difference ought to be made by reason of the document being in a foreign language which is not one of those occult languages which very few people in England would be acquainted with. What I have stated appears to me to be sufficient to answer the first question in the affirmative.

As to 8281 his Lordship said:—The question is exactly the same with the exception that the time is shorter; and I still think that I ought not to make any difference; that the fair inference, though the time is shorter, is that the public did in that time avail itself of the information placed at its disposal, and that I ought therefore to come, as I do, to the same conclusion. There were forty days during which the public were entitled to avail themselves of these means of knowledge, and I say that the fair inference is that they did. * * * There is no fair ground for the argument as to misstatement because the Journal gets into the hands of those who are interested in the matter, and if anybody had gone during the short period that the statement was not accurate they would have been informed that the German specification was published. They had that information from the Journal. It is said it is a mere periodical soon forgotten; but persons interested in inventions would bear in mind they had seen this in the Journal; they could go to the office and ask for it and they would be told "it has not come to-day, but it will come to-morrow," or "in a week" or whatever the time was. I am taking into consideration as the foundation of the inference I draw the times or periods during which the documents were actually there and were accessible, and I think it would be quite wrong to

attribute any force to that error of statement in the Journal which said that the documents were there when they were expected to be there seeing that they were actually there in a very short time afterwards.

HAYWARD v. HAMILTON.

[1879—81. Not reported.*]

Subject matter—Anticipation.

The plaintiffs were the registered proprietors of letters patent granted the 31st day of *July*, 1871, No. 2074, to *Edward Lambert Haynard*, for "improvements in pavement lights." The specification stated, "Pavement lights are commonly used to cover the areas in front of windows in the basements of buildings, and the object of my invention is to construct them that they may not simply allow the light to pass through, but that they may also direct the light in an inclined direction into the rooms it is desired to light. For this purpose I glaze the frame of the pavement light with glass which is moulded so as to be of a prism-like form on the under, resembling to some extent in this respect the glasses which are often inserted into ships' decks to give light below. The form and arrangement of the prism is, however, entirely altered in order that the light may be thrown forward in one direction, as already stated. One of the sides of the prism is upright, or nearly so, and the other side is inclined to it at such an angle that the light passing through the upper surface may strike this inclined side, and be reflected, or nearly so, within the prism, and issue from the upright, or nearly upright, side in the direction required. The sides of the prism may be flat or curved in an horizontal plane. I usually form the glasses to glaze pavement lights hexagonal on the upper surface, and fit them into an iron frame with corresponding hexagonal cells, but the glass may be made rectangular or of another form on the upper surface." The specification went on to describe the figures which showed various forms for the prism: in fig. 2 and also in fig. 5 two angles of the slanted sides were given. *Claim*: "The construction of pavement lights, substantially as described."

The defendant was working under a patent dated the 22nd *Sept.*, 1877, No. 3574. This action was brought in the Queen's Bench Division and the issues raised (*inter alia*) were novelty and subject-

* For the notes of this case I am indebted to T. Aston, Esq., Q.C.

matter. At the trial before HAWKINS, J., the jury (18th Nov., 1879), found:—

1. That having regard to the state of knowledge at the date of the patent it was not a new thing to form and arrange a prism so that the light might be thrown forward in one direction by making one of the sides of the prism upright, or nearly so, and the other side inclined to it at such an angle that the light passing through the upper surface may strike the incline side and be reflected completely, or nearly so, within the prism, and issue from the upright, or nearly upright, side in any required direction.
2. That having regard to the prisms described in the plaintiff's specification and shown in his drawings, and especially to the operative parts thereof, use in the transmission of light, the defendants used a glass light having the same operative parts for the transmission of light.
3. That the defendants had infringed the plaintiff's patent.
4. That it was a new thing to glaze pavement lights as the plaintiff had done.

The plaintiff on these findings moved for judgment before a Divisional Court (Pollock, B., Hawkins, J.). The defendants moved at the same time for a new trial on the ground that the verdict was against the weight of the evidence on the ground that one *Darker* had anticipated the plaintiff's patent. *Darker's* evidence was to the effect that he being a skilled optician had, in order to obtain selenetic designs, used prisms inserted in an aperture in the shutter of darkened rooms. He had in fact received the light on the angular face of the prism outside the shutter, but he further stated that the course of the rays of light was practically the same as in the plaintiff's prism. The Court entered judgment for the plaintiff and refused a new trial.

Appeal to the Court of Appeal (Bramwell, Brett, Cotton, L.J.J.). Appeal dismissed.

BRAMWELL, L.J.—I think the plaintiff is an inventor. I think he has found out and manufactured and patented a thing, an article, namely, a light directing pavement light. I do not think there is any very great quantity of invention in it; it is not as though a man had sat himself down to consider how he could make a sewing machine, or a grain-pressing machine; it is a much humbler piece of invention than that, and it may possibly be nothing more than that the idea struck him, and immediately the idea struck him he could apply it or carry it into execution by

a very obvious apparatus. But still it is an invention, and it is not the less an invention because it required but small inventive powers to enable him to do it. One may take an illustration in this way, the screw propeller: I suppose everybody knew that a screw used as it was would act in the way a screw propeller does; but the man who thought of it and applied it to a steamboat, which I suppose anybody could have done if the idea suggested itself to him, would have been called the inventor of a screw propeller or screw propelling steamboat, as the case may be. It does not depend upon the quantity of invention. Nor is it in this case the patenting of an idea. He does not say, "I thought of such and such a thing, and I claim a patent for it;" but he says, "I have thought of such a thing and I will show you how to carry it into execution," and therefore it is not open to any objection such as I have indicated: nor is it open to any objection in regard to the constituent parts of it being old. No doubt the prism as the plaintiff uses it is old, it is as old as the world that a prism used as the plaintiff uses it will direct light in the way his prism does, and the other part of his invention is not new, that is to say, the particular mode in which he makes his pavement light, but the combination is a novelty. The thing was never practised before, and undoubtedly a combination of two old things may be made the subject of a patent. It seems to me then that the plaintiff really is an inventor—he has found out something. He makes an article that was not made before. This particular case may be, no doubt upon the verge; but one cannot help making this remark, that it is very strange if it is no invention that it has never been done before. Why has it never been done before? Why, because nobody else found it out, which I take to be an equivalent to inventing, and I think, therefore, that his patent is sustainable. So much as to the first question. Then as to the infringement. That really is the most obvious thing in the world. I think it is a direct claim to do that which the plaintiff is doing.

BRETT, L.J.—I must confess that from an early stage I had very little doubt about this case. It seemed to me that the whole matter really depended upon what was the proper construction of the specification, and that if the specification did in truth claim a new machine, a new apparatus, or a combination, whichever you may please to call it, that then that combination was new, and it was palpable it had been infringed. If anything less than that new machine, made up of combined parts, was claimed by the specification, it seemed to me that the plaintiff's case must fail on

several grounds, namely, that if less than the whole were claimed, that which was claimed was not new, and if less than the whole were claimed, there was no infringement. So that, according to my mind, the whole case practically depended upon what was the true construction of the specification, and of the claim. In my opinion the proper construction of that specification is that the plaintiff claims in it a new pavement light, made by combining together so as to make a new machine or a new apparatus, or a new pavement light, an old frame, an old flange, and perhaps an old prism, which old portions of the now apparatus or machine had never before been combined together so as to produce the machine claimed by the plaintiff. In order to support that proposition one ought to examine a little the specification, and the very first phrase in it is this: "This invention has for its objects improvements in pavement lights." What is a pavement light? A pavement light, as we have seen it, and as it is bought and sold, is a particular article. "Pavement lights," he says, and therefore pavement lights in one sense existed before, "are commonly used to cover areas in front of windows in the basements of buildings, and the object of my invention is so to construct them" (what is the word "them" referred to? why, pavement lights,) "that they may not simply allow the light to pass through, but that they (that is pavement lights again) may also direct the light in an inclined direction into the rooms it is desired to light."

The problem which he had to solve was this: it is to be a pavement light, and it is necessary therefore that the upper surface should be horizontal, should be level with the pavement; it is necessary that it should be made to a frame strong enough to hold thick glass, and so thick that people may walk upon it; and it seems that it must be necessary to have something in the shape of a flange to the glass. And the other part of the problem was to arrange a pavement light that it might "direct the light in an inclined direction into the rooms it is desired to light"—that is to say, that it might direct the light which falls vertically on this horizontal pane of glass so as to pass into rooms which are not under it. That was the problem in fact. In order to make the light effective in a room, it seems to me it must go nearly horizontally into the room, because if the window were so far below the pavement that the light had to go at anything like a large angle down, it would only light a portion of the room, and, therefore, this thing can only be really used where the window of the

room is sideways, and where the top of the window is not much below the level of the pavement. Therefore, that gave him another datum line, which was that the side of the prism with which he was about to deal should be upright or nearly so. The problem he had to solve, therefore, was to construct a pavement light with the direction of two given lines in it, so as to throw the light sideways, and he states that to be the object. He says, "for this purpose I glaze the frame of the pavement light with glass, which is moulded, so as to be of a prism-like form on the underside, resembling to some extent in this respect"—that is, in respect only of its being a prism-like form—"the glasses which are often inserted into ships' decks to give light below. The form and arrangement of the prism is, however, entirely altered"—so that it is not a prism like the one in the ship's deck, but it is a prism entirely altered, and the only similarity between the two declared here is that there is a certain similarity in this respect, that they are in prism-like form but entirely altered—"in order that the light may be thrown forward in one direction as already stated. One of the sides of the prism is upright, or nearly so"—that was part of the problem he had to solve—"and the other side is inclined to it"—not at any particular angle but—"at such an angle that the light passing through the upper surface may strike this inclined side and be reflected completely or nearly so within the prism, and issue from the upright or nearly upright side in the direction required." Then he says, "In order that my invention may be fully understood and readily carried into effect, I will proceed to describe the drawings," and he says, "Fig. 1 is a plan of a pavement light;" and he describes it, to my mind, in unusually clear terms for a specification. His Lordship then read the claim and said: Therefore he does not claim a frame, he does not claim a frame which will hold glass with a flange, he does not claim a prism of any particular sort; but what he does claim is the construction of a pavement light, substantially as described, and it seems to me what he claims, and what he has just described, is a machine, or apparatus, or article, which is a pavement light. Now that pavement light he has described, and it is formed by the combination of three things which it may be said were known before. It is necessary, in order to make that pavement light of his, that there should be a frame; it is necessary that there should be flanges, so that the frame may hold with sufficient firmness the glass to be put into it; and it is necessary, in order to make that pavement

light which he describes, that the bottom part of the glass should be in the form of a prism, but in a particular form of prism, which may be described at large, and not with total accuracy, as a half prism, but a half prism of which the upper side must be horizontal, one side must be nearly vertical, and the other side at an angle, and such an angle that the vertical rays, when striking against the inner circles of the inclined side of the prism, may not strike the other side as to be reflected back into the prism, but may go at once through it. The true construction of the specification seems to me that he has claimed such a machine.

Then comes the question, Is such a machine, so formed, a new thing? The frame is not new, the mode of putting the glass into the frame is not new, and the fact of the lower side of that glass being in a prism-like form is not new, because that had been done in the decks of ships, and if this light had been substantially like the deck lights of ships, I should have thought that was a sufficiently analogous use to have prevented the novelty of this machine; but it is not the same prism as was used in the deck lights of ships, and it is not used for the same purpose. In the case of deck lights of ships the prism was used for dispersing the light both ways into the cabin that was beneath it, and the problem of throwing the light only one way, and thus into a room which was not under the light, was not a problem which had presented itself to the minds of those who had to deal with deck lights. It therefore seems to me that the deck light of ships was not an anticipation of this machine.

Then it was said that a prism used by a man of the name of *Darker* was an anticipation of the prism used by the plaintiff. In the first place, if this claim had been only for the use of the prism in the way in which it is used, I should not have thought that *Darker's* was an anticipation. It is true that *Darker* used the prism to introduce light from the outside into rooms; but it was no part of the use of that prism that the upper side should be horizontal, or that the one side should be vertical; it turned upon a pivot, and was merely used for the purpose of directing the light to a given point, but not directed so as to disperse it into a room at the side. Supposing you could say that the prism, as a prism, was the same as *Darker's*, it seems to me really preposterous to say that *Darker* had used a machine such as is anything like the whole, which, as I have said, is the subject-matter of the plaintiff's claim. Therefore *Darker's* prism is no anticipation at all, and if that be so, there is no anticipation of what the plaintiff

claims. I wish to say that I do not decide that *Darker's* prism might not have been an anticipation of the plaintiff's prism if the plaintiff had only claimed the prism. I assume for the purpose of this case that the use of the prism merely as a prism is old; but what I hold to be the plaintiff's claim is a new instrument or apparatus made up of three old parts which had never been combined before in order to make the whole machine. It seems to me, therefore, that the plaintiff has claimed a machine, and that that machine was new. That it is useful none have denied.

There was a point raised and discussed which for a time did seem to me to present a difficulty, namely, whether although this was new and useful it could be said to be an invention. Now the difficulty that that proposition presented to me was this: that I did not recollect of myself any case in which, where a thing had been pronounced to be new and useful, the question of whether it was an invention had been ever discussed, or even left to a jury, for instance. It seemed to me in all previous cases it had been taken for granted that if the thing were new and useful there must have been an invention in order to arrive at a thing that can be so described, and I should say that in nine hundred and ninety-nine cases out of a thousand that must be so. I say if the thing is new and useful it is impossible to suppose there is not sufficient to make an invention, but I do not think as a matter of law that could be predicated as an absolute rule of law, because I think it is possible, although a thing were new and useful, it might be, under certain circumstances, that there was no invention in it. However, in this case, I think, taking this to be a combination, there was so much invention that we cannot say as matter of law that it was not an invention, and nobody at the trial seems to have raised that question, or asked that it should be left to the jury as a separate question. Therefore I think this machine is invented by the plaintiff and claimed by him as a new machine combined of old parts, or apparatus, or commercial article, whichever you please to call it, is new, that it is claimed as new, and therefore it is the subject-matter of a new patent. I do not find that the learned Judge at the trial in terms construed the specification, but I think that he, by the questions he left to the jury, substantially construed it in the way I think it ought to be construed.

His Lordship then discussed the question of infringement, and said:—It is wholly immaterial whether what was done by the defendant was done in accordance with the terms of his specifica-

tion or not, because the question is whether the defendant made articles which were an infringement of the plaintiff's patent. It seems to me that the articles made by the defendant and sold by the defendant are identical substantially with the articles made and sold by the plaintiff. They are the plaintiff's machines with a notch cut into the glass, which notch has no effect upon the strength and no optical effect whatever, but, in reality, is a sham. Therefore, in my opinion, not only are the machines similar and sufficiently similar to be an infringement, but they are identical. Then the only remaining question is as to whether the judgment ought to be entered, as it is, upon the questions found by the jury. The first question left by my brother HAWKINS seems to me to have been left out of caution, and in order to meet any difficulty which thereafter might be raised by the extreme ingenuity of counsel who were before him. It seems to me to be a question that he was asked practically to leave by the plaintiff's counsel, and did leave in order to be cautious. It is a mere abstract question of a scientific proposition, and it is a question which, to my mind, is wholly immaterial, and has no effect. In my opinion it was only put by way of caution, which caution, I think, my brother HAWKINS was right to use; but under the circumstances, I think it is a question which ought not to have been left as matter of law, and which can have no effect. The other two questions are material, and it seems to me, after the construction of the specification had been practically ruled, that the learned Judge left the right questions to the jury, which I think were substantially right, and upon the construction of this specification and the question of novelty and invention it seems to me that this patent was a good one upon the part of the plaintiff, and that it was infringed by the defendant. I think the judgment was right in the result, and that this appeal ought to be dismissed.

COTTON, L.J.—I am of opinion that the judgment appealed from ought to be affirmed. The question as to the validity of the patent depends upon the construction of the specification, which I was not able to see to be quite so clear as BRETT, L.J., seems to consider it; but in my opinion, upon the true construction of the specification, the plaintiff's is a good patent. Now what is it? It was contended that it was a mere claim for inventing this prism, and if so, that would not be sufficient; but when one looks at it one sees that it is not so; it is for an improvement in pavement lights, a prism not being a pavement light, but only part of an apparatus called a pavement light, and, in my opinion, what is

claimed is this—an improvement in pavement lights by a particular form of glazing, that is to say, by substituting for the old glazing of less or greater thickness, which had been in use before, a glazing which would not be simply a prism, but a prism so constructed as to direct the light in any required direction, not always in the same direction but in the direction which might be required, having regard to the depth below the pavement of the room and the size of the room; and that, I think, is indicated sufficiently by the specification which has been read by my brother BRETT, and I will not read it again. It is clearly stated that the object is to construct a pavement light with a prism so as to send the light in the direction required. My doubt was when it was so pointed out, whether it was sufficiently explained by the specification what the plaintiff's invention was, and how it was to be done; but I think, when one looks at the evidence, and to the words of the specification, it does. In my opinion he does sufficiently point out that which I think was his invention, namely, an apparatus called a pavement light, not only with glazing with a prism, but with a prism, or such portion of the prism so constructed as keeping the upper surface fixed to the pavement, as it must be, to send the light in the required direction. That, in my opinion, is not only a new union of things not found together in one apparatus before, but it is a union, an introduction of this in such a way as to obtain the required result, and therefore to constitute in the meaning of the words a combination, that is to say, a new machine, and a putting together of parts so as to constitute the subject of a valid patent, and therefore, in my opinion, this is a good patent which the plaintiff has taken out. I agree with the reasons given by BRETT, L.J., for saying that *Darker's* prism was not an anticipation of the invention which the plaintiff has claimed, and I do not go again through the reasons he has given for that. Then, with regard to ships' deck lights, I hardly think it necessary to advert to it, but I may say there the prism was entirely different. No doubt in those cases it was a prism with an acute point cut off more or less, but it was not a prism in any way arranged or intended to throw the light into any given direction, though possibly it was to a great extent introduced for strength, and probably it had some effect in diffusing the light, but it was introduced in an entirely different way and for an entirely different purpose, and in my opinion did not anticipate the invention of the plaintiff. Then, as regards the infringement, really one has nothing to say about it, because it is, in my opinion, clear that

this is an infringement. I do not say that it may not be some improvement on the original invention, but if the invention has been taken by the defendant he cannot use it so long as the plaintiff's patent lasts without infringing the plaintiff's patent, even although he may have done something which improves the original invention. I say that because I do not think we are in a position to decide whether the shaving off a portion of the one surface of the prism, that is to say, the transmitting surface, may not have an effect, and be an improvement upon that which the plaintiff originally patented. It is not necessary for us to decide that, but in my opinion the defendant has fixed into a pavement light, in other respects like that of the plaintiff, a prism, possibly with the transmitting side not always so perpendicular as in the plaintiff's, but with the two sides so arranged that the one side inclined at a greater angle, shall reflect the light in the interior of the prism on to the transmitting surface.

Application for stay pending an appeal was refused, COTTON, L.J., saying:—As a rule, the plaintiff is entitled to all his ruling immediately, unless the defendants could show good grounds for a stay of execution.

HAYWARD v. THE PAVEMENT LIGHT CO.

[1884. 1 O. R. 207.]

Interlocutory Injunction—Old Patent—Infringement.

Action for infringing the same patent. The plaintiffs, before delivery of a statement of defence, moved for an interlocutory injunction. The defendant company had not adopted the plaintiff's inclined side, but in lieu thereof made a curved side to reflect the light. Injunction granted with costs.

KAY, J.—The invention has been patented so long ago as 1871, and the validity of the patent has been established by the Court of Appeal.

It is clear the patentee does not confine himself to an exact prism "on the under," which I suppose means the under side * * * He does not confine himself to any particular angle, or to keeping one angle on the side which is to deflect the light; so that if he had chosen to make a dozen angles, or a hundred angles, that clearly would have been a construction within his patent. What the defendant has done is this: instead of making the deflecting or reflecting side a series of angles he has made it a curve; it is curved so as in fact to amount to an infinite number of small angles, so that the light which falls on any part of the curve is

deflected in a different direction to that which falls on another part of the curve. That is nothing more than multiplying the facets, if one may use the expression, which the plaintiff under his patent might have used according to the very terms of his specification. It is not merely taking the idea which one knows alone would not do, but it is taking in fact the actual construction.

HINDE v. OSBORNE.

[1884—5. 1 O. R. 221 ; 2 O. R. 45, 64.]

Infringement—New Evidence on Appeal—Improvement.

Action by assignee for infringement of a patent granted to *John Careless*, 1881, No. 2115, for “a new or improved instrument for curling, waving, and frizzing hair.” The invention related to an instrument to be used in place of common curl papers for curling the hair, and the specification stated: “In constructing the said instrument I take three light bars or strips of metal, two of the said strips being of the same length, and the third somewhat longer than the other two. The shorter bars or strips may be made of about two inches in length. The three light bars or strips are connected together at one end by a short pin or axis on which they are capable of turning. The two shorter bars or strips are in contact at the joint pin, but the longer strip is separated a short distance from the others by a washer on the joint pin or axis. The free end of the longer strip is so bent that when the three strips are brought together or parallel to one another the bent end of the longer strip engages with the ends of the other short strips. The extreme end of the bent end of the outer strip is formed into a short pin, and the ends of the shorter strips have holes into which the said pin may enter and fix the ends of the shorter strips. The instrument is used in the following manner: The three strips are opened out upon the joint pin, and the hair to be curled is introduced between the two shorter strips, which are then brought parallel and the hair coiled or wound upon them. The longer strip is next brought parallel to the other two, and the pin forming its extreme end engaged in the hole in the ends of the shorter strips. The instrument is thereby securely fixed to the hair. *Claim*: The new or improved instrument for curling, waving, and frizzing hair, herein-before described, and illustrated in the accompanying drawing, that is to say, an instrument for the purposes described, consisting essentially of three light bars or strips of metal jointed together at one end, so as to be capable of

opening out from one another or of being brought parallel to one another, and so constructed that they may be fixed together when required, substantially as described and illustrated."

The defendants pleaded want of novelty, but being unable to give particulars withdrew that plea, and went down to trial with only a plea of non-infringement.

The article sold by the defendant which was the alleged infringement consisted of a bar or strip about four inches in length which was bent into the form of a common hair pin. A second bar or strip was attached to this which acted in exactly the same way as the plaintiff's third bar, but instead of the end being turned over into a pin, it was curved into a loop like the end of a safety pin, and thus held the free ends of the first bar or strip.

The action was tried at Birmingham Assizes without a jury. Judgment for plaintiff.

HUDDLESTON, B.—The defendants say, "We only bought these pins from another man." * * * The man from whom the defendants bought says, "my invention is altogether different." He says, "in the first instance, I have not two bars, I have only one bar, which is bent at the bottom, and I have no fastening at the bottom; and the whole of my invention consists of three pieces, whereas the plaintiff's consists of five. Mine is not like the plaintiff's because there is no washer, nor is there either a screw or a pin which goes between the two other pieces." He says those are the essential differences.

To see whether there are those real differences, or whether those differences are material or not, I must see what the claim is (His Lordship read the claim). It is certainly not necessary that there should be three distinct bars, or two distinct bars. The two distinct bars or smaller bars of the plaintiff's are fastened by a pin, but the one bar of the defendants', which is doubled so as to form a joint in the doubling, is really nothing more than a mere application of the principle of the plaintiff's, which had a pin instead of a joint. As the witness said, while the space between the bars is occasioned in the plaintiff's by a pin, in the defendants', it is occasioned, after all, by the same thing namely, the flexibility of the metal itself. The joint at the bottom, whether it be by a pin or whether it be by the metal itself, is really the same thing. The object is that the bars should be capable of opening out from one another; and as to that, the plaintiff's works in this particular way, and the defendants' works in a less efficacious way, but really on the same principle. The essential object of the plaintiff's is

that they should be fastened at the bottom and fastened at the top in the way described, and it is exactly the same thing with the defendants'. The defendants fasten theirs at the bottom by the flexibility of the long bar or whatever it may be called, and at the top the method of fastening or engaging is no doubt different from the plaintiff's, but the object is exactly the same, and the mode of carrying it out, in character, is the same. That being so, I do not entertain any doubt in my own mind that the defendants' article is a piracy of the plaintiff's.

The defendants appealed to the Court of Appeal and, before the appeal was heard, moved for leave to adduce fresh evidence. 2 O. R. 45.

Leave refused (Coleridge, C.J., Lindley, L.J.).

LINDLEY, L.J.—The power given to the Court of Appeal to hear fresh evidence is an extremely valuable one, and is given by O. 1viii. r. 4. I cannot understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence simply because a man has failed at the trial and he thinks he can get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shown to satisfy the Court that there is some evidence now forthcoming, which, with due diligence, he could not have got, and it must, moreover, in accordance with the usual practice, be evidence—not merely swearing by affidavits or anything of that kind—but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and the defects which have been disclosed upon the first trial. What this gentleman says is nothing more or less than this,—“I did not bring this forward.” His affidavit does not satisfy me at all that he could not have ascertained this by due diligence. He says he could not get sufficient information to enable him to give particulars of want of novelty. That may be. But, after all, in substance, this is an attempt to destroy the patent for want of novelty. I do not say that the defendant might not succeed in bringing in some of the evidence on the plea of non-infringement. It is possible he might, but the case is not one to which we ought, under the Rule (to which I have already alluded), to give any countenance at all. 2 O. R. 47.

The appeal came on for hearing. The application for leave to adduce fresh evidence was renewed and refused. Appeal dismissed. 2 O. R. 64.

BRETT, M.R.—The only question is, whether there was an in- 2 O. R. 66.

fringement. It is suggested that this was a patent for an improvement, and that what the defendants then would be able to show was, that their curling pin was a copy of the former unimproved curling pin, and was no infringement at all of the improvement. That is very ingenious, and would be a true proposition if it could be maintained in fact that this was a patent for an improvement. Therefore, the main question is, was this a patent for an improvement? The only thing relied upon was, that at the beginning of the specification the words are, "I am about to state a new and improved instrument;" but when you come to look at the body of the specification, there is no former instrument described, there is no former instrument alluded to, there is no former use alluded to, and the whole of this thing which is described in the specification is described as if there had never been any other such thing before in the world, or anything like it. When you come to the claim, it is obvious that it is not a claim for an improvement, but that it is a claim for an absolutely new instrument. If it could be shown, upon proper pleadings, when a man had claimed an absolutely new instrument, that all that he had done was to improve an old instrument, his patent would be immediately declared bad. Therefore, that suggestion as to the facts only goes to show that this was a bad patent. That, they deliberately abstained from pleading, so that it must be taken that this patent was a patent for a new instrument, and it is not denied that it is a good patent.

Now, what would be an infringement of the patent for that instrument? To make or sell an instrument which in some independent substantial part of it was the same (that is, substantially the same) as either the whole or some independent substantial part of the plaintiff's instrument, as described in his patent. I never saw a more clear case of infringement.

Then, after having tried the case in that manner, after having had their attention called to the question of novelty, after having deliberately rejected the opportunity of trying whether this patent was novel, they now come and say, "We did not look at the records in the British Museum and in other public places before the trial; but now we have, and now we will undertake to say that this was not novel." What is the principle of law applicable to such cases? It is that you cannot have a new trial under such circumstances unless you show that you have discovered fresh evidence, which, by due diligence and care you could not have discovered before the trial. Here this is not made out, because

one of the ordinary modes of objecting to the novelty of a patent, that is, of seeking for evidence to show that it is novel, is to go to those very places which the defendants' advisers now say they have been to. If they had taken due diligence and care (I am not going to say they were guilty of a want of due diligence), and if it is true they have found these things now, then they could, by taking the ordinary means, have found them before.

HOCKING v. FRASER.

[1885. 3 O. R. 3.]

Practice—Costs.

Action by assignees for infringement of a patent granted to *F. Hocking*, 12th March, 1877, No. 983, for "an improved apparatus for heating water, applicable also for use as a condenser" (in part disclaimed), and also for infringement of another patent granted to the same, 24th July, 1878, No. 2934, for "improvements in condensers for obtaining fresh water from salt water."

The defendants raised the usual issues; at the trial the Vice-Chancellor held that the patent of 1877 was valid, and that the defendants had infringed it, and ordered an injunction and an account. No evidence was offered as to the patent of 1878.

BACON, V.-C.—The costs of the action must be paid by the defendants, except so far as such costs have been increased and occasioned by the claim (as to patent of 1878) in the 6th paragraph of the statement of claim. So far as the costs of the action have been increased by that claim, the defendants are entitled to be paid by the plaintiffs, for they have not pursued their claim.

Further as to the 3rd paragraph of the claim in the statement of claim, the Vice-Chancellor said:—The 3rd paragraph relates to the payment of money, and then to the destruction of all such condensers as are now in the possession or control of the defendants. I reserve the further consideration of those two points, the payment and the destruction.

Injunction suspended, if the defendants gave notice of appeal within 14 days; the defendants undertaking to keep an account.

HOCKING v. HOCKING.

[1886. 3 O. R. 291.]

Defence—Embarrassing—Assignor.

Action against the assignor for infringement of the same patent of 1877.

The statement of defence alleged (*inter alia*), para. 2, that if the specification were construed so as to make the defendant an infringer, the claims of invention would be bad for want of novelty as including matters described in certain specifications, stating them. North, J., in Chambers, refused to strike out para. 2, under O. xix., r. 27. Appeal to the Court of Appeal (Cotton, Lindley, Lopes, L.JJ.) dismissed with costs.

COTTON, L.J.—It is said here that what is pleaded is no defence at all, and that, therefore, it ought to be struck out; but that does not make it embarrassing. In my opinion that is not the case, but it is this: "According to the true construction of my patent which I assigned to you, it does not include what I am now doing," and he says, "I intend, in aid of that argument, to refer to certain patents." Now, in my opinion, it is quite true that you cannot construe one instrument by another. In certain circumstances it may be admissible to refer to an existing specification in order to show what was the state of public knowledge, and what was the public use then going on of certain things, in order, knowing that, properly to construe the words which are in use in the specification in question. I give no opinion whatever whether on the trial of this action these specifications will in any way assist, but I cannot say that they will not. I do not think it was necessary to plead this, because on the contention that, on the true construction, the specification did not include what is being done by the plaintiff, under certain circumstances these documents might be referred to as showing what was the existing knowledge, and so enable the Court at the trial to construe the specification properly. If the words of the specification are clear, of course these specifications cannot help in any way, nor could the public knowledge at the time help in any way; but if they are doubtful, then I think it may be legitimate and useful, in ascertaining the true construction of the terms of the specification, to look to all matters which would help the Judge to determine what was the state of public knowledge at the time when this patent was granted.

LINDLEY, L.J.—I think the worst that can be said of this paragraph is that it is not necessary. It does not seem to me to be calculated to embarrass anybody at all. I think it is unnecessary, and if all the defendant had done had been to say he had not infringed, that would of course have raised the question what the true construction of the specification was, and whether he had infringed it, if properly construed * * * I think NORTH, J., might have struck this out in the exercise of his discretion, but I do not

think he was bound to do it, and I do not think we ought to interfere.

HOUSEHOLD v. FAIRBURN.

[1884—5. 1 O. R. 109; 51 L. T. 498; 2 O. R. 140.]

Threats—Injunction—S. 32—Due Diligence.

On the 26th *March*, 1884, the plaintiffs commenced an action against the defendants to restrain the issue of circulars alleging that the Rainbow Steam Water and Liquor raiser was an infringement of patents belonging to the defendants, and for damages.

On the 7th *April* they gave notice of motion for an interlocutory injunction. On the 26th *April* an action of *Fairburn v. Household* was commenced by the defendants against the plaintiffs for infringement. On the 8th *May* the motion came on, when KAY, J., acting on the authority of former cases, refused the injunction. The learned Judge's attention does not seem to have been called to s. 32 (*supra*, p. 14). The Judge, however, put the defendants on terms to prosecute their action with due diligence, and meantime this action was not to proceed.

1 O. R.
109.
51 L. T.
498.

In *Fairburn v. Household* the claim was delivered in *June*, and an order for further and better particulars of breaches was not complied with till *November*. The defence was delivered in *December*, 1884, but notice of trial was given for the Summer Assizes at *Manchester*, whereas the next assizes there were the Spring Assizes.

On the 30th of *April*, 1885, the plaintiffs in this action moved for an injunction.

2 O. R.
140.

KAY, J.—The injunction was not granted on the former occasion because the Court was informed that there was a trial pending as to the validity of the patent. That was a very good reason why the Court should not grant the injunction, the defendant undertaking that he would prosecute that action with due diligence. Instead of prosecuting it with due diligence he chose to go away to America, and whilst there a large space of time elapsed during which nothing whatever is done in the action, and in the meantime he is getting all the advantage which the Court intended him to have if he prosecuted the action with due diligence. The Court certainly never intended that he should prosecute it as leisurely as he could, so as to create further delay, and all the time go on advertising and continue the issue of these circulars and advertise-

ments, which are, no doubt, doing a great deal of damage to the plaintiffs. I grant the injunction.

The plaintiffs were relieved from their undertaking not to proceed with this action.

JACKSON v. NEEDLE.

[1884. 1 O. R. 174; 2 O. R. 191.]

Practice—Injunction—Subject-matter.

Action for infringement of a patent granted the 21st *July*, 1883, No. 3594, to *R. B. Jackson*, for “an improved box for parcels post and like purposes.”

The invention consisted in putting one box within the other, and placing packing between the two.

Writ issued 3rd *March*, 1884.

The plaintiff moved for an interlocutory injunction. The defendant raised questions as to the validity of the patent.

BACON, V.-C., granted the injunction.

On appeal, the Court of Appeal (Baggallay, Cotton, Lindley, L.JJ.) on *June* 11th, 1884, discharged the order, the defendant undertaking to keep an account. Costs to be costs in the action.

BAGGALLAY, L.J.—In the course of the argument I called attention to the judgment of TURNER, V.-C., in a case more than thirty years old, of *Caldwell v. Vanvliessen* (vol. i., p. 101), where he drew attention to the distinction between applications for injunctions to restrain infringements, when the patent had been well established, and when it was a new patent. At that time, no doubt, the Court was not in the habit of granting these injunctions until the title had been established by an action at law. That rule no longer applies; but at the same time the Court has not shown the same disposition to grant injunctions where the patent which is said to be infringed has been of a recent date. It is clear that in this case what we do must be guided by the law as it was before it was altered by the Statute of last session. The sale of the article by the plaintiff probably commenced some time in the month of *January*. Probably he had been, before that time, preparing for what he might sell after the patent came into operation; but it appears that he has manufactured a considerable quantity of articles, and made large profits from the manufacture which he has so carried on, and from the sale of the manufactured article, which he puts at a very high figure. At the same time the patent is of very recent origin, and I think that it would be going con-

trary to the practice of the Court, recognised down to the present time, at any rate so far as regards cases arising under the old Act, to grant an injunction. The Court abstains from interfering by injunction in the case of a recently dated patent where there is really a substantial question to be tried. No doubt in this case the plaintiff has got the *prima facie* case that he has had a patent granted to him. He has got that right. On the other hand, it is alleged on the part of the defendant that that which is called an invention was not an invention, that it was not novel; and our attention has been drawn to various patents under which articles have been manufactured, or might have been manufactured, or may still be manufactured, more or less resembling that in respect of which the plaintiff claims to have a patent. I abstain, as I thought it right to abstain yesterday, from expressing any opinion upon the probabilities of success of the one party or the other, because, admittedly the whole of the evidence has not been gone into; but there has been sufficient gone into to satisfy my mind that there is a substantial question to be tried at the hearing of the action whether it is a valid patent or not. In this respect I think it differs very materially from the case before the Court yesterday (unreported). There the question was not as regards the title of the plaintiff, but as regards the question of infringement by the defendant. The plaintiff there had a clear right. Here the dispute is as to the plaintiff's right, and it is hardly in dispute that there is infringement if the plaintiff has that right.

CORROON, L.J.—It is to be quite understood that we give no opinion as to what would be the proper course in any case arising under the present Act. The question will be thereunder whether the investigation and protection which is given to the public under ss. 10 and 11 may alter the rule which hitherto has existed, where a patentee of a patent of a recent date comes for an interim injunction. The rule seems to have been laid down and acted upon since the Judicature Act, that when there is a recent patent, and an application for an interim injunction which is to protect the enjoyment by the plaintiff of that of which he is in possession until the hearing or the rights are decided, the Court will not interfere by interim injunction where there is a serious question to be tried as to the validity of the plaintiff's title. Certainly, I express no opinion at all against the validity of the plaintiff's patent, but there is a serious question to be argued and to be decided at the hearing; and on that ground I think, as it cannot be said that there is not a question as to the right of the plaintiff to the enjoyment

and possession of the exclusive right to manufacture this article, that it is not a case in which an injunction should be granted.

LINDLEY, L.J.—I am of the same opinion. I should have hesitated very much to differ from the Vice-Chancellor in a matter of this kind if I had not thought that he attached too little weight to the question as to whether the plaintiff's title was good or bad. He seems to have thought that that was immaterial at this stage of the proceedings. I cannot say I think that it is immaterial. I think he attached too little weight to that. I do not say whether the plaintiff's title is good or bad. It is impossible not to be struck with the evidence.

2 O. R.
194.

The action was tried by NORTH, J., who held the patent bad for want of novelty, and dismissed the action, saying :—The plaintiff's first witness seemed to have an idea that because the parcels post was new, therefore a thing to be sent through the parcels post was new : there is no foundation for that.

JACKSON v. WOLSTENHULMES.

[1884. 1 O. R. 105.]

Infringement—Claim.

Action for infringing a patent granted the 11th May, 1870, No. 1338, to *P. R. Jackson*, for "improvements in the construction of segmental toothed wheels." The invention related to a new mode of forming large toothed wheels which had been previously cast in segments and afterwards joined to form a complete wheel. The specification stated :—This mode of construction is objectionable, as it is impossible to get all the segments of the same quality of metal, or, when casting, of the same temperature, consequently the contraction of the metal in cooling is irregular, and the segments are not of uniform hardness. Now, my invention consists in obviating or reducing these defects by dividing an entire rim of the required diameter, and afterwards cutting or otherwise casting the said rim, by a slotting tool or other means, into the desired number of segments. Keys or plates may be inserted at the jointing of the segments to preserve the correct pitch of the teeth. This improved mode of construction also facilitates the fitting of the segments on to the wheel or set of arms, or a portion of the wheel, for which they are intended, as the rim may be bored out or turned before it is cut into segments. My invention is applicable to all classes of toothed gearing. The specification then went into details, and showed how the segments were fitted on to the

wheels. *Claim*: In the construction of segmental toothed wheels, of whatever class they may be, casting an entire toothed rim of the required diameter, and afterwards cutting or dividing the same into the required number of segments, which are then secured to the rim of the wheel or other article in the manner and for the purposes described. The action was tried in the Palatine Chancery Court. The defendants (*inter alia*) denied infringement, though they had adopted the mode of fitting described in the specification. Judgment for the defendants. The plaintiff appealed to the Court of Appeal (Cotton, Bowen, Fry, L.J.J.), who dismissed the appeal.

COTTON, L.J.—What the plaintiff alleges that he has claimed is the fitting; that is to say, fitting the two surfaces, the inside of the exterior rim and the outside or outer rim of the wheel, in such a way as to make mechanical or perfect contact between the two parts. It is not necessary to give any opinion on the question whether, if that were claimed, it would be a good subject of claim. The only point we have to consider now is, whether it is claimed; and, in my opinion, it is not.

BOWEN, L.J.—The fitting and turning is not really treated as part of the invention, nor is it claimed. It is mentioned in the previous part of the specification, but when we come to the claim at the end, the claim omits it. It must be remembered that claims are for the security of patentees, to prevent it being said that the patentee has claimed more than can be really supported as his invention. Here the patentee has abstained from claiming the fitting or turning.

FRY, L.J., read the passage from the specification above cited, and said:—That is the mischief with which the patentee was dealing; and, although it is not impossible that he might afterwards enlarge the ambit of his invention, it is not immaterial to observe that in reciting the evil he does not refer to the difficulty of joining the two rims together. Then I entirely agree with what has been said that the reference to the fitting of the segments is mainly for two purposes. It is referred to for the purpose of showing the utility of the invention, because it is said to facilitate the fitting, although it is not part of the invention, and it is also referred to as a mark of time, and in the description we find that it is only referred to as a mark of time. It says *after* it has been turned and fitted something is to be done, and *when* the circumference has been turned and fitted something is to be done. It is not referred to as a substantive act or thing now patented; but it

is referred to as a common and well-known step which must be taken, and the taking of which marks a particular time. Then with regard to the construction of the claim, it is to my mind apparent that there is no word which fits the turning or fitting at all. What he claims is the casting, and the cutting, or the dividing. Now the fitting in the manner indicated is neither casting, cutting, nor dividing. It is said the words "in the manner and for the purposes described" cover it; but they only qualify the words which I have already read,—the casting, cutting, or dividing.

I put the question to myself in another way. Supposing it were old, and supposing it were claimed, how could you disclaim it? What words could you pick out in this claim which you would disclaim to make the patent good, supposing the turning and fitting were claimed? That is a question which I have asked myself, and have been entirely unable to answer.

JENSEN v. SMITH.

[1885. 2 O. R. 249.]

Subject-matter—Novelty.

Action for infringement of a patent granted the 1st Feb. 1878, No. 427, to *Peter Jensen* for "improvements in oil boxes or lubricators for revolving and other parts of machinery." The invention had special reference to chambers for solid or semi-solid lubricants, and such chambers were shown in the drawings as having a small pipe or opening through the bearing leading to the revolving part. To force the lubricant through this pipe on to the substance to be lubricated, the patentee showed in fig. 10 a screw fitted so as to close the mouth of the chamber and to engage in a screw thread cut in the inner side of the chamber: when the screw was turned the lubricant was forced down. Fig. 14 showed an arrangement by which a cap of some depth was used, a screw thread on the interior of the cap fitting to a screw thread on the exterior of the chamber. As the cap was screwed down the lubricant was forced through the pipe.

Claims: 1. The construction and modes of application of lubricators, substantially as described with reference to figs. 1 to 12. 3. The construction of lubricators, substantially as described with reference to figs. 14 and 15.

The defendants denied the novelty and that the invention was subject-matter. They put in evidence and made an exhibit, No. 3,

a *Delettrez* lubricator, having a top through which a screw passed, and having a piston inside actuated by the screw. They also relied on prior publication by *Redmund's* specification, 1842, No. 9454, in which a screw was used in the top of a large door hinge to cover the opening for the lubricant.

KAY, J. (after reading the specification) said:—I observe first that there is not a word there about the state of knowledge which the manufacturers and the trade had at the time, nor the slightest attempt to differentiate and to show in what respect this mode of construction of lubricators was an improvement upon lubricators which had been used up to that time.

The first question is, supposing that (No. 3) to have been an invention known in England, as I infer from this evidence, is there sufficient invention in the difference between the plaintiff's and this to be the subject of a proper patent. I take the two forms that most resemble it in the plaintiff's patent, figs. 10 and 11. It is quite obvious that if you took either of those two and made the lower part of the cup in which the screw works a little wider than the thread of the screw, and then put anything below the screw like gun wadding to act as a piston, that would be identical with this No. 3; and the fair way to try whether there is sufficient invention in the matter is this: Supposing the plaintiff to have been the first undeniably, and that some one had then bored out the screw thread half way up and put in a piston to be actuated in that wider part of the chamber by the screw thread and the screw that remained, would the plaintiff have submitted to that, or would he not have said that it was an infringement of his patent? To my mind the answer is inevitable that that would have been a clear infringement of the plaintiff's patent, and if a patent had been attempted for a variation like that from the plaintiff's, I say the answer would have been at once there is not sufficient invention in a variation of that kind to entitle the party to a patent. I have got precisely the converse of that here. I have got a piston actuated by a screw for the purpose of forcing down the grease into the joint which requires to be lubricated, and the plaintiff drops out the piston and makes his screw fill the whole of the cavity, and that is the only difference between these two forms, which is in the least material, the figs. 10 and 11 of the plaintiff's patent and this of *Delettrez*. Now is that difference a sufficiently meritorious invention to be the subject of a valid patent? My answer to that is that, in my opinion, it is not, and the patent therefore would be bad on that ground.

As to *Redmund's* specification the Judge said:—No doubt it is a true observation that that screw is intended rather as a stopper than as the means of forcing the grease downwards, but as the witnesses said, of course if the grease was put in so that it reached into the screw cavity, the screw might be used for forcing the grease down. There again there seems to be something which is very like an anticipation of the plaintiff's patent, because supposing anybody had made a hinge of that kind, and had used the screw as it might be used as the witnesses say, not merely for the purpose of a stopper, but had used it distinctly for the purpose of forcing the grease down, it would be very difficult for anybody afterwards to take out a patent for such a thing as is described in figs. 10 and 11.

JOHNSON v. RYLANDS.

[1873. Not Reported.*]

Subject-matter—Novelty—Infringement.

Case for infringement of a patent granted to *Richard Johnson* the 6th Nov. 1863, No. 2763, for "improvements in testing the strength of wire for telegraphic and other purposes." The invention described consisted of two drums, *g* and *i*, driven at varying speeds: the wire from a reel was carried first to drum *i* and coiled several times on it: it was then carried to drum *g*: by suitable gearing the drum *g* was driven at a higher surface speed than drum *i*: thus every length of the wire was tested as to its strength.

Claim: For the purpose above set forth passing wire over surfaces, one of which is caused to draw it forward at an accelerated rate.

The alleged infringement consisted in the use by the defendant of two drums, and the passing of wire over them so as to take the kinks out of it, the second drum being retarded by a clip so as not to go as fast as the first; the wire pulled round the second drum being gathered up on the first.

Judgment for plaintiff.

Rule to enter a nonsuit made absolute by the Court of Exchequer (Martin, Cleasby, BB.; *diss.* Pollock, C.B.).

Appeal to Exchequer Chamber (Blackburn, Keating, Mellor, Lush, Honyman, JJ.). Judgment affirmed.

* For the notes of this case I am indebted to T. Aston, Esq., Q.C.

BLACKBURN, J.—First take the strain on the wire. It has been known ever since I presume wire has been known, that if you strain a wire by putting a certain force upon it, if there be a weak point in the wire not strong enough to stand that test, that will give way, and consequently the putting a strain upon a wire is a test of the uniform strength of the wire, or rather a test of the weakest point of the wire, which if it stands that strain, then it must be as strong as that. That has been perfectly well known ever since wire has been known. Then it is also perfectly well known that when soft wire is strained it does expand and extend in length more or less when the strain is put upon it, and is liable so to do. Now that being the case, there was a desire that there should be ascertained a mode of testing the strength of wire convenient for telegraphic purposes. But before ever the plaintiff had done it, this that he now does had been done by the defendant. He had caused the wire to revolve round two drums and so to be strained between the drums for the purpose of taking the kinks out, so that he had caused a strain between the two drums to be put upon the wire passing over the first and going to the second, which gathered up the wire and which caused the strain between the two. That he did, not for the purpose of testing the strength—that was not his object. It appears to me that if the plaintiff had made a claim of this sort, knowing that the defendant had strained wire, and it had been done and used openly and knowingly, and said, “I claim two drums for straining the wire and taking the kinks out, using the same mode of straining and the same mode for the purpose of ascertaining and testing the strength of the weakest part of the wire”—had he said that, that would not have been the subject of a patent at all. That would have been applying it to effect an old purpose in a way it had not been done before, and it is not because it happened that nobody had used it before in that way that that therefore would have made it the subject of a patent. And further than that, it being known that wire on being strained does expand somewhat in length, and the first drum that brings the wire forward being held back so as to strain the wire, the wire would necessarily be elongated more or less before it reached the other drum, and that drum must, for the purpose of gathering up the wire, move quicker than the drum behind—that again (although it was not stated) was a thing which everybody who had known the fact that wire expanded under a strain must have known would have been so.

His Lordship then read passages from the specification, concluding with the claim, and said :—I think that the effect of that would be that every individual bit of wire drawn forward by the drum which went at an accelerated rate would necessarily be either broken or be expanded to the proper percentage, according to the relative speed of the two surfaces. It is found most convenient to fix it at two per cent., and I may take it that whatever the percentage was it would be the same thing, but it may be convenient to call it two per cent. The consequence is, if the wire was uniform and the same all through, it stands to reason that the strain which would be required to make it expand two per cent. would be uniform also. But the objection is that it may be varied, that it may not be uniform. It may be, and it is expected in practice that there will be in every coil of wire here and there portions which, being imperfectly annealed, would be brittle and hard, here and there some portions might be thinner than the rest, and in portions it may be irregular. If it is brittle and hard when the strain is put on, and you come to the brittle and hard portion, it will not bear the strain, it will not expand, and it will inevitably break. On the other hand, if it is tough enough to bear the expanding to the extent of two per cent., it may pass there although it may not be so tough as the rest. It may not be tough enough to bear more than two per cent., but it may be tough enough to bear the two per cent., and, consequently, by the plaintiff's machine, when a wire has gone over it, it is known that every individual inch of it is capable of bearing that percentage of expansion, and that a strain of the amount has been put upon the different parts of the wire. It is drawn forward in that way, and viewing it in that light, I think the plaintiff's patent was for a valuable invention and is good.

His Lordship then referred to the action of the defendant's machine, saying :—Whether the wire be thick or thin, it is a uniform strain, and the wire in the defendant's machine, consequently, going over from one drum to the other will be strained by a uniform strain, which would not necessarily cause any portion of the wire which is tough or brittle to expand or break, but will cause a uniform strain to be put on the wire which is passed between the one drum and the other, and in that way the effect is not different from the effect produced by the plaintiff's machine. It is not so valuable, but it does produce this effect, that every portion of the wire has been subjected to a uniform strain throughout, and which, though not so valuable as the way in which the

plaintiff's machine does, yet that mode of doing it may be valuable. But then comes the point relied upon, that inasmuch as in the plaintiff's machine when the front wheel, the drawing wheel, is travelling quicker than the second one, you may (and it is perfectly true that you may) work that and say the second wheel is going slower than the first; then inasmuch as that front wheel which gathers up the defendant's wire (which must necessarily be subjected to strain and to expansion) must gather up a greater length of wire than that which travels over the other drum behind, your front wheel must travel quicker than your second, which is true, and it is said that any means by which you retard the other wheel which receives the wire first is a "mechanical equivalent" for the machinery in the plaintiff's machine by which it was secured that the first should travel quicker than the second. That phrase, "mechanical equivalent," according to my experience in patent cases, is always used when a man intends to disguise something else which he cannot clearly express in any other way. But I do not think in this case that this can be said in any sense to be a mechanical equivalent. In the plaintiff's machine the two wheels move at a fixed rate by means of breaks which are fixed to the gearing, and the consequence of that is, that the wire is subjected to a strain which stands at a certain percentage. What the defendant's machine does is this, he causes wire on the first wheel to pull round the second wheel, and the consequence is that the wire is exposed to a strain which will necessarily cause it to expand. The first wheel having to pick it up, must necessarily go quicker than the second. In the one case, therefore, the relative motion of the different wheels is the cause of the wire expanding. In the plaintiff's case, the motion of the wheels at a different speed is the cause of the wire expanding, instead of being the effect. In what the defendant does, the expanding of the wire, instead of being the effect of the wheels moving at different speeds, is the cause of the wheels moving at different speeds. The cause and effect are reversed.

KURTZ v. SPENCE.

[1886. 33 Ch. D. 579; 55 L. J. Ch. 919; 55 L. T. 317; 35 W. R. 26;
3 O. R. 368.]

S. 32—Threats—Validity of Defendant's Patent.

Action to restrain threats brought under s. 32 (*supra*, p. 14).

By the statement of claim the plaintiffs alleged that the de-

fendant's patent, which they were accused of infringing, was invalid.

A summons was taken out to strike out this allegation.

Order made.

33 Ch. D.
581.

CHITTY, J.—The law at the time when the section was passed was plain. An action for an injunction against threats being made by a person claiming to be a patentee or to have the benefit of the patent could be brought, but in such an action the validity of the patent was not in issue. The two issues were: first, the good faith of the person making the threat; and, secondly, whether the person against whom the threat was made was, in fact, infringing the patent.

33 Ch. D.
582.

It appears to me that the true reading of s. 32 is to confine the issue to the infringement, and not to allow the validity of the patent to be tried. The term, no doubt, is "legal rights," and upon that, it is argued, with some force, that it must mean a right which can be enforced in a court of justice, and that it is absurd to argue that it is a legal right which is founded upon an invalid title. But, I think, having regard, as I am entitled to have regard, to the state of the law when this section was passed, that the Legislature did not intend to permit that in such an action as this the validity of the patent should be directly brought in question; but intended only to allow the question of infringement to be tried.

33 Ch. D.
583.

His Lordship referred to s. 26 and said, s. 32 makes no provision for delivery of particulars of objections, and it is plain that under that section the plaintiff—the person who is seeking to obtain the injunction against the threats issued by a person claiming the benefit of the patent—must begin. So that the patentee would have to defend the validity of his patent in a manner which the Legislature did not think the proper one, when the patent is going to be impeached under the proceedings adopted in lieu of *scire facias*; and, as far as the section goes, there would be no necessity for the delivery of particulars of objections. It was said that there was inherent jurisdiction in the Court to order, in such a case, delivery of particulars of objections. I will not say there is not some foundation for that argument. It appears to me that if it had been the intention of the Legislature under the short term "legal rights" in the section to allow the validity of the patent to be tried, they would have inserted some provision, corresponding with the provisions of s. 29, in s. 32, or made s. 29 apply with full force to s. 32. S. 32 contains at the end a proviso that the section is

33 Ch. D.
584.

not to apply if the person making the threats with due diligence commences and prosecutes an action for the infringement of his patent. There is a slight change of language there from the words "legal rights" to the word "patent." I am unable from that to draw any inference as to the meaning of the words adverse to the defendant's contention. I mention it for this reason, that this, which I may call special remedy, given by s. 32, is not to take effect if the patentee (I use that term for shortness) will himself commence an action for infringement. It is known practically that the patentee in some cases finds a pauper using his invention, and the expense of an action of this kind is almost proverbial; and, therefore, there are fair cases in which the patentee will utter the threat, but will think twice before he undertakes proceedings, and will hesitate to do it because of the expense to which he will be put, and the small chance, or no chance, he has of being paid. At the same time this proviso says in substance that he is not to be sued for the threats if he will institute this action, and he may, at the risk of not getting his costs paid, institute the action for infringement.

LAWRENCE v. PERRY.

[1883—5. 2 O. R. 180.]

Anticipation by Provisional—"Substantially as Described"—Utility—Subject-matter—S. 19.

Action by assignee for infringement of a patent granted 9th April, 1879, No. 1419, to J. H. Johnson, for "improvements in lead and crayon holders" (a communication, &c.).

The specification stated that the invention was "characterized by the combination with a lead-receiving tube provided at its front end with spring jaws of an enclosing sleeve or sheath, the one part being longitudinally movable with respect to the other, without rotation, for the purpose of clamping and releasing the lead or crayon inserted in such tube and between the said jaws."

The enclosing sheath was tubular and had a contracted front end to admit the passage of the jaws or lead, or both. The interior tube was split longitudinally so as to form in front spring jaws, and the jaws had an incline or inclines on them which were acted on by the narrow front end of the sheath, so that as the jaws approached the throat of the sheath they were compressed and clamped the lead. The specification shewed in 10 figures four different forms of the holder.

In the 1st form of holder, figs. 1—3, the lead-receiving tube

was made to move forward by the use of an eccentric actuated by an external handle; it had the inclines at the end of the clamping jaws, within the throat of the sheath. The 2nd form, fig. 4, corresponded with the 1st, except that the clamping jaws protruded beyond the throat of the sheath, which acted upon the reverse inclines, and thus pressure on the pencil tended to tighten the hold of the jaws. The 3rd form, figs. 5—8, resembled the 2nd in the relative positions of the jaws and the sheath. Instead of the eccentric it had a cap placed at the rear of the lead-receiving tube, which cap projected beyond the end of the sheath, and was held back by a spring so arranged that when there was no pressure on the cap the force of the spring drew the reverse incline of the jaws back against the throat of the sheath so that the jaws held the lead firmly. When the cap was pressed inwards with the finger, the spring was compressed; the lead-receiving tube was moved forward with its clamping jaws; the pressure of the throat on the jaws was removed, and the lead was free. A small cross pin in a slot in the inner tube limited the extent of its movement. In the 4th form the lead-receiving tube was made thicker and pressed the body of the holder, and a short sheath was placed near its lower end with a spring confined in such a way as to push the throat of the sheath forward upon the reverse incline of the jaws.

Claim 1: In a lead or crayon holder the combination with an enclosing case or sheath of a longitudinally movable lead-containing tube or receiver, terminating at its front end in clamping jaws acted on by the said sheath, to clamp or release the lead, substantially as hereinbefore described. 2. In a lead or crayon holder the combination substantially as herein set forth of a lead-receiver terminating at its front end in clamping jaws, an enclosing case or sheath, and an eccentric or its equivalent operated from the exterior of the holder to produce longitudinal movement of the one part with respect to the other. 3. In a lead or crayon holder the combination of the clamping case or sleeve, the expanding jaws acted on by the said case, the lead-containing tube carrying the said jaws and longitudinally movable with respect to the said case or sleeve, and the spring, substantially as hereinbefore described. 4. The combination of the case, the expanding jaws, the longitudinally movable lead-receiver carrying the said jaws and provided with a head or cap projecting beyond the rear of the case, and the retracting spring, substantially as hereinbefore described.

The defence raised the usual issues.

Judgment for defendants.

NORTH, J., referring to an alleged anticipation by a holder patented by *Harding*, 1834, No. 6565, said: That has a cylindrical metal tube split towards the end so that the parts spring asunder and made hollow to receive a pencil or crayon, and having an incline outwards with a ring sliding backwards and forwards, so that when the ring is slid backward upon the tube within it the outer ends of the tube or spring jaws open; but when the ring is slid forwards along the incline towards the point of the instrument it forces the split sides of the inner tube closer together so as to close on and hold firmly the pencil. The ring is itself a short tube * * * so that this is an instance in which we have a short enclosing outer tube or case, an inner tube containing the pencil or crayon, and moving longitudinally within the outer case or ring, with the split part of the holder at the end resilient in itself but acted on by the ring to clamp or release the lead. * * * The plaintiff's counsel contended in reply that the words in the 1st claim, "substantially as hereinbefore described," imported into that claim the whole description contained in the body of the patent, and that *Hurding's* tube and ring were not of the character there described, and did not act as described, because in *Harding's* the motion is communicated to the ring merely by the fingers; and there is no mechanical movable appliance which connects the two parts or makes one act on the other. If the true construction of the claim be that the thing referred to in the words "substantially as hereinbefore described" is the action of the sheath on the clamping jaws to clamp or release the lead, then the mode by which that action is brought about is not within the words of reference, and is not claimed. If the claim is to be read by referring the words "substantially as hereinbefore described" to the word "combination" the thing claimed is still merely the combination of the same two integers, and the word "combination" may well refer to the use of the two integers together, without necessarily including the means by which the two are connected. There might well be an infringement of a patent for a combination of A and B, although the infringer adopted a different mode of combination to that of the patentee. If I were to hold that the claim to the combination "substantially as hereinbefore described" of the outer sheath and inner tube had the effect of importing into the first claim the particular means described for effecting that combination (namely, the eccentric or the spring, either with or without the head or cap), I should be confining the first claim to the things specifically dealt with by the other three claiming

clauses, and giving no independent effect or operation to it; and I should be treating one or other of the described modes of effecting the combination as an essential part of the invention in every form, although it is not in terms referred to as a thing which the patentee considers novel and original, and is not alluded to in the opening lines of the specification, where the patentee states by what his invention is characterised. In my opinion the first claiming clause was intentionally framed as it is, in order that it might be more extensive than the others, and with the intention of protecting the combination of the outer sheath and inner tube, whether effected by the means which were referred to in the subsequent claims, or by any other means; and it has unfortunately been expressed in general terms, which include more than the patentee had invented, and cover something which was not then novel or original. If *Harding's* patent had been of later date than the plaintiff's the manufacture of his crayon holder would certainly have been an infringement within the first claiming clause, though it would not have come within any of the other three.

His Lordship then referred to the alleged anticipation by *Faber's* patent, No. 531, and said: This is obviously very like the plaintiff's and all the witnesses on both sides say that it is an anticipation of the first claim of the plaintiff's, unless the fact that in *Faber's* the outer cap rotates round the other makes a difference. Referring again to the plaintiff's claiming clause, not a word is said there about rotation or non-rotation; but I think that the longitudinal movement of one tube within the other, referred to in each of those clauses, is sufficiently indicated to be without rotation by the words of reference therein contained, as the fact that such movement is without rotation is referred to as characteristic in the first lines of the specification.

His Lordship quoted one of the plaintiff's experts as saying, as to the pin and slot used by the plaintiff and preventing rotation, "this was not material, as rotation would do neither harm nor good," and added: I have felt some difficulty in seeing how the plaintiff's invention can be useful if it only differs from an earlier one by an ingredient which does neither harm nor good.

His Lordship dealt next with an anticipation by *Wiley's* provisional specification, 1866, No. 1839, and alluded to evidence given thereon by one of the plaintiff's experts saying: He then said he did not think a workman could work from that specification; and when asked why he said so—I think by me—he gave the extraordinary reason that a sketch was always wanted for

mechanical things. That in mechanical patents drawings are generally very useful, and are sometimes essential for perspicuity I do not doubt; but the proposition that there can be no publication of an invention in a specification or book unless illustrated by drawings is one to which I cannot assent for a moment.

It was alleged by the plaintiff's counsel that no case has occurred yet in which the description contained in a provisional specification has been held sufficiently precise to destroy a later patent for a like subject. Be this as it may, there is nothing in that remark relevant to the present case. In this case I am clearly of opinion that *Wiley's* provisional specification does contain quite a sufficient description of the nature of the invention, and also of the manner in which it is to be performed, to bring the case within the ruling of Lord WESTBURY in *Hill v. Evans* (vol. i. p. 248). I find a clear description how to construct an instrument which is completely covered by the first claiming clause of the plaintiff's; and this is, in my opinion, quite sufficient to prevent their being subsequent, first, and true inventors within the realm of the instrument so described, even if the description in the provisional specification of other alternative forms of instrument were mere sketches only. It is, therefore, unnecessary to consider whether the view taken by Lord WESTBURY in *Hill v. Evans*, or that of GROVE, J., in *Philpott v. Hanbury* (*infra*) is the more correct.

Lastly, it was contended that if what is described in this provisional specification were a useful invention, it is inconceivable that a complete specification would not have followed in due course. This argument is not a very forcible one, for it is only founded on inference, and many circumstances might be imagined capable of preventing the delivery of a complete specification within the time limited for the purpose. But if applicable, it would not help the plaintiffs, for there is no evidence whatever that any pencil case which would come within the first claim but not within any of the others would be of the slightest use, or has ever been manufactured at all.

His Lordship referred to *Morgan's* patent for a watch key, 1876, No. 2892, and said: Mr. *Imray* stated that the action of that instrument was the same as that of the plaintiff's, so far as related to the clamping and releasing, &c., the spring cap, and that with a short lead it might be used as a pencil. But there is nothing in it like the lead receiving tube described in the plaintiff's specification. The article is a key but not a pencil, there is nothing to suggest the use of it as a pencil; and though, if the idea of

making a pencil case of it is once thrown out, a very slight and simple alteration, which would suggest itself at once, would be sufficient, still I cannot say that there was not sufficient invention in the adaptation of that arrangement to a pencil case to make it a proper subject for new letters patent.

The possibility of my taking this view was anticipated by the plaintiff's counsel, who asked me, in the event of my so doing, and also holding that there was no infringement, to bear in mind that, under s. 19 of the Patents Act, 1883, *supra*, p. 9, it is open to me to give the patentee liberty to apply to the Patent Office for leave to amend his specification by way of disclaimer, and to direct in the meantime that the trial of the action should be postponed. I asked the learned counsel whether he applied for any direction under that section, but he answered that he did not. * * * I do not see how I can postpone the trial after judgment, and it would be useless for me to give such leave unless coupled with postponement of the trial, as the plaintiff can apply to the Patent Office for leave to amend the specification by way of disclaimer without any leave from me.

LISTER v. NORTON.

[1884—6. 1 O. R. 114 ; 2 O. R. 68, 135 ; 3 O. R. 199.]

Interlocutory Injunction—New Patent—Interrogatories—Examination of Witness on Commission—Title—Subject-matter—Provisional Protection—User.

Action for infringement of a patent granted 21st Jan. 1881, No. 268, to *H. Lister*, for "improvements in the manufacture of velvets and of pile fabrics in imitation of sealskin and other similar materials."

The action was commenced on the 27th Feb. 1884, and on the 4th April the plaintiff moved for an interlocutory injunction. Motion ordered to stand to the trial, the defendants keeping an account.

1 O. R.
115.

CHITTY, J.—What the late M.R. laid down as the right practice was this: that it will not do for the defendant simply to say, "I dispute the validity of the patent." He must put something in his affidavits to show a case to be tried; and then, if it is a recent patent, the Court will not grant an injunction. As to what is exactly a recent patent, and what is a patent of sufficient age to support an injunction, that is a matter, no doubt, more or less of discretion. But the discretion is limited by the practice; and, according to my recollection of the practice, a patent three

years old would not be sufficient where it is disputed. The learned Judge further said as to motions for interlocutory injunctions in patent cases:—They stand on a different footing. There are peculiar rules with regard to patent cases; and as to the costs, said:—Where there is an independent case against a motion it is better to order the motion to stand till the trial, if the defendant asks for it; because, although, where the case on the motion is the same as the case at the trial, it is better merely to make the costs in the motion costs in the action, yet where there is an independent case against a motion, so that the defendant may say, “If you succeed at the trial, yet you must have failed on the motion by reason of this delay, and therefore you have exposed me, in any view, to unnecessary expense,” it is better then to order the motion to stand to the trial.

The defendants put in a defence denying infringement, and the plaintiff interrogated the defendants, and asked in one interrogatory whether the defendants had not sold imitation sealskins to certain firms, naming 16 firms. This interrogatory the defendants declined to answer, on the ground that the information was not *bond fide* sought for the purposes of the action, and was unnecessary at that stage of the action.

An answer to the interrogatory was ordered, unless within four days the defendants admitted infringement.

CHITTY, J.—As the record stands between the parties at the present moment, there is no admission of infringement. The secretary has answered and stated on information and belief that which would, if the affidavit could be read against the defendant company, be an admission of infringement. If the infringement is not admitted, then this interrogatory is relevant to one of the issues which will have to be tried. The interrogatory is framed in a manner which is by no means vexatious. It only deals with the names of a few of the customers, and some of them who happen to be mentioned are the customers who were mentioned in the affidavits upon the motion. On the trial the affidavits cannot be made use of in the ordinary manner of affidavits, because the evidence at the trial will be *vinâ voce*, and the affidavits can only be made use of in cross-examination. That being so, I think the interrogatory must be answered unless the admission is given.

Now, if the admission is given, there will be no issue of infringement. The main issues in the suit will be all the issues which relate to the validity of the patent; and it appears to me that I ought to act consistently with the principle which is enun-

2 O R.
69.

ciated in O. xxxi., r. 20. His Lordship read the rule, and continued :—In the course of a trial in the Chancery Division, where the matter at stake is of the nature that is at stake in this action, it is well known that the question of damages, or the question of profits, is not gone into at the trial. There is a reference made. I do not mean to say that in simple cases the amount cannot be ascertained, but in anything like such a case as the one before me, it is almost a matter of course to say that there will be a reference to ascertain the damages, if damages are to be awarded, or that there will be an account directed if the plaintiff asks for an account. Substantially, in the Queen's Bench Division, the practice now is the same, because the jury cannot be, by any reasonable counsel, expected to go through a number of intricate matters to ascertain what the amount of damage is. But, however that may be in the other Division, I am satisfied that that is the general course of procedure in this Division, and it is the course of procedure which will be adopted in this case. The admission of infringement, if given, coupled with the other admissions which are made, namely, of sales, will give to the plaintiff at once, if he should succeed in establishing the validity of his patent, a right to damages, to be ascertained in the manner I have mentioned, or the right to the account. I think, therefore, that if the admission of infringement is made, and I understand that in all probability it will be, the defendants should not be called upon at the present stage of the proceedings to answer the particular questions as to the names of customers.

The decision of the C.A. in *Parker v. Wells* (18 Ch. D. 477) related not to a patent but to another matter, but the Rules of the Court as to discovery do not draw any distinction between different subject-matters when in dispute; and the principle which the late M.R. laid down in *Parker v. Wells* is applicable quite as much to the case of a patent action as it is to the case of a trust action.

2 O. R.
136.

The plaintiff subsequently moved for a letter of request to the German Court to examine a witness. CHITTY, J., made the order, on the understanding that if the witness came to the trial his evidence on commission should only be used for the purpose of cross-examination, the plaintiff undertaking that he would use his best endeavours, including payment of witness's journey-money, to procure his attendance at the trial. The letter of request was drawn up in a special form to suit the requirements of the German procedure. On appeal, the defendants undertook to produce the witness at the trial, and to submit, if necessary, to a postpone-

ment of the trial if the witness did not attend, and to pay the plaintiff's costs of such postponement (if any); the plaintiff undertook to repay to the defendants the expenses incurred by them in producing the witness at the trial. Upon these undertakings the Court of Appeal ordered that the letter of request should not be issued unless the witness was not produced at the trial, and made the costs of the appeal costs in the action.

The action came on for trial before CHITTY, J. It appeared that the plaintiff had filed a provisional specification for "improvements in the manufacture of pile fabrics in imitation of sealskin and other similar fabrics" on the 24th *July*, 1880, No. 3054, but he filed no complete, and abandoned that application; but on the 21st *Jan.* 1881, he filed the provisional of this patent, No. 268. The nature of the inventions in both was the same. He had publicly used the invention (which was invented before the 24th *July*, 1880) between the dates of the two provisional specifications. The invention had relation to a mode of manufacture of fabrics from silk and mohair mixed in imitation of skins. Silk by itself was glossy and soft to the touch, but did not rise readily under the pressure; mohair, on the other hand, recovered itself after pressure rapidly, but was deficient in softness and glossiness. It was old to combine these materials after spinning, but the article produced had defects, and the plaintiff's alleged invention consisted in combining them "in the raw state" previous to spinning. Evidence was tendered to show, and the Judge was of opinion that, "in the raw state" did not mean, and would not be understood by a spinner to mean, mohair and silk as imported, but would indicate a combining after they had been boiled and were in the sliver. The combined yarn had been previously to the date of the patent used for glacé goods, though that was an entirely distinct class of goods. The evidence showed that the plaintiff's invention did manufacture an excellent imitation of fur. The specification, after describing the mode of manufacture, ended:—By which means a better imitation of the original skin is obtained than has hitherto been made, the materials herein named being peculiarly well adapted for the purpose. Having now described the nature and particulars of my invention, I would have it understood that I do not confine myself to the relative proportions of the materials employed, as these may be varied according to circumstances; but what I believe to be new in the manufacture of velvets and of pile fabrics in imitation of sealskins and other similar materials is: 1. The combination of mohair and silk when

used in the raw state, substantially as described ; 2. The combination of alpaca and silk when used in the raw state, substantially as described ; 3. The combination of camel hair and silk when used in the raw state, substantially as described.

The defence raised the usual issues. Judgment for defendants.

3 O. R.
203.

CHITTY, J., referring to the title, said :—The repetition of the preposition “ of ” before pile fabrics gives rise to the defendants’ argument that velvets are here spoken of without reference to the imitation of skins. If the title is read alone that might be the strict grammatical meaning. But I think that, reading the specification as a whole, and particularly having regard to the separate sentence, “ By which means a better imitation of the original skin is obtained than has hitherto been made, the materials herein named being peculiarly well adapted for the purpose,” velvets are spoken of not separately but in reference to imitation skins. Velvets are, as was shown by the evidence, a species of pile fabrics, the pile being shorter than in many other descriptions of pile goods, and velvets can be used in imitation of the skins of animals, such as a moleskin, where the hair is shorter than in the seal or chinchilla.

3 O. R.
205.

The question then arises whether the alleged invention is the proper subject-matter for the grant of a patent. The gist of the invention being the application of a well-known material to a new use, and to produce a new result, the question resolves itself into this—whether there is such an amount of invention as to entitle the inventor to a patent. If the use or application is merely analogous, it is plain that a patent cannot be granted. Where it is not merely analogous, but is sufficiently out of the beaten track the patent may be upheld. These general propositions are not precise or scientific. It is impracticable to frame propositions of a scientific character on this point. Every case must be decided on its peculiar merits and with reference to its own special circumstances. The authorities are necessarily decisions on particular cases, and are useful only as affording some guide to the decision of the case before the Court. The well-known illustration of the spoon suggests the principle which precludes the grant of a patent for the use or application of a common instrument or tool to a merely analogous purpose. His Lordship discussed the authorities and the evidence, and said :—The patentee had established indeed a short time after he had obtained his patent a large and successful trade in his patented goods, and although I admit this

part of the case is not far from difficulty, I think he has made out a sufficient degree of invention to justify the grant of a patent to him.

On the point of user under the prior provisional specification the learned Judge referred to the case of *Oxley v. Holden* (vol. i., p. 350), and said:—But on the facts of that case there was no user of the invention during the period (less than six months) which elapsed between the filing of the first and the second provisional specification, and consequently the defendants' counsel have argued that the authority of the decision does not extend to actual user during the currency of the first provisional specification, and they contend that on the facts before me there is sufficient user and publication of the invention between the 24th *July*, 1880, and the 21st *January*, 1881, to invalidate the patent. On this issue of fact, apart from the point of law, I hold that the defendants are right. There is evidence of user by the defendants also during this period. But, reverting to the point of law, I think that this user in public is covered by the grounds on which the Court of Common Pleas decided *Oxley v. Holden*. The Court held that the protection of the first provisional specification extended down to the grant of the patent, and made this one of the grounds of their decision. A provisional specification was the creature of the Act of 1852. That Act, after providing for the filing of such a specification, which is to describe the nature of the invention, and for the grant of the certificate, proceeds in the 8th section to enact that: "Thereupon the invention therein referred to may during the term of six months from the date of the application for letters patent for the said invention be used and published without prejudice to any letters patent to be granted for the same." The phrase "to be granted for the same," obviously means in this section and in the 9th section (which relates to the filing of a complete specification in the first instance) for the same invention, and cannot be construed as referring to the application or petition. The possible case of there being a second provisional specification deposited within the period of six months from the date of the first, and the grant of the letters patent under the 23rd section as of the date of the second provisional specification does not appear to have presented itself to the minds of the Legislature. But there is no express condition in the Act, avoiding the protection conferred in reference to the first provisional specification by the filing of a second provisional specification in relation to the same invention, and having regard to the decision in *Oxley*

s O. R.
206.

3 O. R.
211.

v. Holden, it is not open to me to say that there is any such implied condition. The learned Judge then dealt with the evidence as to prior user, and said:—The result of this evidence appears to be this:—The defendants do not rest upon one isolated case nor upon any near attempts, but there is a body of evidence between the year 1873 and 1879 inclusive, showing user in public of the plaintiff's alleged invention, and that the application of the mixture of silk and mohair to the manufacture of pile goods in imitation of animal skins was known to a considerable number of persons. It is true that in some of the cases there was a mixture of some wool with the mohair and silk. It was a kind of adulteration of the mohair. Silk was present with the mohair in substantial quantities. The cases where wool was mixed would have been infringements of the plaintiff's patent if they had occurred after the date, and I think they are anticipations of it. There was practical knowledge of the manufacture as claimed by the patentee in possession of a considerable number of persons, sufficient to make it public knowledge.

LONDON AND LEICESTER HOSIERY COMPANY *v.* GRISWOLD.

[1886. 3 O. R. 251.]

Injunction—Assignor.

On Oct. 8th, 1873, a patent, No. 3257, was granted to *Henry Josiah Griswold* for "improvements in knitting machinery;" and on Dec. 3rd, 1880, a patent, No. 5048, was granted to him for "improvements in the manufacture of stockings." These had become vested in the plaintiff company by an assignment, to which the defendant, the inventor, was a party: by the assignment he undertook to communicate any improvements to the company.

This action was brought against him for infringement and to enforce the covenants in the assignment.

The plaintiffs moved for an interlocutory injunction to restrain the defendant (1) from infringing; (2) from disclosing his improvements to any persons but the plaintiffs; (3) from assisting the defendants in actions brought by the plaintiffs for infringement.

NORTH, J., before whom the motion came, made no order. He held the defendant had not infringed. As to the second point he said:—I feel a difficulty in granting an injunction with regard to that, for this reason, that the only injunction I could grant would

be an injunction to restrain him from abstaining from disclosing to the company the improvements invented by him. I do not find anything in the terms of the covenant to restrain him from mentioning them to anybody else, and it might be important, to give the company the benefit of them, that he should mention them to somebody else. I cannot say that in pursuance of that covenant that they shall have the exclusive benefit of those inventions I can grant an interlocutory injunction to restrain him either from mentioning them to other persons or to restrain him from abstaining to communicate them to the plaintiffs. If I were to do that it would be compelling specific performance of this covenant on an interlocutory application.

On the third point the learned Judge said:—I am quite satisfied that I could not, under any circumstances, grant an injunction to restrain the defendant from obeying a subpoena to attend as a witness in Court and answering questions which might be properly put to him in the course of examination as a witness, the refusal to answer which might lead to his committal to prison for contempt of Court. It is said further that I ought at any rate to restrain the defendant from communicating to the defendants in other actions information in the possession of this defendant which might enable the defendants in the other actions to show that the patents assigned are not valid patents. With regard to that it has been decided—and that is well settled—that the licensee of a patent is, during the continuance of his license, estopped from disputing the existing patent; but it is going a great deal further to say that a man who has assigned a patent is to be restrained from mentioning to any person at any time, or under any circumstances, matters which might show that the patent, which has been granted by the Crown in the belief that the invention claimed was a new invention, was not, as a matter of fact, a new invention. No authority having been cited to me upon the point at all, and the principle invoked from the case of a licensee not seeming to me to go nearly far enough for the proposition in support of which it is cited, and there being no authority for that being done which I am now asked to do, I decline upon an interlocutory motion to go so far as to say that the defendant can be restrained from communicating to other persons material information within his own knowledge relating to specifications or other matters antecedent to the granting of the patents in question.

LUCAS v. MILLER.

[1885. 2 O. R. 155.]

Variance between Provisional and Complete.

Action for infringement of letters patent granted the 19th June, 1880, No. 2493, to *Joseph Lucas* for "an improved bicycle lamp."

The invention related to that class of lamp which is hung from the axis of the bicycle between the discs of the hub. The object was to obtain a lamp sufficiently small to pass through the spokes. It had been usual to fasten at the top of the lamp two semi-cylindrical pieces, jointed by a single joint to one another and to the top of the lamp. These semi-cylindrical pieces (known as the barrel) then clipped round the axis of the bicycle, and the unjointed ends being fastened together, the lamp remained suspended below the axis. It was usual to fasten the door containing the glass by a horizontal joint at the top, so that the door opened vertically, and was caught when shut by a laminal spring at the bottom. *Lucas* dispensed with the horizontal joint of the door, and hinged what had hitherto been the unjointed ends of the semi-cylindrical pieces. He then fastened rigidly one unjointed end to the top of the body of the lamp and the other to the top of the door. Thus, in fact, he magnified the previous horizontal hinge of the door into a barrel which would go round the axis, and when opened out vertically the pieces were in this order: body of the lamp, semi-cylindrical piece, hinge, semi-cylindrical piece, front or door of lamp. He thus described his invention in the provisional specification:—I construct the lamp of any design suitable to my requirement. To the upper portion of the body of the lamp I arrange two semi-cylindrical forms, in commerce designated a barrel, in an horizontal line, and extending the width of the lamp, or nearly so. These are connected together by means of a hinge or joint at the top. One of the said forms is securely connected to the body, the other is securely connected to the door, which is the front of the lamp, the door being locked by engaging in two lamina springs at the base of the body of the lamp. When desirous of affixing and suspending this lamp to the axis of a bicycle or other vehicle the spring is first depressed, and the door released and elevated until reaching a vertical position. The lamp is now double its original height, but the body is reduced in breadth or bulk to one half. It will now pass

between the spokes with ease, and the semi-cylindrical forms or barrel being also vertical and open can be arranged with facility upon the axis, and a folding or downward movement will bring it to its normal position, securely locking the barrel to the axis and door by means of the spring as before described."

In his complete specification he repeated this passage and described his invention with reference to figures and letters. The letters were as follows: *a*, body of the lamp; *b*, the door; *c*, cylindrical barrel; *k*, the hinge. It appeared that after his provisional specification was filed, he discovered a further improvement, which he thus described:—"For imparting steadiness and obviating noise caused by the friction of axis, semicircular washers of leather *o* have hitherto been employed, but these have always been permanently affixed, so that when worn a difficulty arose as to replacing. I propose to employ the form *e'* pierced from sheet metal with the upturned edges *e'* bent or closed at the dotted lines, thus forming a semicircle with two sides, the leather washer *o* being arranged between. It is passed into the rim *p* of the barrel *c* by a partial rotary movement, and thus firmly secured. The action can be reversed for replacing the said washers. The screw *r* will assist in bringing the washers up to the axis when worn."

Claim: The construction and arrangement of a lamp for bicycles and other analogous purposes, consisting of the combination of the divisible barrel *c* with its rim *p* for receiving the form *e'* constructed to hold the washer *o*, and regulated by the screw *r* and its joint or hinge *k* in its relation to *a* and *b*, substantially as hereinbefore described and shown on the accompanying drawings, or any modification thereof.

The defence raised was (*inter alia*) variance between the complete specification and the provisional.

Judgment for the plaintiff.

KAY, J.—It is not the function of a provisional specification to claim anything. The claim, as was very truly said by my lamented friend, SIR HENRY JACKSON, in one of his admirable arguments in a patent case, in which I was opposed to him—the claim is in point of fact a disclaimer; it shows what parts, and what parts only, of the whole invention you mean to protect by your patent. Here the plaintiff does not attempt to claim by his complete specification any new invention entirely separate and apart from that which was described in the provisional specification; but having described the mode of opening the lamp and barrel, it

occurs to him that it would be an improvement upon that particular form of lamp to which this improvement is specially adapted, to have a rim within the barrel into which he could slide these washers. Now is that an invention so completely apart from the invention described in the provisional specification that it makes the complete specification bad, because it is a part of the claim in the complete specification? In my opinion it most clearly is not.

The learned Judge then referred to *Newall and Elliott* (vol. i., p. 326) and to *Bailey v. Roberton* (vol. i. p. 26), per Lord BLACKBURN, and continued:—As I understand that, every word of it is against the defendant. Here is a small detail, discovered after the provisional specification, which the inventor thinks will enable his invention to be worked more easily, and he puts that into the complete specification. It is admitted he has a perfect right to it. He also says: “I wish to claim that as part of my combination.” There has been no attempt to show that that fails for want of novelty, or on any ground of that kind. The only defence attempted on that part of the case is, that, in point of fact, because he has added this small detail to his claim in the complete specification, that makes it all bad. I entirely disagree. I think Lord BLACKBURN’s words show that it was precisely one of the things which he had a right to add.

MOORE v. BENNETT.

[1880—4. 1 O. R. 129.]

Distinguishing Old and New—Combination—Infringement.

Action for infringement of a patent granted the 6th Sept., 1877, to A. W. Moore, for “improvements in machines for cutting and trimming the hairs or bristles of brushes.” The machine consisted of a bed plate having bearings carrying a spindle. Through this spindle was a longitudinal slot in which was fixed a longitudinal cutter having edges on each side of the spindle. There was arranged alongside a horizontal cutter so that when the spindle revolved the revolving cutter came up with its edges alternately and cut the bristles of the brush presented to it. The revolving cutter was arranged at such an angle that the edges of it came in close proximity to the fixed cutter only at one side first, and gradually as the spindle revolved to the other side. The specification described the invention in detail. *Claim*: The combinations and arrangements of parts and mechanism, substan-

tially as and for the purposes hereinbefore described and set forth.

The defence raised the usual issues.

The defendant's machine was alleged to have worked with its cutters strictly parallel, and so was said not to have infringed.

At the trial before FIELD, J., without a jury, judgment was given for the plaintiff.

Appeal to the Court of Appeal (Cotton, Lindley, Fry, LJJ.). The Court were not satisfied with the evidence as to the defendant's machine, and referred the question to an expert chosen by the parties, who reported that the defendant's machine would work with its edges strictly parallel. The Court then held that the defendant had not infringed, and that the specification was bad for not distinguishing old from new.

Appeal to the House of Lords. Appeal dismissed without costs, as their Lordships considered the specification was not bad, but agreed with the Court of Appeal that the defendant had not infringed.

SELBORNE, L.C.—The learned Judges in the Court of Appeal 1 O. R. 143.
thought that this specification was bad on the grounds which Lord WESTBURY stated as his reasons for holding the specification bad in the case of *Foxwell v. Bostock* (vol. i. p. 200). Your Lordships have not at all to consider whether in the case of *Foxwell v. Bostock* the decision arrived at was correct or not; nor have you to consider whether, when interpreted with reference to the facts of that case, the language used by the very eminent and able Judge who decided it may not be susceptible of an interpretation which would make that language correct in point of law. But, my Lords, I feel that your Lordships cannot refuse to regard the decision in *Foxwell v. Bostock* in the light in which you have already explained and interpreted and commented upon it by your own decision in the case of *Harrison v. The Anderston Foundry Co.* (vol. i. p. 221). And, so explained, it appears to me to amount to no more than this: that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is improved. For example, if a machine exactly similar to the plaintiff's had been long in use in the brush trade, and some particular improvement, say in the arrangement of a cog, or in the arrangement, it may be, of some

other portion of an old combination which was new and useful, had been made, the general combination remaining the same, then, according to the decision in *Foxwell v. Bostock*, by describing it as a new combination you would be misdescribing it, because, indeed, the thing discovered would be a particular improvement upon a particular part or element of that combination. And upon the principle (which no one can dispute) that the specification should not be vague, but should give sufficient information, it ought not to disguise the real invention by a claim so wide that any one would suppose something to be claimed as new which is not, but it should do it sufficiently and with proper precision. But your Lordships will decide, consistently with what, I think, is the general rule in these cases, by holding that where the claim is for a combination, and not for particular subordinate things included in that combination, if the combination is a new one, in substance and in truth, and if the manner of arriving at it and working it, and the purpose for which it is useful, are all properly, sufficiently, and correctly described in the specification, so that any one acquainted with the subject will know in what respect it differs from the things which have gone before, then it would be contrary to the whole policy which allows such combinations, though no part of them is new, to be the subject of a patent; to say that, besides describing clearly and sufficiently the manner of doing it, in a way which would show everyone acquainted with the subject what was the novelty in the thing, you are to go on, and though you do not want to claim subordinate parts of the combination as distinct from the entire combination, nevertheless you must specify the subordinate parts of it as constituting new elements and a new thing. The case of *Foxwell v. Bostock* was qualified or explained in *Harrison v. The Anderston Foundry Co.* It was treated as an authority in such a way as to make it impossible to apply it to the present case, where, looking at the specification and at the evidence, it is perfectly clear that no such general combination as this had been at any time used, and where the material and important parts of the two arrangements and combinations, which are described, are clearly, plainly, and intelligibly described. It would, in my judgment, be in direct contradiction to the decision in *Harrison v. The Anderston Foundry Co.* to hold the specification bad.

1 O. R.
148.

LORD BLACKBURN, as to the costs said: The general rule, or rather the reason of the rule, is that where there is a successful party, that is to say, a party who has brought an appeal and suc-

ceeded, *prima facie*, he being in the right, gets the costs of the appeal. Where there is an appeal upon two grounds, and the appellant succeeds upon one, and the respondent succeeds upon the other, the party who has succeeded upon one was justified in bringing the appeal, but he has not succeeded altogether, and he does not get the costs. As, I think, Lord CAMPBELL used to say, the costs are to the victor; but where there is no victor, and each party gains a part of his case, there are no costs; and it is upon that ground, namely, the appellant having succeeded in inducing your Lordships to come to the conclusion that the Court of Appeal was wrong in thinking that the specification was bad as a specification, having succeeded in establishing that point, he is not to pay costs to the other side. But, having failed in showing that the Court of Appeal was wrong in holding that there has been no infringement, he does not get the costs. The result simply is that the costs are thrown away.

Specifications were not introduced at the time of the Statute of Monopolies. Down to the time of Queen Anne (I forget the exact date) there was no specification, or anything like a specification, in use; but at that time the practice was introduced, and it has been continued ever since, of putting a proviso into the patent to this effect: that "If the patentee shall not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing, the patent shall become void." This has been recognized by the Legislature, but the terms of the original proviso remain, I believe, unaltered. Now, it is upon that that the first question arises. I do not myself know that I can more accurately or more distinctly say what I think should be the nature of the specification than by saying that it must "describe and ascertain the nature of the said invention, and in what manner the same is to be performed;" and I myself think that, in order to do that, it is necessary that there should be a sufficient explanation to indicate to a person who has competent knowledge how the thing is to be done, and what it is that the patentee says he has invented. It may possibly be that after you have ascertained that, and know that the patentee says he has invented A. and B., it may be proved as clearly as possible that his real invention was A., B., and C., and that he has for some reason or other suppressed C. He has not, in that case, described his invention. Though the patent would have been good enough before the reign of Queen Anne, yet since that time a specification having been used, and he not having given a specifi-

cation describing the invention, the patent is void upon that ground. It may be that when he describes his invention truly enough, and shows that he is the inventor, it may be proved that though A. was new and very meritorious, and B. was, as the patentee really believed, a part of his invention, yet it was old, and that which had been used before ; so that, though he had invented it, he was not the first person who had invented it, and it was not a manufacture which others had not previously used. Then, by virtue of the Statute of Monopolies, if not by the Common Law, the patent would be void as giving him a patent for more than the Crown had a right to give him a patent for. But that would not be a fault in the specification ; it would be a fault in the case.

Having said that much, I think it follows from it that the specification should give such a description of the thing claimed as the subject of the patent as should be intelligible to a person, as I said before, having competent knowledge. There are, I think, a good many cases which go to that extent. I will not at present pretend to give an abstract definition of what, in my opinion, would be a sufficient description in all cases. In *Foxwell v. Bostock*, Lord WESTBURY certainly had given an elaborate judgment ; and the Court of Session had, in the case of *Harrison v. The Anderston Foundry Co.*, applied that to the specification before them, and had come to the conclusion that the specification then in question was bad, because *ex facie* it did not (as they understood Lord WESTBURY to have laid down) show, in the combination for the improvement of the existing apparatus, sufficiently clearly what was new and what was old ; and that on a principle which, if they rightly understood Lord WESTBURY in *Foxwell v. Bostock* (and I say nothing about whether they rightly understood him or not), and if that principle was applied to specifications for combinations, would, I think, make it impossible to draw a good specification for a combination of old materials without such a degree of prolixity as would render it practically impossible. That, if it had logically and clearly followed, would certainly practically make it impossible to have a good patent for a combination. But when the case of *Harrison v. The Anderston Foundry Co.* was brought to this House, it was determined by this House (and we must take it that it was rightly determined) that if *Foxwell v. Bostock* was understood in that sense it was going too far. It seems to have been doubted whether Lord WESTBURY did mean that or not. I should myself rather come to the conclusion that

Lord WESTBURY did so ; and the present Court of Appeal thought that Lord WESTBURY did so, and they thought that they were right in following him. But, whether that is so or not, this House said that in that case it was going too far. I should be strongly inclined to say that if the defendant had taken the plaintiff's edges, not parallel but tapered, as the plaintiff asserts that he did, it would have been taking a substantial and real part of the combination, and for the object for which the combination was to be useful, namely, the making of brushes in that way ; and that it would not have been less an infringement and taking a part of the property because the defendant added superfluous things, if he did add them, or because he substituted equivalents for some other things in the combination, or even left out parts of the combination altogether, provided always that he had taken a substantial part of it for the purposes shown in the specification. And I am strongly inclined to think (whether it is necessary absolutely to decide it or not I do not know) that if the plaintiff had proved that, he would have proved that there was an infringement.

1 O. R.
150.

MOSELEY v. VICTORIA RUBBER COMPANY.

[1886. 55 L. T. 482 ; 3 O. R. 351.]

Privileged Communication—Solicitor also Patent Agent—Interrogatories.

Action for infringement of two patents (1) granted the 2nd Nov. 1883, No. 5207, for "improvements in the production of ornamental designs on waterproof fabrics ;" (2) granted the 9th April, 1884, No. 6175, for "improvements in the methods of producing ornamental designs on the surface of textile fabrics," both to *Charles Moseley*.

The defendants (*inter alia*) denied infringement : thereupon the plaintiff interrogated them ; by their answer (*inter alia*) the defendants described the process they carried on. After this answer the plaintiff discontinued as to the 1884 patent, but set down the action for trial as to the other patent. The defendants then delivered interrogatories referring to their answer, and interrogating him as to which of the processes or stages of the processes therein described infringed the 1883 patent, and which infringed the 1884 patent. They also interrogated the plaintiff as to documents in his possession relating to the preparation of the specifications filed under the two patents, or containing any instructions to the draughtsman employed to settle the same.

The plaintiff answered stating that the processes described in the

defendants' answer were infringements of the 1883 patent. He refused to answer the defendants' interrogatories so far as they required him to distinguish between such of the defendants' processes as infringed the 1883 patent and the 1884 patent, on the ground that the particulars of breaches had been sufficiently stated by him, and that the information asked related exclusively to his case, and to the evidence by which and in the manner in which he intended to establish it at the trial. As to documents, he stated that he had documents relating to the preparation of the specification of the 1883 patent, viz., correspondence, &c., between himself or his firm *Moseley and Sons* on the one hand and his solicitor on the other hand, between *October*, 1883, and *May*, 1884, and also drafts of specifications and instructions to counsel to settle the same, and the plaintiff stated that all such documents were confidential communications between himself and his solicitors and counsel, and that the same were privileged, and that he was not bound to produce the same, and he declined further to answer on the ground that the action having been discontinued as regarded the 1884 patent the rest of the interrogatory was not relevant to any issue in the action. The defendants took out a summons for a further answer which, with a summons for production of documents, was adjourned into Court, and came on before CHITTY, J.

It appeared that Mr. *Johnson*, the plaintiff's solicitor, was also his patent agent. The learned Judge, in the course of the argument, said that all the defendants could claim to see were the communications made to the solicitor in his capacity of patent agent.

The learned Judge, even assuming that privilege was in form sufficiently claimed for the documents referred to (which he did not decide), ordered a further answer. Costs to be costs in the action.

CHITTY, J.—It is quite clear in point of law that communications between a man and his patent agent are not privileged, and therefore, seeing the nature of this correspondence which is referred to and seeing the double character which Mr. *Johnson* occupies, it appears to me that the defendants are entitled to an answer more precise * * * * No doubt the plaintiff might be in some difficulty in distinguishing what communications took place between him and his patent agent and what took place between him and his solicitor, seeing that the patent agent and the solicitor are one and the same person. I agree. But that very observation shows that some more exactness is required in the answer; and it

shows, I think, that the meaning of this paragraph was that there were confidential communications between the gentleman who was the plaintiff's solicitor, and, no doubt, something else besides. In all these matters where a privilege is claimed with regard to the documents, the party's oath, if sufficiently pledged, decides the question; and it is important, therefore, seeing that the other side cannot cross-examine him or test what he states in any way for the purposes of this interlocutory proceeding, it is important, I think, in a case which requires precision, that there should be great exactness.

The plaintiff has been advised that his action cannot be sustained in regard to the patent of 1884, and he has discontinued it. Now, of course, there is no direct issue left relating to the patent of 1884. I understand the defendants to state, and it is not denied in general terms on the other side, that there is considerable similarity between the patents of 1883 and 1884, and the patent of 1884 is but a small advance, if any, on the patent of 1883. The two patents deal with the same subject-matter and relate to a process of manufacture, and it is said on the part of the defendants that at least some portions of the description contained in the specification of 1883 relate to matters of common knowledge. I am not saying that, with a view at the present moment of showing that the patent of 1883 is invalid, but I am merely making that as a general statement. Then the defendants say that though they cannot make any definite statement as to the effect of the correspondence that took place in regard to the patent of 1884, there is fair ground for believing that the two inventions have been so closely connected that in the communications which they wish to get at, namely, communications between the plaintiff and his patent agent, there will be material facts to be disclosed which will assist their case in breaking down the patent of 1883. I am not disposed myself to allow fishing interrogatories, but it seems to me that I should be doing no injustice to the parties if I say that there ought to be a further answer, and I do so say as to the patent of 1884.

The particulars, as they now stand amended, of breaches, are—first, that the defendants themselves manufactured according to the specification; and, secondly, that there was a sale of certain particular articles in a particular day to one *Cohen*; and, thirdly, manufacturing according to the defendants' patent of 1884. The defendants have delivered interrogatories to the plaintiff, in which they seek to obtain more specific information with regard to the

breaches. The plaintiff has answered that to this extent. He says, "I have looked at your answer, and I see what you say, and according to my belief it is not true that none of those processes infringe my patent, but, on the contrary, according to my information and belief, the processes do infringe my patent." There he stops, and says, "I am not bound to tell you any more. You can read my specification for yourself, and I am not bound to argue my case at the present moment. There is my specification. Look at it, and compare it yourself with what you have told me you yourselves do." The defendants say, "We are not content with that. We want you to point out the exact lines, and so forth, in the specification which you, the plaintiff, say contain the gist of your invention so far as we are infringing it." I think the interrogatories go beyond what is required in an action of this kind. I think the defendants can read the plaintiff's specification, and see what it means. If it is unintelligible of course the plaintiff will fail. The defendants can compare for themselves what they themselves swear that they do with what is printed and open to them in the plaintiff's specification. This is not a very important point between the parties to my mind. I think it is sufficient to say that I do not require the plaintiff to give any further answer.

MOSS v. MALINGS.

[1886. 33 Ch. D. 603; 35 W. R. 165; 3 O. R. 373.]

Practice—Amendment of Particulars at Trial—Publication—Subject-matter—Infringement.

Action for infringement of a patent granted 1st Jan. 1884, No. 226, to *Ralph Slazenger Moss*, for "improvements in handles for bats and other analogous purposes." The patentee had adopted for tennis rackets a handle, founded on a shin bone as a model, with two opposite grooves, the grooves extending in length as far along the handle as the hand is likely to be applied thereto. The specification stated:—The hold of the handle is firm and secure from the increase of surface in contact with the hand; the enlargement at the end also enables the operator to hold the handle at a farther distance from the striking or operating part of the bat or other instrument, thus affording a more powerful stroke and additional force, and the handle is not likely to slip out of the hand. The only *Claim* was:—The method of constructing the handles of bats for the purposes aforesaid having grooves and an enlarged

end substantially as hereinbefore described and shown on the drawings.

The defendants raised the usual issues. In particular they alleged that in *Nov.* 1883, one of their workmen designed a handle, on each of the four sides of which was fixed a piece of wood with a convex surface. This handle was registered by the defendant as a new design in *April*, 1884. Numbers of them had been sold and were the alleged infringements. The action came on for trial, and the plaintiff was called. After his evidence in re-examination was finished, the defendant applied for leave to further cross-examine him as to a purchase by him of a handle made according to the invention before the date of his patent. No mention was made of this in the particulars of objection.

NORTH, J.—I cannot allow the plaintiff to be cross-examined to show that the defendant has a case for amending his particulars. At present there is no evidence before me to justify an application for leave to amend the particulars. I should only grant it now if it were shown that the matter has only been recently discovered, and could not, with reasonable diligence, have been discovered before. I have not heard a suggestion of that sort made, and without that I could not grant such an application as this.

33 Ch. D.
604.

Judgment for the plaintiff.

NORTH, J., said that even if the alleged model had been prepared, the defendant did not treat what he says was done as a sufficient publication to prevent his registration being of an original design. If it did not publish his own invention it could have no effect whatever in anticipating the invention of the plaintiff, which was the subject of the patent of the 1st *Jan.* previous. It is not a question here of the plaintiff being the first inventor, having seen the model that was prepared. There is no suggestion that the plaintiff ever saw that.

Then it is said that a bat handle such as this is not a proper subject for a patent, and I must say it does seem to me to be a somewhat slight matter for such a matter as a grant of a patent. It is suggested that this alteration of the handle is a mere decoration. I do not think that at all, but it is something which is clearly proved to have been novel; and, as regards the novelty, I must say that there is no evidence whatever of there having been anything whatever like it before. It does not appear that persons were planning things of this kind. It seems to have been a new idea. Nothing was produced resembling it in any way, or even leading up to it, excepting this bat made in November, and

that being so, seeing that it is clearly novel, in my opinion, seeing also that it is clearly useful, and seeing that it has had a large sale, it does not seem to me that it is a matter in which I can refuse to say it is a proper matter for a patent. In considering whether there had been any anticipation of the same sort of thing before, the nearest thing that the counsel for the defendant could suggest was the fluting of columns. That seems to be a very long way indeed from making a bat handle, the object of fluting a column being not for grasping it by the hand, but something entirely different from the object for which the plaintiff's and defendants' handles are shaped and made. Then it is said it is merely a matter of alteration of configuration, and so on. With reference to that, it is quite clear there are many things with respect to which a mere alteration in shape, being novel and being useful, is quite enough to be good ground for a patent.

As to the infringement his Lordship said:—A suggestion has been made that there is a difference in this way, that what the plaintiff has done has been simply to take what you may call a solid handle and groove out certain indentations in it, whereas the defendants' is totally different, because he has taken what I call again a solid handle, and he has built up certain ribs or put certain protuberances upon it. The result in both is the same; there are alternate elevations and depressions, and whether those are produced by cutting out the intervening bits or building up the ribs so as to leave holes between the two seems to me entirely immaterial. The same result is produced in each case.

NEEDHAM v. JOHNSON.

[1881—4. 1 O. R. 49.]

Infringement—Construction—Combination.

Action for infringement of a patent granted 18th Sept. 1860, No. 2831, to *W. Needham and J. Kite* for "improvements in machinery or apparatus for depurating fluids."

The object of the invention was the use of paper as a filtering medium under high pressure. The inventor used square frames which could be fitted together so as to form a cubical box. In the first frame were, at top and bottom, tubes which fitted into holes in the next, which had on the opposite side similar tubes which fitted into the 3rd, and so on, that when the frames were put together, there was a pair of continuous tubes at top and bottom. In the upper tube between the frames was an eyelet

hole which allowed the fluid to be filtered to get in between two filtering papers supported (the specification stated) "by the use of perforated plates or diaphragms of equal or of greater length and breadth or diameter than the frame forming the supply and discharge chambers, so that when the press is put together ready for operating, these diaphragms are simply nipped between, and are not recessed in, or in any way fixed to these frames; but this would not of itself entirely secure the paper against breakage, as it would be liable to break under pressure against the edges of those perforations in the diaphragms by which the depurated fluid enters the discharge chamber after filtering through the paper, and thus give passage to unfiltered fluid. We overcome this difficulty by interposing a textile fabric, an ordinary filtering cloth for example, between the paper and the perforated diaphragm, and we sometimes enclose the paper between two cloths to give it additional support, and to keep the densest matter from contact with the paper." The papers, diaphragms, and cloths were threaded on the tubes. "By this arrangement we obviate the necessity of holding the paper by hand until two frames are brought together, as the above-mentioned tubes passing through the paper support it, so that it cannot slip from the face of the diaphragm, the cloths being carried in a similar manner; and thus it is only necessary to push the frames together, and brace the whole, to have the press ready for working." The action of the press was as follows:—The fluid to be filtered was forced in through the upper tube, ran through the first eyelet into the first filtering chamber and filled it: then ran on to the second eyelet hole and filled the second chamber, and so on till all the filtering chambers were full. The pressure then forced the fluid through the papers and diaphragms, leaving a cake in the filtering chamber, and the depurated fluid flowed out on each side of the diaphragm and fell into the lower tube, in which were holes to receive it. It could then be drawn off without ever coming in contact with the oxidising action of the atmosphere. *Claim*: 1. Securing filtering paper from breakage under high pressure by the use of plane diaphragms and textile fabrics applied substantially as herein set forth. 2. Forming continuous supply and discharge conduits by simple contact of the frames substantially described and shown.

The alleged infringement consisted of square frames which had central projecting tubes on each side which did not meet in the middle but between their ends, and to them was fixed in each chamber a bag of the filtering medium. The bags were filled

with the fluid, which filtered through into a trough running at the bottom of the chambers. The defendants did not use paper for filtering.

1 O. R.
51.

LOPES, J., sitting without a jury, gave judgment for the plaintiffs.

Appeal to the Court of Appeal (Esher, M.R., Baggallay, Lindley, L.JJ.). Judgment for defendants on the ground of no infringement.

1 O. R.
52.

ESHER, M.R.—It was urged that there was no sufficient invention in the plaintiffs' alleged invention. Now, if that were to be said of the whole of the plaintiffs' machine, it seems to me utterly indefensible. Everybody must be of opinion, I think, that, to take the plaintiffs' machine as a whole, it is an excellent invention; and taking the plaintiffs' machine as a whole, it cannot, I think, be denied that it is novel. But, for some reason or other which I cannot define at the present moment, because I suppose we have not had sufficient information, I do not think that the person who drew the plaintiffs' specification has claimed the whole machine. I do not know why he has not. I do not think he has; not that it is very material in this case, because it cannot be contended that the defendant's is an infringement of the whole of the plaintiffs' invention. I do not think he does claim it. He claims two different parts of that which is effected by the plaintiffs' machine. If he claims the whole of the machine it seems to have been admitted that the phrasology of these claims is wrong, because there ought to have been a first, second, and third, whereas it is only first and second. That, of course, would not of itself have shown that it had not been claimed. But I can see nothing that claims the whole machine.

The whole matter depends upon the second claim, and what is the meaning of it? Speaking for myself I think that that involves a difficulty which arises over and over again in the use of the English language, "forming continuous supply and discharge conduits." You may, as it seems to me, read that in one of two ways:—"forming continuous supply conduits, and forming continuous discharge conduits;" or it may be read according to the ordinary English idiom, "forming continuous supply and discharge conduits." In the one case it would be that each conduit must be a continuous thing; in the other, it means that the two conduits together must be continuous. These are the two readings, and I am inclined myself to say, according to the inaccurate way in which English is very often written, that it might be capable of

1 O. R.
53.

either. If you say that it is forming a continuous supply conduit, and, separate and distinct from that, it is forming a continuous discharge conduit, I think it would describe what has happened in the plaintiffs' machine, because it is to form each of them by simple contact of the frames. Now, even if you take one of the frames alone, there is no conduit in it at the top; there is a mere hole through it. That is not a conduit, surely; but if you put the frames together in the way which is described here, so that the holes in each of them come in contact with each other, then, if there are enough of them, of course it forms a conduit in the sense of forming a pipe. Therefore, by the simple contact of the frames you would form a conduit; and, to my mind, the word "continuous" would have the effect referred to, because it would be a conduit without a break, by the simple contact of the frames. It is capable of that construction, I think. In the same way, the same thing would apply to the discharge conduit. If that be the true construction of that second claim, it is virtually two claims. It is a double claim put into one. I say, *if* that is the construction, it would be a claim for a continuous supply conduit, and for a continuous discharge conduit. That being the construction, it is admitted that there is an infringement of one of those claims. But then, at the same time that that is admitted, it is said that if that be the claim, then a part of the claim, that is for one of those conduits, is bad for want of novelty, and that that makes the whole patent bad. I do not think it was disputed that if that were the construction of the claim, one of those conduits is bad for want of novelty.

But then it is said that there is another possible construction of this claim; and the construction which is suggested is as follows: It is admitted and cannot be denied that the claim here is for machinery, and substantive pieces of machinery. It is not a claim for a result with regard to the liquid. It is a claim for the machinery, and the means by which the machinery acts upon the liquid. The other reading of that claim seems to me to be this: that it is a claim for a combination of machinery; and that combination must consist of two conduits, the one a supply conduit, and the other a discharge conduit, and that the claim is that they are parts of a machine, and so placed in that machine that they act continuously. But then, in order to make them act continuously in the machines (that is, in order to make the machines act continuously), you must have something in the machine which produces the continuity. That is said to be the mode in which,

with regard to these two pipes, the supply and discharge chambers are placed, and that they act, it is said, with regard to the supply conduit, by allowing the liquid to come from that supply conduit into one of them and pass into the other; and with regard to the discharge conduit, that they allow the liquid to pass from the second of the two chambers into that discharge conduit. If that be so, and if this claim is for the machinery, what you are claiming is a combination of machinery which consists really of two conduit pipes joined together by supply and discharge chambers so placed in the machine as to act as these supply and discharge chambers do. If that be so, it is a claim for a combination of the physical parts of that which forms the machinery combination which is claimed. It is true, if that be the claim, it does not signify, as it seems to me, whether the elements or the elementary parts of that machinery were new or old. You do not claim them; you claim the combination of them.

Then arises the question whether, if that is the claim, the defendants have infringed it,—have infringed the combination. They have infringed it if they have used that combination, or if they have used something which is only colourably different from that combination. If they have used that combination, and also something added to it, that combination remaining a necessary part of their machine, but the addition to it being an improvement, and if they have used that, but without acknowledgment, that is to say, without acknowledgment that they are only using an improvement, that would be an infringement, no doubt. If they had invented such a machine as I have described, they would have been entitled to take out a patent, not for that machine as a new machine, but for an improvement upon the plaintiffs' machine. If they had claimed the improvement on the plaintiffs' machine, they could not use their improved machine without paying the proper price to the plaintiffs for having used their machine although improved. If they used it without paying, they would infringe.

1 O. R.
54.

Having stated that that combination consists in combining the two conduits, which conduits are formed by simple contacts of the frames, and the continuity of which is established by so placing the supply and discharge chambers that they will conduct a liquid from the one to the other in the way described, it is a necessary part of that combination that that should be so. If the defendants have not two conduits at all—if they have a continuity of passage in the liquid brought about without the use of two conduits at all,—they certainly have not the same combination as the plaintiffs';

and if they have that continuity brought about by a conduit and something else which is not the plaintiffs' and not by another conduit, but by something else which is different from it, then, of course, they have combined two things which are different from the things which are combined in the plaintiffs' patent. It seems to me, on the best consideration I can give to it, that unless that which is done in the centre of the defendant's machine is a conduit, or equivalent to a conduit,—that is say, although it is not precisely what might be called an actual conduit, and yet only colourably different from a conduit—unless that be so there are not the two conduits in the defendant's machine which have to be made continuous by the chambers and the combination is different, * * * *

If a conduit or any thing only colourably different from a conduit was produced in the centre of the defendant's machine I should say that the mere fact of its being in the centre instead of the top would not prevent it from being an infringement. That would only be a colourable difference. The difference of position would make no real difference, and would only be colourable. But does it make a conduit at all in any ordinary sense of the word? It is said that it produces a column of liquid, and that the column of liquid passes through the conduit which is a conduit proper in the plaintiffs' machine—the supply conduit. Well, that may be so, but this patent is not taken out with regard to the liquid or with regard to the mode in which the liquid passes; it is taken out for the machinery by which the liquid is caused to pass in a particular way; and if a different machinery causes the liquid to pass in the same way, if the machinery is substantially different, it is only saying that the defendants produce the same result in the liquid by a different machinery, which the plaintiffs produce by their machinery.

LINDLEY, L. J.—This is not and cannot possibly be construed by any fair process of interpretation as what is called a patent for a principle. I do not mean, of course, an abstract principle, but what is usually understood by that. It cannot be so construed. We must look at it fairly, and see what it really means, and what it really does amount to. I do not like the expression, “benevolent interpretation.” I do not believe in it. The question is, whether a given construction is the true construction; but, of course, if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which

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renders it invalid. There is no particular benevolence in that. It is a general principle of interpretation applicable to all documents, but of course those who talk about the benevolent interpretation do not mean more than that. They do not mean you are to put upon a specification a benevolent interpretation, which will turn that into an infringement which is not an infringement. Benevolent interpretation has nothing to do with infringement; it has to do with the validity of specifications.

One must enquire and see whether the hole which the defendants have through the middle of their filtering diaphragms or divisions of compartments is substantially the same as the plaintiffs' continuous supply pipe with holes. Looking at the thing in the abstract, one does not see a very great deal of difference between a continuous pipe with holes and a continuous series of holes which do not actually touch and join. If you look at the thing merely as an abstract matter, I do not see that there is very much difference, but when you come to look at the working there is a good deal of difference. For the purpose of trying this question, whether the difference is colourable or not, it is, I think, impossible not to bear in mind the great object of the plaintiffs' invention, which is to adapt the whole of their machinery to a proper filtering apparatus. I cannot lose sight of that; and it appears to me to be almost conclusive upon this question of the colourable imitation to show that the defendants' series of holes cannot be used for the purposes of a paper filter at all. That, I think, shows it. The plaintiffs' apparatus is constructed on purpose to use it with paper, and although I do not mean to say that if the defendants copied the whole thing, and did not use paper, that would not be an infringement (of course it would), still, when we are considering whether their series of holes is substantially equivalent to the plaintiffs' series, it does appear to me to be almost conclusive that you cannot substitute one for the other. I have come, therefore, to the conclusion that the difference is not a mere colourable difference. It is a substantial difference, and there is no infringement of the plaintiffs' patent.

Their Lordships gave the defendants the general costs of the trial and of the appeal. As to any costs occasioned by suggesting want of novelty, no costs were given to either side, as the Court did not decide whether the Judge in the Court below was right or wrong in holding the patent good.

NORDENFELT v. GARDNER.

[1882-4. 1 O. R. 10, 61.]

Infringement—Combination—Improvement—Distinguishing new from old—Costs.

Action by assignee for infringement of a patent in part disclaimed, granted 13th May, 1873, No. 1739, to *J. H. Johnson*, for "a new or improved battery gun" (a communication, &c.). The new gun was an improved form of mitrailleuse or battery gun. One improvement consisted in the feeding apparatus: a carrier block under the magazine received the cartridges that fell into it and carried them to the ends of the barrels. The cartridges were then forced into the barrels, discharged and withdrawn into the carrier block. The carrier block then went back into its position under the magazine, and as it moved back the discharged cartridges fell out. A further improvement was what was called the spreading crank, by means of which the projectiles radiated, and dispersed in a fan-like form over the plane of fire. *Claims 2.* "The general construction, arrangement, and mode of using the feeding apparatus, substantially as herein-before described and illustrated by the drawings annexed. 8. The peculiar spreading apparatus or mechanism so constructed as to cause an automatic and uniform distribution of the projectiles, substantially in the manner herein-before described. 9. The spreading crank with its peculiarly shaped grooves, arranged and operating substantially in the manner and for the purpose herein-before described and illustrated by the drawings annexed."

The defendant had manufactured under a patent 1880, No. 5384, in which he did not use the plaintiff's carrier block. Besides denying infringement he said the plaintiff's spreading mechanism was old, having been anticipated by the Montigny gun, patented in 1807. At the trial before HUDDLESTON, B., without a jury, an injunction was granted, the learned baron holding that the defendant had infringed the 2nd claim and that the 8th and 9th claims were new. His lordship allowed costs of the shorthand notes, saying in a subsequent case:—"The case lasted ten days; that case would have taken three weeks if it had been tried without a shorthand writer. It was a case involving very intricate questions of machinery—scientific questions—which it would have taken me a considerable time to write down; and it was agreed to have shorthand notes. They were taken, and were exceedingly useful, and I allowed them."

The defendant subsequently moved to dissolve the injunction

on the ground that the plaintiff obtained a Belgian patent before he obtained his English patent; and that his Belgian patent having expired on the 17th *Nor.*, 1883, his English patent had ceased and become void under s. 25 of the Patent Act, 1852. The plaintiff alleged that the grant of the patent in England was perfected before the grant of the Belgian patent.

The learned Baron came to the conclusion that the Belgian patent was not obtained till the 31st *May*, 1873, and refused the application.

Appeal to the Court of Appeal (Brett, M.R., Baggallay, Lindley, L.JJ.) Appeal allowed and action dismissed on the ground that the defendant had not infringed, though their lordships agreed with the learned Baron that the patent was not void.

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BRETT, M.R., referred to Claim 2, saying:—That is the general construction of the combination or the construction of the whole combination, “the general arrangement,” that is the whole arrangement, and the mode of using the feeding apparatus.

That seems to me to claim the feeding apparatus as a combination, and to claim the combination, and the combination alone. If that be so, how can such a combination be infringed? The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement. Or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition or subtraction or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition or subtraction or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same they are substantially the same; and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things; it would be a combination of different things; and if the combination were altered by a material subtraction, I should think that it

was a new combination. But an alteration by substitution, that is by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is the taking away of one of the elements, and a material element of the old combination, and a putting in of a new material element which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C; but if the original combination is of A, B, and C, and you take away C and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old.

It seems to me, that if you take the claim of the Montigny gun to be for a combination, which I think it is, then the combination of the plaintiff, with regard to the spreading apparatus, introduces a new and substantial element and is a different combination, and therefore is no infringement. If you take it that it is an improvement, there can, as it seems to me, only be an improvement of a combination, in this way, if you leave all the elements of the old combination existing, and add a new element to them. Well, if you do that, I agree that you must claim only for an improvement, and you must point out what the improvement is. I have said I think there can only be an improvement of a combination where you leave all the elements of the first combination and add something to them; for if you alter the elements of the first combination, you have made a different combination, and there is no question of improvement to arise. Well now, I think this of the plaintiff's is a different combination; but if it is an improvement, then comes the question whether that improvement is sufficiently pointed out in the plaintiff's specification. It was urged to us that it must be pointed out in the claim. I cannot agree. If the particular improvement is made clearly manifest on the face of the specification which is alleged to be imperfect, if it is sufficiently pointed out what that improvement is, then I think the objection with regard to want of sufficient description fails.

BAGGALLAY, L.J.—On the question of novelty an argument was addressed to us on behalf of the defendants, which at one time appeared to me to have some weight. It was to this effect: the plaintiff, by his eighth claim, claimed as a new combination the entire combination which constitutes his spreading apparatus; but its novelty is due to the spreading crank, and it is not stated

that the spreading crank is new. If the claim of the plaintiff in respect of his spreading apparatus had been confined to the eighth claim, there might have been, as I at first thought there was, great force in the argument; but all objection on this score is removed, in my opinion, by the ninth claim, in which the novelty of the spreading apparatus, by reason of its peculiar operation and arrangement, is distinctly asserted.

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74.

LINDLEY, L.J.—The plaintiff's patent was alleged to be bad because the specification did not point out what was novel in the spreading apparatus, and claim 8 was so worded as to apply to the whole of that apparatus, including what is old. That part of the spreading apparatus which is old is worked in the *Nordenfelt* gun by means of a peculiarly constructed crank, and that crank is part of the spreading apparatus described in the specification; and the novelty of this part is apparent from the fact that it is the subject of a distinct claim, claim 9. Construing the plaintiff's specification fairly, and with a desire to understand it, we must look not only to claim 8, but also to the description of the spreading apparatus, and to claim 9; and, looking at all three of those, I am of opinion that it does appear, not indeed from claim 8, but from the description and claim 9, what the whole combination is, and how much of it is new. This is all that is required by the authorities, including, among others, *Foxnell v. Bostock*. Claim 8 is to the whole combination, which, as a whole, is new. Claim 9 shows what makes it new, and claims the new portion as a separate invention. So long as the specification shows what part of the combination is new, it matters not where in particular it is shown to be so. The new part may be pointed out either in the body of the specification or in one of the claims. If authority is needed for that, which I can hardly suppose it is, it will be found in *Harrison v. Anderston Foundry Company*. I can hardly suppose that authority is needed, because in construing any document you must construe it as a whole, and not take one particular clause and construe that alone. All that is requisite is that it shall be pointed out somewhere, so that a person reading the specification shall have no difficulty in ascertaining what the new part is.

As to costs the master was directed to allow the plaintiff any costs which he might have incurred by reason of the plea of want of novelty, beyond those he would have incurred if that plea had not been upon the record.

OSMOND v. HIRST.

[1885. 2 O. R. 265.]

Interlocutory Injunction—Laches.

Action for infringement of a patent granted *Feb.* 20, 1878, No. 701, to *J. Osmond* for “improvements in apparatus for marking the ground applicable to lawn tennis and other purposes.”

The defendants manufactured under a patent granted *May* 17, 1882, No. 2315, to *Burrows* and *Dawson* for “improvements in machinery or apparatus for marking out the lines on lawn tennis courts.”

Motion for an interlocutory injunction.

The only questions raised by the defendants were laches and non-infringement.

Injunction granted.

BACON, V.C., as to the points raised, said:—The one I will deal with first is that the plaintiff has been guilty of laches, because the defendants’ patent being in existence since 1882 he has not brought an action until the present time, and it is said that that must be proof of the fact that the plaintiff must have known of the infringement; but the defendants might have cross-examined the plaintiff upon his affidavit; they might have proved *aliunde* that he had stood by and suffered *Burrows* and *Dawson’s* patent to be worked, and never thought of interfering with it from the time the patent was granted till the time the action is commenced. I cannot entertain the notion that there has been any laches on the part of the plaintiff for a moment.

The defendants appealed, but the action was compromised.

OTTO v. STEEL ; SAME v. STERNE.

[1884—6. 31 Ch. D. 241 ; 55 L. J. Ch. 196 ; 2 O. R. 139 ; 3 O. R. 109.]

Amendment of Particulars—Prior Publication in a French Book—Construction of Specification—Prior Action—Costs—Stay pending Appeal.

Action for infringement to a patent granted 17th *May*, 1876, No. 2081, to *C. D. Abel*, the subject of a former action of *Otto v. Linford*. See vol. i. p. 343, where the invention is set out.

The defendants denied the novelty of the invention and delivered particulars of objection. The actions were ordered by PEARSON, J., to come on one after the other. The defendant in *Otto v. Sterne*

asked leave to amend the particulars by adding a particular of the user in public and at South Kensington Museum of an engine constructed according to the specification of *Lenoir*, 6th April, 1865, No. 986, as a prior user. The specification of the said patent was included in the particulars as a prior publication. The application was not made till the actions were in the list for trial. The engine had been lent to the defendant to be kept till after the trial, and was at his works and open to the inspection of the plaintiffs. The defendant had given the plaintiffs notice of these facts.

2 O. R.
140.

PEARSON, J., said that he thought he should give the defendant leave to amend; but of course he must undertake to give the plaintiff all facilities for seeing the engine on his premises, adding: I warn you most distinctly that you may get into a difficulty if, when the case comes on for trial, I have reason to believe that your opponents have not had that facility for investigating everything relating to this machine which I think they ought to have.

The costs of and consequent on the amendment and the application for the amendment to be the plaintiff's in any event.

The action against *Steel* came on for trial, that against *Sterne* having been compromised. The defendant tendered in evidence a book on "The Utilization of Heat," published in France in 1862 by *de Rochas*. The evidence went to shew that there was of this work, which was written in French, one copy only in this country, and that was in the inner room of the British Museum Library. It could be got by any person asking for it by name, or a person not asking for the book by name, but desiring information on any particular subject, would be taken to the department of the Library where books on that subject were likely to be found. It was in the catalogue of the Museum under the name of the author only, and in a French publishers' catalogue, of which copies were distributed in England, it was under the author's name, and also under the title "Physique." On this evidence the book was not admitted in evidence.

31 Ch. D.
243.

PEARSON, J.—The question is, whether or not this book has been published in this country in such a way as to become part of the public stock of knowledge in this country. It is not, to my mind, necessary for that purpose to show that it has been read by a great many people, or that any person in particular has got from it the exact information which it is said would have enabled *Otto* in this case to have made his engine. But, to my mind, it must

be published in such a way as that there may be a reasonable probability that any person, and, amongst such persons, *Otto*, might have obtained that knowledge from it.

The learned Judge quoted a passage from *Plimpton v. Malcolmson*, at p. 560 of 3 Ch. D.: "I have no doubt that that book was in the British Museum catalogue. Of course I cannot say it was." In this case it is proved that it was. "We know that after two years it would have been in the catalogue, and, in fact, long before; and there was nothing to show me it was not read or used, and in the absence of evidence to the contrary the presumption was the other way." 81 Ch. D.
245.

By which I understand JESSEL, M.R., to have said that if there be a book in the British Museum, the presumption is that it has been read. I find it very difficult indeed to go along with the M.R. in that presumption. I do not know the authority for it. He gives no authority for it. But it is certainly to be remarked that in that very judgment, although, if that were so, he might have decided the case simply on the fact that a book was in the British Museum, he does not seem to me to rely on the fact of a book being in the British Museum, but on the fact that there had been copies of the book circulated in this country. If I am to accept the argument, I must come to this conclusion, that it is only necessary to prove that a book is in the British Museum, and I am then to hold that that book has been published in this country for the purpose of an action like this, and that whatever is contained in that book has become part of the common stock of knowledge in this country. As the authorities stand, there is no decision, to my mind, that lays down such a proposition as that; and I cannot help thinking that I should be doing injustice, probably to many persons, if I were to say that inventions honestly made by them were to be held to be bad because they might have been anticipated by something to be found in a book in the library, for which nobody had ever called, and nobody had ever read in this country. I cannot go as far as that; and therefore, there being not only no evidence before me that any other copy of this book has ever reached England, but, to my mind, evidence rather to show that no other copy ever has been known or seen in this country, I must hold that the simple fact that it is to be found in the inner library of the British Museum is not sufficient publication for me to hold that whatever is found in that work has become part of the public stock of common knowledge.

The trial proceeded and judgment was given for the plaintiff.

8 O. R.
114.

Referring to *Otto v. Linford*, the Judge said :—Mr. *Steel* was no party to it, the decision in that case is not binding on Mr. *Steel* ; but inasmuch as it is the province of the Court to construe the specification, I am bound by the decision of the Court of Appeal upon the proper construction of the specification. I do not mean to say that there may be no cases in which it may be plain that the Court has arrived at the construction which is put upon the specification from evidence which has been given before it, and that if contrary evidence were given before me or additional evidence were given before me to shew that the evidence presented to the Court of Appeal in the case was either incorrect or not sufficient, I might not feel at liberty to depart from the decision of the Court of Appeal. But, except in some very strong case of that kind, I certainly should be and should feel myself bound by the decision of the Court of Appeal, and accordingly in this case I intimated that with regard to one of the objections taken in the course of the action, an objection to the specification on the ground that Dr. *Otto* had not, as it was alleged, stated any proportions of the mixture with reference to the residuum that he intended to use, the Court had decided that that was no objection to the patent, and I feel myself bound by that decision.

The plaintiff was refused solicitor and client costs because the patent was impeached on grounds substantially different from those relied on in *Otto v. Linford*.

The defendant appealed to the Court of Appeal and moved to suspend the injunction and the account pending the appeal. The Court (Cotton, Bowen, Fry, L.JJ.) refused the motion.

PARNELL v. MORT.

[1881—5. 29 Ch. D. 325 ; 2 O. R. 55.]

Costs—15 & 16 Vict. c. 83, s. 43.

This action was brought in the Palatine Court for the infringement of a patent. The Vice-Chancellor dismissed the action without hearing the defendant's witnesses. He refused a certificate under 15 & 16 Vict. c. 83, s. 43, and simply dismissed the action with costs. The Registrar on taxation disallowed the costs relating to the defendant's particulars of objections. The Vice-Chancellor on appeal referred the taxation back to the Registrar to review it on the ground that the section did not bind the Palatine Court. The Plaintiff appeared and the Court of Appeal (Cotton, Bowen, Fry, L.JJ.) held the Vice-Chancellor was right.

COTTON, L.J.—In my opinion it is not necessary to decide whether that case (*Honiball v. Bloomer*, vol. i. p. 262) is right or wrong. I only refer to it for the purpose of saying that if ever it should become necessary for this Court to deal with that, and to say whether it would follow that construction of this 43rd section, it must not be considered that we in anyway assent to it, or express our approval of it by not dissenting from it. I will say no more than that. Whether it may be a right construction or not, that decision only applies where there has been such a trial as will enable the Judge to say whether certain particulars of objection have or have not been proved, or have failed. I wish to leave the question open.

BOWEN, L.J.—I should like to add one word about *Honiball v. Bloomer*, and I say that I entertain the same sort of uncertain feeling about that case that the Lord Justice has expressed; and if ever it should become necessary to consider that case, I should like to keep my mind unprejudiced on that point; but I doubt whether it can occur again, because nonsuits have ceased, and that case was one which especially turned on the effect of a nonsuit.

PERONI v. HUDSON.

[1883—4. 1 O. R. 261.]

Defendant not appearing—Proof—Costs—Certificate.

Action for improvement of a patent granted 24th Jan., 1878, No. 317, to *Luigi Peroni*, for “improvements in the construction of glass tubes for thermometers, and in the manufacture of thermometers therefrom.” The invention related especially to thermometers for medical purposes, and consisted essentially in forming the glass tube with a bore out of the centre or with a ridge so that the curve of the glass on the side of the spectator acted as a magnifier, and enabled the position of the top of the fine column of mercury to be read off on the scale behind with ease. The specification described this with figures. *Claim*: Making tubing for thermometers, and making thermometers therefrom, the section of which is such that the bore is out of or beyond the mechanical axis or centre of the magnifying curve, so as to cause the bore thereof to appear magnified to a greater degree than is the case with thermometers made of tubing of the section heretofore employed.

The defendant delivered a defence denying the novelty of the

invention, the grant of the patent, the sufficiency of the specification, and infringement. He also alleged variance between the provisional and complete specifications. He delivered particulars of objections, but just before the trial he informed the plaintiff that he should not appear at the trial, but he gave no formal notice of admitting the plaintiff's case or of withdrawing his defence.

KAY, J.—The defendant has put in a defence raising the usual issues. At the last moment he intimated he would not appear. Of course the Court is unable to give judgment for the plaintiff upon a matter of this kind when a defence of that kind has been put in without putting the plaintiff to the proof of his case. Now, the proof of the case is this: in the first place, the specification is brought before me, and it certainly describes what seems to me a very beautiful invention.

His Lordship referred to the specification and said:—Not having heard anything on the other side, I see no reason why that should not be a very good specification. Then the only other point for the plaintiff to prove is the infringement, because the *onus* of proof with regard to want of novelty is altogether on the defendant, and he does not choose to come and prove his case at all. I have it, therefore, proved now that, whereas the thermometers of the plaintiff seem to have the name of *Hicks*, and a reference to the patent upon the back of the white glass which is embodied in the tube, and on which is marked the scale, a witness proves that he went to the place of business of the defendant, and that he there purchased a thermometer which on the face of it has not got the name of the plaintiff upon it, or any allusion to the patent, and which is identical in construction with that of the plaintiff which has been handed up to me. The only difference I can see is, that in the one case the scale is put at the back, and in the other case it is put slightly at the side. Of course that is not an essential difference, and therefore I think the proof which is on the plaintiff of infringement is clearly made out.

KAY, J., refused an application that the costs might be on the higher scale. He further gave a certificate that the plaintiff had proved his particulars, but refused to certify that the validity of the patent had come in question, holding that s. 31 (*supra*, p. 14) only applied where the patent was established in a case contested in Court.

PHILPOTT v. HANBURY.

[1884—5. 2 O. R. 33, 153.]

Utility—Sufficiency—Anticipation.

Action for infringing a patent granted the 10th Sept. 1882, No. 1299, to *W. T. Philpott* for “improvements in apparatus for use in drafting patterns for ladies’ dresses and other garments.” The figures showed and the letterpress of the specification described a scale or chart for use for the purpose indicated.

The defendant raised the usual issues. The trial took place before GROVE, J., without a jury, and he gave judgment for the defendant on all the issues save that of utility.

GROVE, J.—It has been decided over and over again that the slightest amount of utility (I will not say an infinitesimal scintilla but a very slight amount of utility) is sufficient to sustain a patent, and that, for the purpose of utility, as indeed for the purpose of most of the other issues, you must take it by itself. I must suppose that this invention is new, that it is properly specified, and that it is subject-matter of a patent. I must assume all that in deciding the question of utility. Well, assuming those things, I think the patent is useful. I think it gives a useful mode of drawing, or drafting as it is called, patterns by which dresses may be made which fit ladies well (whether any better than every other mode by which a dress may be made or not it is not necessary for me to say), but at all events they are probably cheaper, and some trouble and some measurements are saved. Therefore it is of utility, because I must suppose that it is a useful thing to make ladies’ dresses fit, and this patent will make ladies’ dresses fit (I am not prepared to say better than a first-rate dressmaker might do without it); but at all events better than an ordinary sempstress would do, and therefore, for that purpose, I must discard the other issues, and must assume that the patent in other respects is good; and taking the whole description of the patent, I say that that description does contain a good deal that is useful in the making of dresses. Therefore, my opinion is that upon the question of utility the plaintiff is entitled to succeed.

A patentee, for the purpose of telling the public what his patent prevents their using without his licence for fourteen years, must give the nature of his invention in reasonably accurate language. I do not say he can possibly do it so as to prevent a critic finding some fault with it. Therefore I should read this specification liberally, and I should apply my mind to it in this way: Is this

specification such that a fair man willing or wishing to understand it can reasonably gather from it what the patentee considers his invention and what he says he prohibits the public from using?

2 O. R.
43.

I have said in the course of this case that I am of opinion that a document published in England, whether it be the specification of a foreign patent or of an English patent, or a book, or any other matter which has been proved to be communicated to the public, anticipates a patent, provided it discloses to people skilled in the knowledge of the trade or matter to which the patent refers what the invention is. That is the way I venture to define it. Possibly it may be excepted to. And upon that I venture to say that, in my judgment, those two patents do disclose, certainly taken together, (and I am inclined to think that, taken alone, they each of them do disclose,) the material part of the invention, *i.e.*, sufficiently disclose it to persons skilled in the trade to which this patent relates.

What I am going to say now is an expression of opinion that is rather *obiter*. I rule it as a matter of law, at present, for the purpose of this case. As a matter of fact, my opinion is (but perhaps it is not necessary for me to give it, because I have decided upon the other ground) that there is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there is a distinction; but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication which, when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it perhaps to those in the trade who are most skilled—the higher class of skilled workmen) would enable them to understand it. If it be such, it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description that they cannot, by reasonable application of the mind, find out what it means, it does not anticipate the patent. But if it reasonably discloses what the invention is, so that a person skilled in the trade can practise the invention from it, then I am of opinion that there is anticipation.

Execution was stayed on condition that the plaintiff gave notice

of appeal and set down the appeal for hearing within seven days. On the appeal coming on the plaintiff did not appear, so it was dismissed with costs. 2 O. R.
153.

THE PLATING COMPANY v. FARQUHARSON.

[1879—1883. Not Reported.*]

Infringement—Construction of Patent after Disclaimer.

Action by assignees for infringement of a patent of 28th Oct. 1869, No. 3125, to *W. Brookes* for “improvements in the electro deposition of nickel” (a communication, &c., from *Adams*) in part disclaimed.

All the usual issues were raised by the defence.

Application was made by the plaintiffs for inspection of the defendants’ process. The defendants objected on the ground that their process was a secret one. Thereupon *JESSEL, M.R.*, ordered that *Prof. Denar* be appointed analyst for the purposes therein-after mentioned, and be allowed access to the defendants’ works at all reasonable times on giving two days’ previous notice to see the defendant’s method of making his solutions and the materials used, and also to see the defendants’ method of using their solutions in the process of nickel plating as ordinarily used by them, and also to be allowed to take samples of the solutions, and thereupon to report to the Court upon the facts and his opinions founded upon them; *Prof. Denar* was not to disclose his report on the facts or opinion obtained or arrived at by him without the leave of this Court or the Judge.

Prof. Denar made his report. It was perused by *BACON, V.-C.*, at the trial before him, and by the leading counsel on both sides, who returned it to the Judge. The Judge refused to allow *Prof. Denar* to be called or cross-examined.

BACON, V.-C., gave judgment for the plaintiffs.

The defendants appealed to the Court of Appeal (*Jessel, M.R.*, *Baggallay, Lush, J.J.*), and the only point argued was infringement.

At the date of the patent a well-known process for coating articles with silver was used. A plate of the coating metal, the anode, was connected with the positive pole of a galvanic battery and was placed in a bath filled with a solution of the same metal. The article to be coated, the cathode, was connected with the

* For the notes of this case I am indebted to *T. Aston, Esq., Q.C.*

negative pole and placed in the same bath. By the electric current the anode was decomposed and deposited on the cathode. This method at the date of the patent was not a commercial success with nickel, which was a much harder metal. The patentee believed he had discovered reasons for this, and one reason alleged was that impurities were present in the solution used or found their way into the solution during the operation of coating. One portion of his specification was devoted to a description of the way in which the solution used in some cases of double sulphate of nickel and ammonia should be prepared. Shortly stated the mode of preparation consisted of seven distinct operations. The inventor first took pure nickel, or, if this was not obtainable, commercial nickel purified by a process described. He converted all the pure or purified nickel into sulphate by strong sulphuric acid, and evaporated the solution to dryness. (2.) The mass was then dissolved in water and a small quantity of sulphuric acid was added, and the whole was evaporated to dryness, the temperature being raised to not more than 650° F., at which point it was kept till all sulphuric acid was driven off. (3.) The resulting sulphate of nickel was pulverized, mixed with $\frac{1}{10}$ th by weight of carbonate of ammonia, and then (4.) under temperature 650° F. the carbonate was volatilized, the iron, if any present, being converted into an insoluble salt. The patentee then described processes (5.) and (6.), which related to the preparation of a sulphate of ammonia; and (7.) he mixed the two solutions of sulphate of nickel and sulphate of ammonia, and this was the solution he used for his bath. The specification then described a mode of preparing the anode, and stated precautions the inventor took to carry out a deposition continually on the cathode, and (*inter alia*) to avoid the use of a battery power of more than two Smee cells. As it originally stood the specification had 5 *Claims*. 1. The electro deposition of nickel by means of a solution of the double sulphate of nickel and ammonia or a solution of the double chloride of nickel and ammonium prepared [as above described] and used [for the purposes set forth] in such a manner as to be free from the presence of potash, soda, alumina, lime, or nitric acid, or from any acid or alkaline reaction. 3. The methods herein described for preparing the solution of the double sulphate of nickel and ammonia and the double chloride of nickel and ammonium. 4. The electroplating of metals with a coating of compact, coherent, tenacious, flexible nickel, of sufficient thickness to protect the metal upon which the deposit is made from the action of corrosive agents with

which the article may be brought in contact. 5. The deposition of electrotype plates of nickel to be removed from the surface on which the deposit is made and used separately therefrom.

By the disclaimer the only alteration made in the specification was to add the words in brackets in the first claim and to strike out claims 3, 4, and 5.

The plaintiffs and defendants both bought crystals of double sulphate of nickel and ammonia from one *Elmore*, who gave evidence that they were prepared according to directions in *Brande's Chemistry*, a book published in 1848. *Elmore* took commercial nickel, added to it commercial nitric and sulphuric acid, which dissolved the nickel, and crystals of sulphate of nickel were deposited on cooling. No external heat was applied, though some was generated by the chemical action. He then added to these crystals an equal amount by weight of common sulphate of ammonia, dissolved the two in water, and boiled. On cooling, crystals of double sulphate of nickel and ammonia are deposited: if the salt is very acid it would be recrystallized in order to make it neutral. The defendants used these crystals for their solution, and also used a dynamo-electric machine producing a current many times stronger than two Smee batteries.

The Court of Appeal entered judgment for the defendants on the ground that there was no evidence of infringement.

JESSEL, M.R.—I cannot say that in arriving at a different result from that arrived at by the learned V.-C., I am differing from him in opinion, because I find from his judgment which is before me that he was under the misapprehension that the infringement was not disputed. What, in fact, the defendants say is that the plaintiffs no longer use the patent, but they do adopt the same process which the defendants allege was a known process.

Now on the question of infringement I may say a word or two about the evidence. Although we have heard a good deal of argument about commercial and pure nickel, the evidence is singularly meagre. It would appear from the original patent that it was taken out by an American residing at Boston, in Massachusetts. It is a communication, as we say in England. Therefore, when we talk of commercial nickel, I suppose we must talk of that which was known to him; and there is no evidence in this case as to what was commercial nickel in the United States at the time of this patent, nor is there any distinct evidence as to what commercial nickel was in this country at the date of this patent, neither one way or the other. How pure it was, or how

impure it was in this country there is no evidence to show. I should guess from the statements in the patent, that the commercial nickel known to the inventor was generally impure, but I only guess that from the statements in the patent itself. *Adams* says this about it, which, as I said before, only refers to that which was known to him. Whether he knew anything about commercial nickel in Europe, or whether his knowledge was or was not limited to commercial nickel in the United States, or a portion of the United States, I do not know, but he does say in his communication this:—"Commercial nickel almost always contains more or less of the re-agents employed in the purification or manufacture of the metal." Then he names them. He uses the words "almost always" and "more or less," but he does speak of preferring to use pure nickel, from which I should guess (I am guessing again), that he could buy pure nickel, but as a general rule the commercial nickel contained more or less of these adulterations or additional ingredients. As I said before, we have no evidence.

The suggestion was made in argument that the commercial nickel which *Elmore* bought was a much better article in the year 1878 or 1879 than it was in 1869. That may be so, but if it is so it should have been proved in evidence. It is quite compatible with the evidence before us, that there was no substantive difference in the average quality of commercial nickel in England in 1869 and 1879. I mention this because it is material in one aspect of the case, although I must say I should have arrived at the same conclusion as I have arrived at, even if there had been evidence to show that the quality of the commercial nickel had improved since the date of the patent.

What is the patent for? There has been a disclaimer, but we are entitled to look at the original patent as well as the disclaimer, in accordance with the decision of the House of Lords, in order to find out its meaning. I think I should have arrived at the same conclusion without looking at the original patent as to the construction of the patent as amended. His Lordship referred to the specification and continued:—"What he is going to tell us is this—first of all, what caused the mischief; next, how to remove the mischief; and thirdly, what additional precautions you must take in order to prevent the recurrence of that or a similar mischief. Then he follows by a claim which I must say (quite independently of the disclaimer, although that fortifies my conclusion), appears to me to be plain enough. The only part

which is said to be infringed by the appellants, is the first, and therefore I will confine myself to reading so much of the first claim as is alleged to have been infringed.

His Lordship read Claim 1.—Consequently we have these things: first of all the word “prepared” refers to the antecedent solution. Therefore we have a solution prepared. It is to be prepared “as above described.” I have no doubt what the words mean, they mean “as above described.” I have been referred to cases in which, under what is sometimes called a benevolent interpretation or otherwise, those words have been held not to restrict some other words used before. All I can say is that every case of construction must depend upon itself; and here I cannot refer them to anything else, without, in my opinion, utterly destroying the patent. I must observe that these words were introduced: originally they were not there, it was only “prepared.” The words “as above described” were introduced there for the very purpose of limiting it; and, as I said before, we are entitled to look at the prior claim for the purpose of construction. It confirms the construction I should have arrived at independently. Therefore, it must be prepared “as above described.” Now is the solution of the double sulphate of nickel and ammonia used by the defendants and by the plaintiffs also (they buy generally of the same manufacturer, *Elmore*)—is it or is it not prepared as above described? Then is it also part of the rest of combination?

Now, in order to show what he means by “prepared as above described,” one must read about half a page of it.

His Lordship referred to a passage in the specification ending, “In preparing this solution the inventor prefers to use pure nickel, but commercial nickel may be used.” Now I pause there for a moment. It is obvious to me that the inventor could get pure nickel. He does not make, and he does not say, that he makes it, because when he makes it from commercial nickel he tells you he is going to make it from commercial nickel. He is evidently, therefore, referring to an existing article. Therefore, to this extent also, I adopt the argument of the respondents that in using the words “pure nickel” he did not mean chemically pure in the sense that there was not a trace of something or other to be found in it; but he meant that which was usually called a pure metal, which is, as we know, a metal containing a very high percentage indeed, differing with the nature of the metal described. I am by no means prepared to say that a metal containing 95, 96, 97, or 98 per cent. of pure metal might not be called fairly

pure nickel. Then he talks of commercial nickel. There is no evidence to show what it was, but it is plain what he called commercial nickel was something that almost always contained "more or less." Although he says "more or less," which is indefinite, I think he must be taken to mean a substantial quantity. "More or less" means a substantial quantity of these impure and noxious substances. That is the fair meaning of it. Then he tells us how to get rid of them.

His Lordship referred to the specification and continued:— That is how he makes the solution, and how he tells you in the first part of the specification that it is necessary to make it in order to secure the end. Now, as to *Elmore's* process, which is that which produces the solution or rather the crystal from which the solution is produced by the defendants, it is not that process. Then, in addition to that, there are a great number of precautions used. As regards these precautions the defendants deny they use them at all. It is a matter on which the evidence has not been minutely examined. I only mention it because this at all events is clear, that both parties now use a subsequent invention, namely, the dynamo-electro-machine, for producing these results. It does not appear to me that, when you have a different machine used in a different way, the precautions wanted to be used in the former machine are necessarily wanted for the latter machine; and it does not at all follow, that, because a man says you must use certain precautions in a certain way with a certain machine, that if you use another you require the same precautions, or even similar precautions. It is not at all the point upon which I am founding my judgment, finally, because, as I said before, the evidence on this part of this case has not been gone into minutely, and it is possible I might have been persuaded that although the result was arrived at by a different machine, with a different intensity, and, as far as I can see, with a different solution, yet that the precautions actually adopted were those pointed out by the patentee, and the result would not have been obtained without the use of the precautions. All I can say on the first view of it is, that it does appear to me it would be difficult to maintain that the use of a totally different machine under the circumstances I have mentioned can be considered to be an infringement of the use of the other machine, with the precautions which have been pointed out by the patentee.

Now, to return to what is really the main point in the case.

If the defendants do not use the combination, and if the combination is claimed, there is no infringement. It is not one of those cases in which even substantial user of the combination is to be complained of because it is the whole thing. A man tells you it is necessary in order to prepare this solution in such a manner as to give the result of each to adopt those precautions, and use these means. He tells you the whole is necessary, and therefore, it is not a case in which you can say you can dispense with three-fourths of them. You must take the patent as the patentee has informed the public what it means, and if it turns out that three processes out of four were unnecessary, and one only would do, that is not covered by the patent. I think it goes further. I think even as regards the first process, there is no evidence of infringement, taking it alone. The first process is the production of what I call the crystal. This double sulphate of nickel and ammonia. Now it was argued on the part of the respondent, that what the patent said was this, if you take anything but pure nickel, either directly, if I may so say, or by purifying commercial nickel, you will not produce your result at all, and therefore, what I claim is to make my crystal or sulphate of nickel and ammonia, with pure nickel plus the acid, and so on. But does the patentee say so? Is it not only this—"I prefer pure nickel, that will certainly do. I may take commercial nickel, but then I must purify it;" distinguishing between what he calls pure nickel and commercial nickel. But the defendants say we use commercial nickel, and if it is true that the commercial nickel in England was pure enough at the date of the patent to produce the result, they do not want even the process of the patentee for the first portion of his process at all. It may be that he may be right, that the commercial nickel in use in America, or the one that he was acquainted with would have been pure enough without his process; but if in England it was pure enough without his process (and as I said before, there is no evidence to the contrary) his process was not wanted, and the result is that they used commercial nickel without purification at all and produced the result.

It does appear to me in this state of the evidence, that we cannot possibly say that a man who has not purified his nickel, but has bought it in the market as ordinary commercial nickel, and found it will produce sufficiently pure crystals for the purpose is infringing the plaintiffs' patent, the plaintiffs simply saying that you must use pure nickel or commercial nickel purified in a particular way.

This appears to me to entirely dispose of the whole case brought forward by the plaintiffs, but I must say a word or two as to the processes used, and the argument as to the identity of results. It is plain from the evidence in this case that somebody or other could plate nickel before this patent. It is not only so described in Brande's book, but there was a plate produced with a thin film it may be said, but there it is. It is plated, and if we say that every mode of using pure nickel to produce this result is within the patent, it may turn out that we shall invalidate the patent, and by adopting that very large view it may, in fact, entitle the defendants to succeed on the ground of the want of novelty. It is quite plain, to my mind, that the persons who filed the disclaimer had that difficulty before their eyes, and wished and desired to restrict the patent within limits, so as to be able to support it on the ground of novelty. I think it would be allowing a license to patentees to change front, if I may say so, in these cases, which they are very apt to do. When they are arguing for novelty they say, "now read our patent in a benevolent way, so that it may not be supposed that we claim that which was common knowledge." Then we should have this argument (and I have heard it frequently used in patent cases) "How can you suppose a patentee would claim that which is so well known? It is not fair to read a patent in that way, you must consider what is well known common knowledge, and restrict the patent accordingly." When the patentee comes for infringement, he may have abandoned the patented process and have adopted entirely a new one, and then he turns round and says all that has been done is a mere improvement on my process. I have told you my idea, and one method of doing it. Protect me in every possible mode, and say that everything done, whether pointed out by me or not, which in any shape or way attains the same end is an infringement of my patent. That is not fair to the public.

LUSH, L.J., referred to the 1st claim and said: The words are "prepared as above described." I confess I am unable to follow the arguments which have been addressed to us to show that those words "as above described" mean something else than what to my mind they plainly import. The man has been describing the mode of purifying the solutions, and then he says, "I claim the mode of purifying as above described." What is that but by adopting as part of his claim, the very description which he has given of the mode by which he proposes to purify his solution. It is impossible, to my mind, to put any other meaning upon

those words. What object could there be in putting them in if it had not been so? As he had got them before he claimed (what he found out afterwards was too much) the use of the purified solution however purified, and now he cuts it down to the mode of purification, "as above described." Now that mode is by heating it up to a very high degree of heat three times following—three successive stages. The defendant uses no heat at all, he lets the solution which he buys, remain until it deposits crystals, and those crystals turn out to be of sufficient purity for the purpose. How can it be said, therefore, that he purifies his solution in the manner described in the specification, namely, by heating it three times over up to a temperature of 650° F.

Appeal to the House of Lords.

Appeal dismissed.

SELBORNE, L. C.—It is unquestionable that if the patent containing these claims were good in law, and if there had been no disclaimer, the first, fourth, and fifth claims would have been infringed by what the respondents have done, for they have employed for the electro-deposition of nickel a solution of the double sulphate of nickel and ammonia, prepared and used in such a manner as to be free for all practical purposes from potash, &c., and they have obtained deposited products, having such qualities as were mentioned in the fourth and fifth claims. But by the disclaimer, the third, fourth, and fifth claims have been struck out, and the first claim has been altered so as to be now limited to the electro-deposition of nickel by means of solutions "prepared as above" (*i.e.*, in the body of the specification), "described" and which (being so prepared), are "used for the purposes above set forth in such a manner as to be free from" the foreign substances mentioned or any acid or alkaline reaction. The attempt on the part of the appellants has really been to retract the disclaimer and alteration, so far as relates to the first claim, and to contend that the introduction of the words "prepared as above described" has not at all limited the previous latitude and generality of the claim, and that every use for the purpose in question of any solution of the double sulphate of nickel and ammonia, however prepared, is an infringement if only it is free from the presence of potash, &c., and from any acid or alkaline reaction. Their witness *Gore* expressly stated that he considered the essence of the patent to be "the exclusion of certain impurities from the solution in order that a good deposit might be obtained;" "the preparation of a compound properly described

as double sulphate of ammonia free from those impurities," "the production of such a pure substance, *by any means.*" This, however, is a question of construction; and it is not in my view either doubtful or difficult. A patentee who disclaims cannot be permitted to play fast and loose with the public. If he alters the terms of a claim originally wide and general, by inserting limiting words, he must be bound by the limitation which he has so designedly introduced. He must be presumed to have made the change because he knew or at least was apprehensive, that the claim in its original latitude, might not be tenable in law, and whether this be really so or not he has irrevocably relinquished in favour of the public, so much of the original claim as was in excess of the limits within which it has been reduced by the disclaimer. The effect of the disclaimer and alteration in the present case was (in my opinion) to leave the respondents at liberty to conduct the electro-deposition of nickel by means of a solution of the double sulphate of nickel and ammonia prepared and used in such a manner as to be free from the presence of potash, &c.; so long as that solution was prepared in a manner substantially in accordance with the specification.

I agree with the Court of Appeal in considering that the respondent's solution is in fact prepared in a manner substantially different from the method described in the specification. * * * *

It is impossible, in my opinion, for the appellants since their disclaimer to claim the mere quality of purity in the native metal in the state in which it now constitutes an article of commerce as in itself covered by their patent, if the solution is prepared in a different way from theirs.

It appears that while the respondent's solution is made from crystallized salts by two perfectly simple operations (the second to be repeated if the salt is very acid after the first crystallizing), the method of preparing the patentees' solution, described in the specification, requires seven distinct operations; of which the first three (which are apparently the most important) are entirely occupied in the preparation of a dry anhydrous sulphate of nickel (without the use of nitric acid) by an elaborate process requiring the application of regulated heat, in a manner wholly different from that in which the respondent's crystallized sulphate of nickel is obtained; and the purpose of these successive operations is to eliminate in that stage those impurities, which by the respondent's method are thrown off into the mother liquor when the double sulphate crystallizes, after the two mixed sulphates have been

dissolved and boiled. These differences are the more important when it is borne in mind that the use for the electro-deposition of nickel, of the double sulphate of nickel and ammonia, and also of the double chloride of nickel and ammonium was confessedly not new, and that all which the patentee professed to do was "to adopt processes in the preparation" of the solutions and to "observe precautions" which might obviate the defects of the previous modes of preparing them and get rid of the impurities, which those previous modes of preparation had failed to remove.

The result is that there is in my judgment no infringement of the patent as limited by the disclaimer. The products of deposition are not patented. The particular solutions are not patented. The salts dissolved in them are not patented. The application of salts of the same qualities and character of the electro-deposition of nickel is not patented. The principle of getting rid of the impurities is not patented, nothing is in fact patented but the one particular method described in the specification of preparing the solutions of the double sulphate either of nickel and ammonia or of nickel and ammonium which the appellants, or Brookes originally used (but do not apparently now use) and the solution used by the respondents is prepared in a substantially different way.

LORD WATSON.—I shall not go into the various steps of that process. I shall only observe that the agency of heat which is employed at three different stages of the process by the patentee is manifestly on the face of the patent one of its most prominent characteristics. After describing the process in detail, he states that the object of employing heat, "of evaporating to dryness and raising the temperature is in the first place to drive off the excess of sulphuric acid, and secondly, to convert the sulphate of iron, if it exists, into basic sulphate which is quite insoluble in water." The heat so applied performs a double function; the one (the driving off of the sulphuric acid) necessary in all cases, the other (the conversion of the sulphate of iron into basic sulphate) being only necessary where the pure nickel used in the preparation still contains a trace of iron in its composition.

Now, my Lords, it is material to observe that the patentee in the passages to which I have referred in his specification describes two totally different things—the one is a description of the general character of the solution which he desires to employ, the other is a description, not general of a solution, but of the preparation of a solution, and it is the only description in this specification of the

patent of any method by which that solution can be prepared. Turning then to the first claim, I find that as it originally stood it was—(His Lordship read it). That was plainly a claim for any solution or every condition which was free from these impurities named, however prepared, so long as it was used; because this claim only patents it as part of a process of electro-deposition of nickel. But the mode of preparation was of no consequence according to the original form of the claim; it covered every solution of the general character which the specification of the patent describes without reference to the means by which it was produced.

But the patentee has disclaimed; he has amended and limited his specification. He has not, as is sometimes done by patentees who desire to limit their claims, struck out any part of the specification. The information which he has given to the public of the extent to which he desires to restrict his claim, and the extent to which the public are to be entitled to use the invention as originally claimed, is only known through the medium of the claims. The alteration which is made for the purpose of limitation upon this first claim consists in the introduction of the words “as above described” after the word “prepared.” Now, my Lords, to read the amended and limited claim in the manner contended for by the appellants is simply to give it the same meaning that it had as it originally stood. It is necessary (and so far I agree with the argument of the appellants) to read this claim in the light of the specification, it is unintelligible without reference to the specification. But the words which were introduced upon disclaimer are words which plainly refer not to the general description of the solution employed, but to the particular preparation and method of preparation which the specification describes, and it limits the claim of the patentee as in question with the public to an exclusive right to solutions of the character which he describes so long as they are prepared according to that method, and entitles the public to use solutions of the same character provided always that they are not prepared according to that particular method, or in any method substantially the same.

That brings us to the simple question whether the solution of the sulphates of nickel and of ammonia used in the preparation of the solution employed by the respondents is prepared in the same manner, or substantially in the same manner, as the solution which is prepared according to the method described. I am not going to enter into a minute comparison of these. It struck me as a very remarkable fact when we were listening to the evidence

that whilst the witnesses say that the solutions are practically the same, I do not think that any witness says "I have compared the two processes according to which the solutions are made, namely, the preparation of the patentee and the method followed by *Elmore*, and I find these two to be alike." We have it merely upon the assertion of the appellants; we are left to compare the two processes for ourselves, and on comparing them I have no hesitation in coming to the same result as that at which the L. C. has arrived. I shall only say this of it, the one process is exceedingly elaborate, and consists in the application of external heat, regulated at three different stages. The other process is exceedingly simple, and dispenses altogether with the use of heat as an agent.

LORD FITZGERALD.—It struck me as one of the singular features of the case that the plaintiffs seem to have abandoned their own patent. They have ceased to prepare the double sulphate according to the process described in the specification, and they purchase the article manufactured by *Elmore* according to his process. They have also departed from the precaution recommended against the use of a battery of too high an intensity; they use the more recently invented dynamo-electric machine which, as regards intensity, seems from the evidence to have twelve times the power of two *Smee* cells. The defendants also use the double sulphate manufactured by *Elmore* and a dynamo-electric machine.

POOLEY v. POINTON.

[1884-5. 2 O. R. 167.]

Anticipation by useless machine—Costs.

Action for infringement of a patent granted 7th July, 1874, No. 2387, to *J. C. Pooley*, "for improvements in the manufacture of bread."

The plaintiff moved for an interlocutory injunction, and for an order to inspect the process of manufacture carried on by the defendant; whereupon defendant's counsel gave an undertaking to keep an account until the hearing; and the Court ordered inspection. Costs of motion to stand to the trial of the action, the action to be tried without pleadings and on affidavit evidence. The defendant was to deliver, however, particulars of objections. These when delivered denied—(1) infringement; (2) that the plaintiff was the inventor; (3) novelty; (4) that the invention was subject matter; (5) sufficiency of specification; and alleged

(6) prior publication by a specification of *De Changy*, 1859, No. 2775.

2 O. R.
169.

PEARSON, J.—I have no doubt that the issue of infringement must be found in favour of the plaintiff. I say the issue of infringement, for this reason,—because, whether the patent be bad or not, the Court of Appeal (p. 39) have lately decided (and I am glad they have been able to come to that decision) that although the patent of the plaintiff may be absolutely bad, and may be no patent at all, nevertheless if the defendant chooses to deny the infringement of the patent, assuming the patent to be good, and puts the plaintiff to the expense of meeting that issue, infringement or no infringement, even if the plaintiff fails in the main subject of the suit by reason of his patent not being a good patent, he is nevertheless entitled as against the defendant to costs of the issue in respect of the infringement.

2 O. R.
170.

De Changy's specification contains a description of what he himself calls apparatus—a large quantity of apparatus—by means of which his process is to be effectually performed; and I have no doubt whatever that it was the curious and superfluous amount of apparatus that he patented which stood in the way of his process obtaining currency in this country. Nevertheless, even according to the witnesses of the plaintiff, *De Changy* had arrived at that which was the principle, if I may say so, of *Pooley's* patent. * * * It may be said that was much, as his apparatus was so costly apparently, and so cumbersome, that it prevented the use of his process, that he had described no way by which that process could be effectually used, and that accordingly his patent must be considered as a dead letter, and did not stand in the way of any person who should take out a patent for a similar principle, showing the process easy and without cost, by which that process could be used every day in the week.

The learned Judge then discussed the evidence and concluded: Without, therefore, determining that he (*Pooley*) was so absolutely anticipated by *De Changy* that I could on that ground say that the patent is bad, I certainly do come, entertaining in my own mind very considerable doubt as to whether I should not be right in saying that *De Changy* had anticipated him entirely, at all events to this conclusion that his specification is bad.

His Lordship gave the plaintiff the costs of the issues raised by Nos. 1 and 2 of the particulars, and the defendants the costs of those raised by Nos. 3, 5, and 6, refusing to give any certificate as to No. 4.

READ v. ANDREW.

[1885. 2 O. R. 119.]

Interlocutory Injunction.

Action by assignees for infringement of a patent granted 13th Dec., 1871, No. 3377, for "improvements in employing certain preparations of indigo in printing and dyeing." The plaintiffs moved for an interlocutory injunction.

It appeared on the plaintiffs' affidavits that the defendant company had taken over a business of *John Andrew & Company*, who were supplied by the plaintiffs with the patented preparations in 1873, and had used these preparations since that date.

Injunction granted.

BACON, V.-C.—The suggestion that the application is defective because the plaintiff has not alleged that his patent has never been disputed, I cannot listen to or entertain. In this case the allegation of the plaintiffs is that their patent has always been considered valuable and practised as a valuable patent. I am told that the effect of granting the injunction would be to suspend the trade. It will have no such effect. The trade may be carried on to exactly the same extent as persons think fit to carry on their trade. They are only restrained from invading the property of the plaintiffs. Then the patent is impeached. The solicitor for the defendants says that he "has been informed and believes that it is not a good patent." Who informed him, or why he believes it, I have no means of knowing; and one of the defendants, who has made an affidavit, says he is also informed and believes that it is not a good patent. I can give no effect to such assertions as those in opposition to the plain, distinct, clear evidence of the plaintiffs, and the plain facts. The offer to keep an account is, of course, wholly insufficient to meet the case, and it is wholly unsatisfactory to me. The parties cannot go on doing such work, as it is of great injury to the plaintiffs. There is no analogy to the cases in the books where the undertaking to keep an account might be of some service. The costs will be costs in the action.

REYNOLDS v. AMOS.

[1886. 3 O. R. 215.]

Subject matter of a patent—Infringement.

Action for infringement of a patent granted the 11th Feb., 1884, No. 3104 to *Cory and Others* for "improved appliances to be

used in the manufacture of ensilage." The object of the invention was to compress the fodder when in the silo or pit which had been done previous to the patent by placing dead weight on the top: but the trouble of raising the quantity of dead weight to the top of the mass was a serious objection to this method. The specification described a method of compression by means of chains, and the specification stated: "We employ chains, which may be either drawn together over the crop to be compressed by any suitable tightening apparatus, or may serve as the point of resistance for screw or hydraulic jacks or presses or for levers to effect the compressing. The chains which we prefer to use are open link, ladder and similar chains, and a suitable number of these chains, according to the size of the pit we arrange at regular distances apart on opposite sides of the silo or pit, and secure by one end to the foot of the walls, or in any other convenient position by means of bolts or other fastenings. Continuous chains may be used passing under the ensilage. In the accompanying drawings we have shown various plans in which the chains may be employed either as the means for effecting the compression or as representing the point of resistance for suitable compressing apparatus. The drawings showed the crop in the silo covered in the usual way by boards, and above the boards cross-beams D one for each pair of chains. The beams had notches at their ends to permit the passage of the chains, and carried pulleys one at each notch over which the chains ran. The two chains nearly meeting above the middle of the beams were united by an ordinary chain stretcher, and when links of the chains were brought over one another a pin was put through and the stretcher used to tighten up other chains. At any time when the chains became loose by shrinkage of crop or otherwise, they could be tightened in the same manner.

Claims 1. In the manufacture of ensilage in pits or in the open, the use of chains by the aid of which leverage is obtained for compressing fodder, and compressed fodder is retained in the compressed state as above described. 6. In the manufacture of ensilage the combination of chains and cross-beams D, with means for anchoring or securing the chains after the pressure has been applied substantially as described.

The defendants denied that they had infringed or that the invention was subject-matter of a patent.

Judgment for the plaintiffs.

BACON, V.-C.—There is not an attempt to say that before this invention of the plaintiffs' anybody had ever dreamed of such a

mode of dealing with fodder. Nobody has been heard to say that the manner in which the plaintiffs proposed to deal with it is not perfectly effectual. Its novelty is established beyond all doubt; its utility is proved, among many other things, by the defendants themselves, who have adopted it; that it is cheaper the evidence enables me to say. So that if I take what are upon authority the unquestionable requisites necessary to sustain a patent, I find that it is new, for it never was used before; I find that it is better than any other, and that it is, beyond all question, very much cheaper.

Now, are those requisites enough to maintain a patent? The cases put that beyond all question. If those requisites exist, then a patent may be established upon them. There is no novelty in a chain; there is no novelty in pinning a chain so that it cannot shift its position; there is no novelty in shortening the chain by means of a pin, but the man who invented this mode of dealing with the chain for the purpose of manufacturing ensilage says that he is entitled to a patent, and I have not heard a word of argument or of authority that should induce me to doubt that that is the plain law on the subject. His Lordship read from *Hayward v. Hamilton*, the remark of BRAMWELL, L.J. (*supra*, p. 117), "It is very strange if it is no invention that it has never been done before," and said: This observation applies in its full force to the case of the defendants, who being interested in the manufacture of ensilage, having tried their best to do it, and tried in various ways, by dead weight and otherwise, it never occurred to them that by using the old well known flexible and applicable material called a chain, it could be so dealt with—so combined—as to produce that very result which they had in vain attempted to arrive at by all the contrivances that they knew of before.

No doubt a chain is as old as the world and pins to hold the chain; but there never was until the plaintiffs filed their specification and produced their invention, any use of chains adapted as these are to the material to be manufactured by means of the chains. Because the defendants have been so ingenious as to dispense with the cross beams by putting a piece of iron capable of resisting the passing of the chain over it, or any other resistance it may afford, and have applied the plaintiffs' invention to the side of the stack instead of using it at the top as the plaintiffs do. This can be no distinction and can be no difference. It is a plain and distinct infringement.

RUSSELL v. HATFIELD.

[1885. 2 O. R. 144.]

Particulars of Breaches.

Action for infringement of a patent granted 29th Jan., 1877, No. 378, to *D. Russell*, for "ramps for use on railways." The specification was very short. The particulars of breaches stated:—The defendant has made, used, offered for sale, and sold portable ramps made after the invention described in the specification of the letters patent, in the statement of claim mentioned. The plaintiff believes and alleges that since the 1st day of Jan., 1882, the defendant has made a number of such ramps at his works at Attercliffe, in the county of York, and has sold some to the Great Northern Railway Company and to other persons. But the plaintiff is unable to give further particulars of such manufacture or sales until he shall have obtained the necessary information by discovery and inspection.

The defendant took out a summons, on which the Chief Clerk made an order for better particulars of breaches on which the plaintiff intends to rely, specifying by reference to the pages and lines the parts of the plaintiff's specification in respect of which such alleged breaches have been committed, and the names of the persons to whom infringing goods have been sold, as alleged in the particulars of breaches, together with the dates of the breaches alleged.

On appeal PEARSON, J., said that as the defendant had full knowledge of all his own sales, the application should stand over until after he had given the plaintiff discovery.

Attention was then called to the fact that the plaintiff had not yet applied for discovery; but the Judge said:—I think the right course at the present moment would be, looking to the particulars the plaintiff has given to the defendant, to alter the Chief Clerk's order by saying that at the present moment the plaintiff need not give the defendant any further particulars, but to leave the defendant at liberty to apply again at a later stage of the action without being prejudiced in any way, by no order for further particulars being made now. Costs to be costs in the action.

SHARP v. BRAUER.

[1885—6. 3 O. R. 193.]

Subject-matter—Threats.

In *July*, 1885, *S. H. Sharp*, to whom a patent had, on 18th *June*, 1879, No. 2408, been granted, for “a new or improved window screen or blind,” issued circulars to the public calling attention to his patent, and stating that he would take proceedings against persons selling folded screens except such as supplied by him. One *Brauer*, a manufacturer of folding screens in Germany, who sold such screens through *Nixon*, his agent in London, found that such circulars had reached his customers, and thereupon *Nixon* and *Brauer* commenced an action against *Sharp*, asking for an injunction to restrain such circulars and for damages. A motion was made for an interlocutory injunction, which stood over, *Sharp* undertaking to bring this action against *Brauer* and *Nixon* for infringement and to prosecute it with diligence, the two actions to come on together, which they did on 20th *May*, 1886, before BACON, V.-C. The specification of *Sharp* was put in evidence, and consisted merely of a method of applying ordinary folding screens of cardboard, tin, zinc, or other suitable material to act as window blinds.

Claim: The construction of window blinds composed of the materials and constructed in the manner substantially as herein described and illustrated.

The action for infringement was dismissed.

BACON, V.-C.—It is the very essence, according to my notion of the law, of the right to sustain a patent that it must contain an invention. That has been carried very far in the ensilage case (*Reynolds v. Amos, supra*). The ground upon which I decided the ensilage case was that there was a clear invention—the invention of a manufacture by the application of the chains which were resorted to in that case. That which nobody had ever done before was at once suddenly accomplished successfully, and I thought the mode of tying up the bundles of ensilage by means of chains properly applied, easily adjustable, and tightened and relaxed as the manufacture required, was enough to support a patent; and so I think still that it was. Here nothing is invented. I may buy, it cannot be disputed, a screen at any shop I like and of any kind I like, but if I take it and apply it to my own parlour window, then I infringe the plaintiff’s alleged rights; because it

is the application, and the application only, that he specifies as his invention and that he claims.

The action to restrain the circulars was also dismissed.

BACON, V.-C.—There is no suggestion of bad faith, and no reason to suppose there was anything like bad faith in any one of the assertions contained in the circular. Malice is out of the question. There is not a particle of malice to be imputed to the defendant *Sharp*. He has been in the enjoyment of a patent for all these years which *prima facie* was valid; and when, in June, 1885, he found that some persons were interfering with that right which he had exercised—a right not till then disputed—he issued the circular. It is said, that from that you can infer malice. There is no evidence that any such circular was addressed to the plaintiff *Brauer*. There is no evidence whatever that by any communications between the defendant and *Brauer* there was any threat. All that relates to that part of the subject, if it does relate to it at all, is, that *Nixon* offered to be agent for *Sharp*, and *Sharp* repudiated the notion of having any agent. He chose to carry on his own business himself, which he had a right to do. The question of malice is, therefore, wholly out of the case.

To ask for an injunction to restrain him now, after what has taken place, from publishing that circular, is an idle request, because not only has he not (and this is not disputed) issued any circular since the action arose for the injunction, but it would be out of the question to suppose that I should grant an injunction to restrain him from doing a thing which is manifestly just. He had a right to advertise himself as patentee; but if he does so again he must take the consequences. One of the consequences is not that I should now grant an injunction. Upon the question of damages, the case is covered over and over again by decisions. Unless there is plain evidence of malice, in the plain common vernacular meaning of the word malice, there is no cause of action. Here, in very explicit terms, very pointedly, the imputation of malice is brought against the defendant, and it wholly fails of proof. The last case referred to (*Sugg v. Bray, infra*), seems to me by no means the least valuable of all those which have been introduced in the course of the argument.

His Lordship did not, in his judgment, advert to s. 32 (*supra*, p. 14).

SINGER v. STASSEN.

[1883—4. 50 L. T. 326 ; 1 O. R. 121.]

Amendment under s. 19—Terms.

Action commenced in the Q. B. D., 15th Oct., 1883, for the infringement of a patent.

After particulars of objections were delivered the plaintiff asked for liberty to apply for leave to disclaim, and the Master and Judge in Chambers gave them liberty.

On appeal to the Divisional Court (Day and Smith, JJ.), appeal dismissed, the plaintiff to pay costs occasioned by amendment, and if 14 days after notice of amendment defendant abandoned his defence he was to have the costs of the action save those of the appeal to the Divisional Court. 50 L. T.
326.

Appeal to the Court of Appeal (Brett, M.R., Bowen, Fry, L.JJ.). Order varied; costs to abide event.

BRETT, M.R.—In my opinion the 113th section does not prevent the affirmative effect of the power given to the Court by s. 19, now that section is put in by way of proviso and mitigation of the general words of s. 18 (10), and if so, it applies to the same action, and applies equally whether the action was or was not begun before the 1st Jan. I think, subject to certain terms, the plaintiff should be allowed to apply to amend his specification by way of disclaimer. I cannot help thinking that is a just decision, because, if he cannot apply, then as long as this action continues other people may be doing acts which, in a similar way, it may be impossible for the plaintiff to effectually overcome between this time and the time when this action ends. Supposing that the action, by reason of the amount of business in Court, could not be tried and could not be concluded for a very long time, it would leave the plaintiff without the protection that I should think this statute was meant to give. Therefore, I should think he ought to be allowed to apply to the Patent Office. It seems to me that we ought not, in justice, to allow the plaintiff to amend his specification by disclaimer, and then to go on in the trial of this action just as if his specification had never wanted amendment at all. I think that would not be just. Therefore, supposing that s. 113, without terms, would not protect the defendants, we think terms ought to be imposed which will protect them. The terms which we think are sufficient are these: that the plaintiff be at liberty to apply at the Patent Office for leave to amend his specification by

way of disclaimer on the terms that the costs of and occasioned by such amendment of the plaintiff's specification should be the defendant's in any event. But then we think that justice requires that there should be this further term put upon the plaintiff, and that is, that no such disclaimer (that is, the specification as amended by the disclaimer) shall be receivable in evidence in this action. We are of opinion, at least, I am, that we have a right to act under s. 19, and that if we have the right to act under s. 19, we have a right to impose these terms.

BOWEN, L.J.—The result of the whole is this:—Old patent rights and old patent liabilities are affected by the substantial legislation which the statute contains; but the express repeal of the old law contained in s. 113 is not to affect them. Accordingly there is no reason why s. 19 should not apply to old patents and old patent rights. They will be still protected by the keeping in force for their benefit of any of the old enactments which are required to safeguard vested rights or interests to the extent to which s. 113 means it to apply. There is nothing in s. 113, therefore, which prevents s. 19 applying to old patents and old patent rights. Does it do so? That drives us back to the question, does s. 18 apply to old patent rights? There seems to me to be nothing at all in s. 18 to lead one to suppose that it is not intended that an old patentee should have the benefit of that section. Then we come to sub-s. 10 of s. 18, which prevents an application for an amendment being made under s. 18 in the simple case where an action is pending. That would in the present instance prevent the patentee from having the benefit of s. 18 so long as the action was pending. But if we read that sub-s. 10 as applying to an existing action like the present, then it seems to me we are driven by force of logic, as FRY, L.J., pointed out during the argument, to hold also that s. 19 applies to an existing action; and the result is that ss. 18, 19, and 20 all apply to existing patents and to existing actions; though with regard to all existing rights there is the corresponding protection—it may be a correlative protection—afforded by s. 113.

We simply do this. We prevent what is being done under our order from abridging the rights of the defendants in the pending litigation; and, so far as we can, we keep the parties in a just and fair position for litigating the question which they meant to litigate before the Act came into operation.

SOCIÉTÉ ANONYME DE GLACES v. TILGHMAN'S SAND BLAST
COMPANY.

[1883. 25 Ch. D. 1 ; 53 L. J. Ch. 1.]

The defendants were owners of a patent granted the 1st Aug. 1870, No. 2147, to *A. V. Newton*, for "improvements in pulverising stone." There was a Belgian patent for the same invention, and the defendants had the right to grant licenses to use the Belgian patent. They granted such a license to the plaintiffs, but did not in terms grant a right to them to sell articles manufactured in Belgium under such license in England, and the defendants in point of fact issued circulars stating that the sale in England of articles so manufactured was an infringement of their English patent, and warning the public against buying such articles.

This action was brought to restrain these circulars, and on 31st May, 1883, PEARSON, J., refused to grant an interlocutory injunction. The plaintiffs appealed, and the Court of Appeal (Cotton, Lindley, L.JJ.), dismissed the appeal.

COTTON, L.J.—It is contended that although there is not in express terms in this license any grant of a right to sell these things in England, yet it is necessarily implied, and it is a right which is necessarily carried to the plaintiffs by the grant of the license that the defendants have made to them. * * * It is the consequence of their being in Belgium lawful manufacturers and lawful owners of these goods and incident to that ownership that they can sell anywhere where the law of the country does not prevent them selling. But there is no grant there of a right to sell in England; * * * the mere fact that the grantors of the license had a monopoly in England would not, in my opinion, import as a matter of construction into this instrument the grant of a right to interfere with that monopoly when there is no express grant of a right to sell in England. 25 Ch. D.
7.

Referring to *Betts v. Willmott* (Vol. i. p. 61) his Lordship said :—When an article is sold without any restriction on the buyer whether it is manufactured under one or the other patent, that, as against the vendor, gives the purchaser an absolute right to deal with that which he so buys in any way he thinks fit; and of course that includes selling in any country where there is a patent in the possession of and owned by the vendor.

SUGG v. BRAY.

[1881—5. 1 O. R. 45 ; 2 O. R. 223.]

Threats—Validity of Defendant's Patent—Benevolent Construction—Costs.

Action to restrain the publication by defendant of statements that the plaintiffs, manufacturers, infringed the defendant's patent, and of threats of legal proceedings against the plaintiff and his customers.

The writ was issued 7th Oct. 1881. After the action was set down for trial, the plaintiff applied, in Oct. 1883, for leave to amend by adding a claim for a declaration that he had not infringed the defendant's patents, or if he had that those patents were bad. The summons came on in Court on the 19th Jan. 1884. Leave refused with costs.

CHITTY, J.—If the plaintiffs are in the position now, upon the allegations of claim, to put forward these proofs, they will be entitled to do so, and there is nothing that I shall do on the present occasion that will interfere with it. But take the other alternative, and suppose they are not. Then I should be altering entirely the scope of the action. I should be bringing in the question of the infringement of a patent, and the question of the validity of a patent.

The plaintiffs sought to obtain damages from the defendants in respect of false statements maliciously made by them with reference to the business and character of the plaintiffs: and (*inter alia*) that the plaintiffs had infringed the defendant's patents.

The action came on for trial before NORTH, J., who dismissed it without costs.

2 O. R.
230.

NORTH, J.—Inasmuch as these patents still subsist, and their validity has not been challenged by *scire facias* or otherwise, I am bound to treat them as good patents; and I do so accordingly. The counsel for the plaintiff did not argue that I must hold either patent invalid in consequence of its claiming what was old; but they did argue that as the patentee could claim, and only did claim what was new, I must so construe the patents as to make them not claim anything which was not either a new integer or a new combination. To this argument I cannot accede. The patent must be construed in the way in which all documents ought to be construed, by giving the ordinary and natural meaning to the words used—looking at the instrument as a whole, and having an explanation of any technical words requiring explanation; and if,

so construing them, I find something old claimed, in clear and unambiguous words, I must read the claim as applying to what is old, even though the result of such a construction, if correct, would be that the patent must be held invalid in any proceedings taken to challenge its validity. If, however, I find the claim fairly capable of two constructions, one of which might be fatal to the validity of the patent, as making it claim something old, but the other of which construction would avoid such invalidation of the patent, I should certainly prefer to put, and should feel bound to put, such a construction upon the claim as would render the patent valid.

As to damages his Lordship said :—The plaintiff has to prove that the defendant was asserting a claim of right against his own knowledge, that it was without any foundation, and that it was not a *bonâ fide* claim in support of a right which (with or without cause) he fancied he had. From this it follows that if the defendant has a *bonâ fide* belief, with or without foundation, that he has the right he claims—or rather, I ought to say, that unless the plaintiff proves that the defendant has not such a belief or fancy—the plaintiff will fail in his action, whether the defendant's belief be with or without cause. The real question is whether, in fact, the defendant had a *bonâ fide* belief that his allegations were true—that is, whether there was in his mind a reasonable and probable cause for acting as he did; not whether there is such a reasonable and probable cause in the opinion of the Court which tries the case. The state of facts might indeed be such as to render it impossible for a judge or jury to believe that the defendant's state of mind really was what he asserts it to have been; but if the conclusion is arrived at that the defendant's allegation, as to his *bonâ fide* belief, is not displaced by the evidence, the fact that the defendant's belief or fancy is not reasonable in the opinion of the judge or jury is immaterial. The defendant swears that he honestly believed the allegations he made; and I have not seen or heard anything in the case which would justify me in saying that the defendant is not to be believed when he makes this statement. When I say this, I do not forget that he has had many years' experience in gas apparatus and patents connected therewith. In addition to this, I find that some of his expert witnesses say that there have been both copying and infringement on the part of *Sugg*; and although the questions of infringement and of copying are for me to decide (and not for the witnesses), and although there are numerous and eminent witnesses for the

2 O. R.
243.2 O. R.
244.

plaintiff, who contradict the evidence of the defendant's witnesses as to both infringement and copying, yet in considering whether the defendant's assertion of his own belief is to be credited or not, I cannot ignore the fact that he has several witnesses who swear to the same opinion that he takes.

2 O. R.
246.

His Lordship referred on the question of injunction to *Halsey v. Brotherhood* (vol. i. p. 218), saying:—The opinion of the C. A. is clear that, whether an injunction or damages be sought *mala fides* on the part of the defendant has to be proved; and it seems to me that the opinion of the M. R. is throughout consistent with this. I do not think he meant to express any opinion that the issuing of notices could be restrained by injunction, unless it was proved that the defendant did threaten and intend to issue them under circumstances in which such notices, if issued, would give a right of action for damages. In the present case I have found that the defendant has not committed any actionable wrong by the notices which he has issued, inasmuch as though the statements contained therein are not true, they were issued in good faith and not maliciously. *Rebus sic stantibus*, therefore no injunction could issue to restrain them. But the result of my decision is that the plaintiffs have not either infringed or copied; and if, while that judgment stands unreversed, the defendant were again to issue notices like those in question, charging the plaintiffs with infringement, the element of *bona fides*, heretofore existing, would be wanting, and a judge or jury would probably have no difficulty in coming to the conclusion that the defendant was acting maliciously. His counsel have, in fact, admitted that an injunction, under such circumstances, would be pretty much a matter of course. But I find no evidence that the defendant has ever threatened or intended to issue notices under circumstances in which such an issue would be malicious. His counsel have emphatically repudiated any such intention; and I find further that the defendant has voluntarily abstained from issuing such notices, for a period during which, so far as I see, the issue of them would not have been actionable. The point upon which the plaintiff's counsel rely is that the defendant has to the last contended that his notices were such as he had a right to issue, and had a right to continue to issue, as he would have had if my judgment had been what the defendant contended it ought to be—viz., that *Sugg* had infringed the defendant's rights and copied his apparatus. But I cannot find, in the assertion of a legal right to do a certain thing which it is contended is not and has not

hitherto been actionable, any threat or expression of intention to do that thing in the event of its being decided that the doing of it would be actionable; and in the absence of evidence of any such threat or intention, I come to the conclusion that the plaintiff's case fails as to an injunction as well as damages. I have given judgment, dismissing the action without costs. I adopt entirely the general rule that costs ought to follow the result, and that when an action is brought for an injunction and damages with respect to what is not an actionable wrong, the successful defendant ought to receive his costs from the plaintiff. But to this general rule there are exceptions; and I think this case an exception for several reasons, of which it is sufficient for me to mention two. In the first place, if I gave the defendant the general costs of the action, I should certainly make him pay the costs of each issue which he has set up as to infringement and copying, upon every one of which he has failed. If this were done, the defendant certainly would have to pay at least as much in costs as he would be entitled to receive; and to avoid a very troublesome and difficult apportionment of costs on taxation, I cut the knot by giving no costs to either party. I also think that the decision of the House of Lords in *Moore v. Bennett (supra)*, furnishes a principle applicable to the present case.

2 O. R.
248.

TATHAM v. DANIA.

[1869. Not reported.*]

Subject-matter—Infringement—Combination.

Case for the infringement of a patent granted to *W. Tatham*, 1867, No. 1019, for "Improvements in machinery for teasing and opening textile materials."

The specification showed the ordinary toothed cylinders of a cotton hard waste breaker machine or devil and the common feed rollers, and stated: "Fig. 2 represents another of our arrangements for the aforesaid purposes wherein we cause the cage roller *e*, which in other machines is made to work in stationary bearings to rise and fall to any suitable extent above the cage or roller *f*, and revolve at any required speed but considerably slower than usual, by which means we are enabled to accommodate, collect, condense, and deliver a greater and heavier body of fibrous material beneath the said cage roller at one time than can be done by any machines heretofore made."

* For the notes of this case I am indebted to T. Aston, Esq., Q.C.

Claim.—The improvements in machinery or apparatus for teasing and opening textile or fibrous materials as herein described and illustrated in the accompanying sheet of drawings.

The action was tried before a jury. Verdict for the plaintiff.

Rule to enter a verdict for the defendant made absolute by the Court of Common Pleas (Bovill, C. J. ; Willes, Keating, JJ.).

WILLES, J.—I apprehend if a patentee would succeed it is necessary for him to show not merely newness in the sense of doing a thing which has not been done before, but that he must show newness in the shape of novelty by producing a thing which requires some exertion of mind that could properly be called invention. To apply an old tool to a new material could not be the subject of a patent, although all mankind had been previously using another sort of tool which produced a much inferior effect, and although therefore the application of the other tool had the merit in it that it produced a useful result in the easier working of a material to which that tool had not been applied before, but inasmuch as the tool has been used for an analogous purpose to that which all mankind knew it was useful for before, although the application was new you would not say the application was a novelty in the sense of invention so as to sustain a patent.

As I understand the alleged invention, it is the mode of operating on fibrous or textile materials in their passage through a series of rollers used in the process of teasing or opening in such a way that it is presented in a more suitable form for being teased or opened by what I may call the cylinder or the following cylinder, that is what I understand to be alleged as the invention, and the mode is described as consisting of apparatus for teasing and opening as described in the specification and the accompanying drawing. The invention is described in the specification, and illustrated by reference to figure 2 of that sheet of drawings, and the description and illustration representing the description of a cage and roller of which the patentee says—(His Lordship read the passage above quoted).—Now in my mind I have been trying to think of language which would describe more distinctly a process in which one of the parts was that the cage roller should rise and fall, and I am unable to think of any language which would more distinctly express that both affirmatively and by an exclusion of any other machine. I refer to the latter alternative, to the expression which I read twice “which in other machines is made to work in stationary bearings.” Now I come to the infringement. The infringement does not make use of that part of the

described invention. What is the result? Not, I agree, that you at once say that there is no infringement which would enable shifty persons dealing with a patent, which consisted of several meritorious parts, if they happened to be described with the conjunction "and," to use any of them or all but one of them, and to say that they had not infringed because they had not infringed all: that would not be the result; but I apprehend the true result is that you must show that that which had been infringed and made by the alleged pirate is a use in his machine of such part of that which is described in the specification as could stand by itself in respect of invention, and in respect of use as the subject of a distinct patent. I do not go into the question whether it is not also necessary to show that what is rejected is not a thing wholly useless or which could be mere hamper upon a person who sought to put the patent process into operation. I do not go into that discussion, because that would fall under a different head of Patent Law, but I am confining myself at present to the plain condition for the infringement of a part of that which is described as a connected whole to be a piracy within the patent law, viz., that you should establish that that part would have been the subject of a distinct patent. It is necessary, therefore, to see what that part in the present circumstances was, because I think a part of the plaintiffs' description has been adopted by the defendant, and it is necessary to see what that part was, and then whether that part is the subject of a distinct patent.

The part which the defendants have adopted consists in the retardation of the cage, that is the only part they have adopted. The cage roller does not rise and fall, they have a fixed apparatus instead of an accommodating or yielding apparatus, and what they have adopted is the retardation of the cage. There would have been an accumulation after the set of rollers which went faster than the other set of rollers, they would urge on the stuff faster than the following set of rollers and carry it off, and there would be an accumulation, and whether you get at that by making the first set of rollers go faster than the second and so accumulate after that set, or by making the second set of rollers go slower than the first so accumulating before that set the result is the same, you have an accumulation by a difference of velocity between two sets of rollers. It seems to me, therefore, the question is reduced to whether it could in itself have been the subject-matter of a patent. I am satisfied that it could not have been the subject-matter of a patent, because so far as I have been able to apprehend and collect

in the course of the argument, the use of sets of rollers in a series going at different rates of speed for the purpose of making materials not of the same kind, but of a like kind, pass through in a form more convenient and advantageous for being operated upon by the succeeding part of the machine was in use before. It was used in the course of cotton spinning. I apprehend that the use of that is the use of an old process which was applied to another state of things, but to another state of things different only in the circumstances and not in the species, because for the reasons I have stated in the early part of my argument that that would not in respect of novelty be the subject-matter of a patent though applied in an analogous way to some other stuff in the same form. For these reasons it appears to me that there was no infringement because only a part of what was described was infringed, and that part could not be the subject of a separate and distinct patent.

TILGHMAN'S SAND BLAST COMPANY v. WRIGHT.

[1884. 1 O. R. 103.]

Particulars of Breaches.

The plaintiff company were the registered proprietors of two patents, both granted to *A. V. Newton*, for "improvements in pulverising stone," dated respectively 1st Aug., 1870, No. 2147, and 3rd Nov., 1870, No. 2900 (both on communications from *B. C. Tilghman*). They sued the defendant company for infringing both patents, and with their claim delivered the following particulars of breaches:—

"The defendants have infringed the plaintiffs' patents in the statement of claim mentioned by importing into this country, selling, exposing for sale, using, and otherwise dealing with glass globes, shades, or moons, having their surfaces wholly or in part roughened or obscured by the projection against them of a stream of sand or other suitable material."

The defendants took out a summons under Order XXX., r. 1, for the plaintiffs to deliver better particulars.

This was adjourned into Court. The defendants imported from Germany certain globes, and the plaintiffs stated such globes were infringements. They had purchased one or two of such globes, but desired not to bind themselves down to those globes alone as infringements.

PEARSON, J.—The plaintiffs will give one or two exhibits, and they will probably say that those were manufactured by one or

other of their processes. It may be, for aught I know, absolutely impossible to distinguish between the processes; and after the argument to me to-day, I should think it probably was impossible to distinguish between the surfaces of articles made according to the two processes. Then the plaintiffs may fail at the trial, because, if the defendant satisfy the Court that the second process is invalid, and the plaintiffs do not prove that the glass was manufactured by the first process, they will fail. I shall give them leave to add general words in the same way as was done in *Talbot v. Laroche* (vol. i., p. 452), where they gave one exhibit, and said they did not mean to confine themselves to that; and that was considered sufficient. And in *Batley v. Kynock* (vol. i., p. 36), one cartridge was exhibited, and that was considered sufficient.

Referring to *The Patent Type Founding Company v. Richards*, where general words were struck out by KEATING, J. (2 L. T. 359), PEARSON, J., said that, as in that case the defendants were manufacturers, his view of the present case remained unaltered.

Costs to be costs in the action.

UNITED HORSENAIL COMPANY v. STEWART.

[1884—6. 2 O. R. 122; 3 O. R. 139.]

Measure of Damages.

Action for infringement of certain patents, of which it is only necessary to refer to two—(1) 1872, 15th Aug., No. 2432, to *W. M. Brown*, for “improvements in machinery for the manufacture of horse-shoe nails;” (2) 1878, 14th Oct., No. 4078, to *G. C. Hopper*, for “improvements in mechanism for, and in the method of manufacturing blanks for animal shoe-nails.”

On the 20th March, 1885, the Lord Ordinary KINNEAR interdicted the respondents from infringing. The pursuers then commenced a second action for compensation for infringements. The defenders admitted infringement of the 2nd claim in 2432, and of the 6th claim of 4078; and the sole question raised was one of damages. 2 O. R.
122.

The Lord Ordinary (KINNEAR).—In the first place, the defenders say, and I think rightly, that the pursuers can only recover compensation for the actual loss which they have sustained; and on the other hand, it is said, with equal justice, that every sale of a patented article is an injury to the patentee or to the assignees of the patent, and, *prima facie* therefore, it would appear to me 3 O. R.
141.

that the true measure of damage should be the amount of profit which the assignees of the patent would have made if they had themselves carried through those sales, because the loss which they have sustained is simply the loss of profit upon sales, which it may be presumed they would have made were it not for the wrongful intervention of the defenders. But then it is said—and there is force in the consideration—that it is rather an assumption than a matter of certain inference to say that if the infringers had not interfered, the sales made by them must necessarily have been made by the pursuers, because there are other considerations which go to the effecting of sales, such as connection in trade, and energy and skill in the conduct of business, and therefore it does not necessarily follow that the pursuers would have made every sale which the defenders succeeded in making if the defenders had not interfered at all. There is another consideration which the defenders have urged, and perhaps a more formidable one, because they say that the patents have only been infringed in so far as they apply to two separate parts of the process of the manufacture of shoe nails, and that those two parts are in themselves of subordinate importance; and therefore they say that they have derived no material advantage from the infringement, because the real merit of the nails they have sold is not attributable to the patented mechanism, or to any process or mechanism that is not open to the public. And therefore they say, that since no considerable portion of the profit they have made upon the sales in question can be traced to their use of the patented machinery, the pursuers are entitled only to nominal damages if they are entitled to damages at all.

3 O. R.
143.

There certainly is a great deal of authority for saying that where only a part of a complex machine is protected by a patent, the infringer cannot be made liable for the aggregate profit derived from the entire machine, as if that were the profit he had made by the use of the patent. But then the cases cited, in which that consideration was thought to be material, were not actions of damages for infringement. They were suits in equity for ascertaining the profits obtained by the infringers, charging them as trustees for the patentee, and in such cases it would be exceedingly material to show that a part of the profit for which they were asked to account was really attributable to processes which were not covered by the patent at all. For the only question in these cases is, what advantage the infringer has derived from the use of the patent over and above what he would have got from the use of

processes open to the public; and this is very clearly explained in the American case (*Morry v. Whitney*, 14 Wall. 620). The question as to the patentee's loss does not enter into the consideration at all, because as the law was stated in the House of Lords, in *Betts v. De Vitre*, the basis of the claim for profits is that the patentee condones the infringement, and does not complain of it, but seeks to recover the whole profit made by the infringer as if it had been made as trustee for him. But this is an action of damages for infringement; and the question is not what profit the infringer has made, but what loss the patentee has sustained, and what the pursuer complains of is, that he, having a sale for articles of common use, which was of great value to him, by the use of his patented machine the defenders have infringed his patent right by interfering with his business and depriving him of the sales which he alone would have made if the defenders had not pirated his machine. Now, if the pursuers have lost the profit they would have made upon these sales by reason of the defenders' infringement, it does not appear to me to be of very much importance whether you can trace the profit which they would have made, or how much you can trace, to the use of a particular portion of their machine. What they have lost is the sale. The great value of all machines of that kind consists not merely in their producing a superior article, but in their producing that article at a cost which enables the patentee to put it upon the market so as to command large sales, and that is what they lose by an infringement which enables others to compete with them.

Therefore it appears to me to be a fair enough ground for estimating their damages to take the whole profits which they would have made upon the sales actually made by the defenders, if the defenders had not interfered so as to prevent the pursuers effecting those sales themselves. That would mean the difference between the cost of manufacture and the prices at which they were selling at the time to their own agent. The pursuers maintain that the profit upon their sales—I mean the profit upon the defendants' sales at the actual rate at which the pursuers are selling for the time—is by no means sufficient to compensate them for the loss which they have actually sustained; because they say that they have been compelled by the wrongful competition of the defenders to lower their prices to their own agent in Scotland, and, therefore, that to give them full compensation, the profits of which they have been deprived by the defenders are not to be estimated at the rates at which they were selling at the dates

when the actual infringement took place, but at the higher rate at which they were enabled to sell before the defenders began to compete with them, or before the competition of the defenders had brought down their prices so considerably as they say it in fact succeeded in doing; and for the same reason they say it follows that they must also have the difference between the prices which they actually earned on their own sales to their agent in Scotland and the rates they would have earned if there had been no competition. Now, I think this additional claim would not be unreasonable if the grounds in fact upon which it rests could be satisfactorily established, for, if they have the sole right of manufacturing and selling horse-shoe nails produced by their machine, they might well be entitled to damages for interference with their business over and above loss of profit on the actual sales of nails imported by the defenders. It is true there has been a considerable fall in prices since the beginning of 1883, when the defenders first began to sell nails made by the machines which have been held to infringe the pursuers' patents; I do not think it is proved that the competition of the defenders' was the sole cause of that fall. There is evidence that however excellent the pursuers' nails may be, there were other nails in the market with which they had to compete, and, independently of competition, there are other causes for the fluctuation of prices which do not appear to be excluded by the evidence. Therefore I am not able to give any precise pecuniary value to this element of loss which the pursuers allege.

UNITED TELEPHONE COMPANY v. BASSANO.

[1884—6. 2 O. R. 70; 3 O. R. 295.]

Construction—Infringement.

Action for infringement of a patent, No. 2909 of 1877. The invention and specification will be found fully set forth in the report of the *United Telephone Company v. Harrison*, vol. i., p. 472. It is only necessary to add that by a disclaimer subsequent to that decision claims 1 and 3 were struck out, leaving the 2nd claim as the sole claim of invention, viz. :—In an instrument for transmitting electric impulses by sound the combination with a diaphragm or tympan of electric tension regulators substantially as hereinbefore described for varying the resistance in a closed circuit substantially as set forth.

The defendants simply denied infringement.

Issue was joined 28th Oct., 1884, and the action set down for trial. On 1st April, 1885, the defendants moved for leave to amend by the denying the validity of the patent. Leave granted to amend within three days on payment of all costs.

The matter being one of indulgence, the defendants were put upon terms to keep an account.

PEARSON, J.—I do not think I can say that the defendants 2 O. R. 71. have not a *locus pœnitentiæ*. I think they are in time. I do not think I ought to prevent them from raising it if they are minded so to do, because they were not estopped by the proceedings which were taken before. At the same time, considering how late they have come, I decline in any way whatever to postpone the hearing of the action.

The main question raised at the trial was that of infringement.

The alleged infringement consisted of a transmitter for telephones consisting of a conical hollow mouth-piece of black wood, into the larger end of which the speaker spoke; towards the lower end of the cone the wooden part became larger, and formed what was called "the black base." Within this was a cylindrical chamber into which the smaller end of the cone opened, but the chamber was of considerably larger diameter than such opening. To the sides of this chamber two pairs of blocks of hard carbon were firmly fixed, and a pencil of hard carbon with attenuated points was supported at its ends by each pair of blocks, the points resting lightly in a larger cavity in each of the supporting blocks, and being in "loose contact" with them. The other end of this cylindrical chamber was then closed by being fastened firmly to a piece of red stained wood, the portion of the instrument furthest from the speaker's voice, called for distinction the 'red back.'

The carbon blocks were connected to a line wire in a closed circuit, and formed with the pencils the tension regulator. The air waves were concentrated on the pencils. The result was that there was a change of position in the carbon surfaces in contact accompanied by some pressure. This to the extent of the compressibility of the carbon varied the area of the carbon surfaces in contact, and as the area was smaller or larger so was the resistance of the electric current larger or smaller, and thus the resistance of the electric current varied with the sound waves.

The defendants alleged that they had not used (1) a diaphragm or tympan within the specification; (2) a tension regulator, which is within the specification, and that therefore they had not taken either of the two things the combination of which alone was claimed.

Judgment for the plaintiffs.

3 O. R.
306.

NORTH, J. (after discussing the specification).—From these various extracts from the specification it is obvious that *Edison* does not confine himself to one kind of diaphragm * * * * The specification frequently refers to a diaphragm or tympan as though they were synonymous terms, and an argument was founded upon this, that nothing could be a diaphragm within the meaning of *Edison's* specification unless it were more or less a tympan or drumhead also, and it was said that nothing of that character was found in the defendants' instrument, but I agree entirely with the opinion of FRY, L.J., that the diaphragm described is always one which is susceptible to vibrations produced by the voice, and this is common to a tympan also, and I do not think that calling it a tympan means more than this; and even if it could be said that in some form *Edison's* diaphragm was not a tympan at all, I do not think it material that a thing is called by an inapt name when I find the thing itself described with sufficient fulness and clearness for all practical purposes, as is the case here.

The next point is as to what is the diaphragm referred to in this specification. The ordinary meaning of the word is a partition or separation, and in the present specification I think it clearly means something which is capable of vibrations, and divides the air on one side of it from the air on the other side of it, so as to allow of differences of air pressure on the two sides which produce the necessary vibration of the diaphragm. It is proved to be quite immaterial on which side of the diaphragm the tension regulator is placed; and therefore it is not in any way essential that the diaphragm should separate one portion of the instrument from another part of it. In point of fact, one form of instrument shown in *Edison's* specification has a tension regulator on the side of the diaphragm on which the speaker is.

3 O. R.
307.

It appears quite clear to me that the use of the red back is the use of a diaphragm within the meaning of that patent. The arrangement of the black cone and base, the red back and the tension regulator, are substantially the same thing as the transmitting instrument fully described in *Edison's* patent, except that the tension regulator is on the nearer instead of on the further side of the diaphragm which is represented in the defendants' instrument by the red back, and this variation of its position is admitted to be of no importance. Indeed, it is proved that when the pulsations of air caused by the voice are made to strike upon the back or outside of the red back, the defendants' instrument

speaks quite as well as—and under some circumstances better than—it does when the voice speaks into the mouth-piece in the ordinary way. It is true that in the defendants' instrument the diaphragm is of wood, which is not mentioned by *Edison* as one of his materials, and the use of which substance as a diaphragm is said to have some disadvantages. But a patent cannot be infringed with impunity by the adoption of an inferior material for a given purpose in lieu of a more efficacious article indicated by the patent for the same purpose.

It is not necessary for me, for the purposes of my judgment, to say more than that by the use of the instrument of which the red back forms a part, the defendants have used a diaphragm within the meaning of the plaintiffs' patent. But it has been clearly proved that if the red back is taken away, the rest of the defendants' instrument still operates as a good telephonic transmitter; and the question whether any combination in which the black wooden portion of the instrument, consisting of the conical mouth-piece, with its black base, or rather of those parts is included, is protected, or not, has been fully argued * * * I entertain no doubt that the use of the black part of the defendants' instrument, as well as the red back, is the use of a diaphragm within the meaning of *Edison's* specification. Each of those parts separates the air on one side of it from the air on the other side, and thus allows the difference of air pressure to exist on its opposite sides.

The defendants contend that even if the above-mentioned parts of their instrument do perform the functions described, still they do not come within *Edison's* specification. In other words, they attempt to circumscribe the area of the specification, and limit it to particular kinds of diaphragms and tension regulators * * *

The contention of the defendants appears to me incapable of being maintained, either upon principle or authority. As regards principle, the patentee discovered a very remarkable new manufacture, and described its essential conditions, and pointed out how it was to be performed, and indicated some practical modes of carrying it into effect, and the law does not require him to describe every way of carrying it out, or limit the protection it confers to the modes particularly described. If the defendants place a diaphragm in their apparatus which performs the functions of the diagram in the plaintiffs' apparatus, they cannot escape the charge of infringement by making a non-essential variation in the position, material, or form of the diaphragm.

It appears clear to me, as it did to FRY, L.J., and to Lord 3 O. R.
312.

MACLAREN, *Edison* did not attempt to describe every form of tension regulator to be used with instruments made under his specification. The question, then, is whether the hard pencil carbon used by the defendants in their instrument, as I have explained, comes within the description of "electric tension regulator substantially as hereinbefore described," as used in *Edison's* specification. The plaintiffs' witnesses say that it does; for it is semi-conductive, compressible, and resilient. The defendants' witnesses say it does not; for it is not semi-conductive, not compressible, and therefore not resilient; and yet, when the evidence is considered attentively, there is very little, if any, difference between them after all. It is merely a question of degree. For instance, it is said that hard carbon is not appreciably compressible, and no doubt it may be said that, in comparison with the tufts of fibre described by *Edison*, a piece of hard carbon or a billiard ball is not compressible. But if dropped from a sufficient height upon a hard flat surface, a billiard ball is compressed to half its diameter, and the carbon pencils of the defendant are compressible in the same way; in fact, *Bassano* himself says that hard carbon must be to some extent compressible in virtue of its elasticity, the same as a billiard ball is elastic; and *Cooke* (a witness for the defendants), says that when the defendants' carbon pencils are made to a point, they are exceedingly compressible at that point, and the evidence is clear that even the slight motion caused by the effect of the voice in the defendants' instrument suffices to produce such a movement of the pencils in relation to the carbon blocks, that by reason of the *inertia* of the pencil a squeeze or compression is produced in the substance thereof, to such an extent, that the area of surface contact is appreciably affected thereby; and that it is by means of the variations thus obtained that the defendants' instrument is made to reproduce articulate speech.

Again, it is said that hard carbon is not semi-conductive, because it is a good conductor. But this also is a question of degree. *Cooke* says that hard carbon may be called a partial conductor—it is a pure question of comparison; that comparing it with a line wire of copper, it might be called a semi or partial conductor, or even a bad conductor—certainly an imperfect conductor; and that for *Edison* to call carbon a semi-conductor is a fair expression, having regard to the circuit in which it is placed, and *Bassano* agrees with this.

But it is also said, even if the defendants' hard carbon blocks and pencils have the attributes of *Edison's* tension regulator, a

regulator of hard carbon is still quite a different thing from any described in that specification. To this there are many answers. In the first place, I have already pointed out that *Edison's* specification does not limit him to specific forms, or to plumbago, or even carbon only. In the next place, *Edison* does specifically describe a form of tension regulator with points of compressed plumbago, which is one form of carbon.

The defendant appealed to the Court of Appeal (Cotton, Lindley, Lopes, L.JJ.). Appeal dismissed.

COTTON, L.J.—He does not confine himself to any kind of diaphragm at all, but he does confine himself, as I understand it, to a kind of tension regulator, that is to say, a tension regulator formed of not a completely conductive substance, but which either by pressing together the small plates or bodies of which that is composed, or by pressing together the different parts of the tension regulator, will afford a more easy or more difficult passage from time to time of the electric current. Then he goes on to state what his claim is. I note there that he does not say the combination with a diaphragm or tympan as herein-before described, but the combination with a diaphragm or tympan, that is, anything which can be properly called a diaphragm or tympan of electric tension regulators, substantially as herein-before described. So there it is undoubtedly necessary in order to constitute an infringement that there should be a diaphragm, and that there should be a tension regulator substantially made as described in this specification, and then that that should be combined with what is properly called a diaphragm or tympan in such a way as to be substantially in accordance with what there is in the specification.

One has to consider, first of all, is there in this machine of the defendants what can properly be called a diaphragm or tympan; that is to say, a diaphragm acted upon or capable of being acted upon by the vibrations of sound caused by the human voice? I said at an early stage of this case in my opinion the construction of this specification must be for the Court. Undoubtedly we must know whether any of these terms are terms of art, and in my opinion the witnesses have taken the definition of diaphragm not as something extraordinary in this specification, but they have taken the definition of diaphragm which is given by FRY, L.J. But then they said: Looking to the context we think, having regard to the words diaphragm or tympan, and having regard to the rest of this specification, it must mean a diaphragm capable of being acted upon, and being made to vibrate by the motion of the

3 O. R.
315.

air caused by the human voice or in some other way. That was their construction of this specification. But we must look really at the specification ourselves, and give it its true construction when we have got such help as we can find from the scientific witnesses as to the meaning in art of the words used.

What I look to see is this—on the fair construction of the word is there a diaphragm, and then is it such a diaphragm as is hereinbefore described—not the particular form of diaphragm which is described in the specification, because it would be wrong to allow any person where a patent is good, having a properly described diaphragm, to say, “My diaphragm is something different, and although it is combined in exactly the same way, and has the same effect on another part of the invention, I claim not to have infringed because I do not take the thing actually as described, although the specification does not refer to that as being necessary for the combination. His Lordship then stated that in his opinion the evidence showed that the red back was a diaphragm, and that the defendants used a tension regulator substantially as described, and continued:—Is the combination of that made with this diaphragm in the way described in the specification? because that, I think, is necessary, for it is “substantially as set forth.” I think it must be fairly taken that it must be done substantially as set forth in the specification. Is it so? In my opinion it is. That which I hold to be a diaphragm has fixed upon it the base of the speaking tube, and there are fixed to the base of that speaking tube blocks of charcoal or carbon. Those are fixed immovably to the bottom of that which is fixed immovably to the tympan. The pencils are loose: that is to say, they are suspended by points not nearly so large as the holes in which they are, and then, when the tympan vibrates with the voice, it causes the bottom of the speaking tube, which has become part of the tympan, to vibrate, and as it vibrates, the pencils, not being immovably fixed to the diaphragm by their *inertia*, rattle or shake in that which holds them, and cause a greater or less pressure from time to time in the parts of the tension regulator in the transmitter of the electric current in the circuit. That is just what is done by the mode pointed out by *Edison*. It is very true that he principally goes upon that where vibration of the diaphragm will press the compressible portions of the tension regulator, but it may be done, as he points out, in one part by their *inertia* acting on a metal disc, and the vibration causing a more perfect contact. What he does say in

one of his passages about the tension regulator is that it is to be acted upon by forming a more complete contact.

The Court refused to express any opinion that the black base without any red back was an infringement, as the defendants had never used their instrument without the red back.

UNITED TELEPHONE COMPANY v. DALE.

[1883—4. 25 Ch. D. 778 ; 53 L. J. Ch. 295.]

Injunction—Breach.

In this action, which was one for infringement of the same patent, the plaintiff company had moved for an interim injunction, and the defendants on such motion submitted to a perpetual one. This was a motion to commit a defendant for a breach of this injunction. During the argument PEARSON, J., said, with reference to an argument urged that the injunction was limited to sale of the whole instrument and not of the component parts:—"If there was a patent for a knife of a particular construction, and an injunction was granted restraining a defendant from selling knives made according to the patent, and he was to sell the component parts so that any schoolboy could put them together and construct the knife, surely that sale would be a breach of the injunction." 25 Ch. D.
782.

The order was made.

UNITED TELEPHONE COMPANY v. DONOHUE.

[1885. 31 Ch. D. 399 ; 3 O. R. 45.]

Judgment on Admissions in Pleadings.

Action for infringement of the same patent, No. 2909 of 1877. The defendant by his defence admitted having had ten telephones which were infringements, but save as to these he denied that he had infringed. The plaintiffs moved for judgment under O. XXXII. r. 6 upon the admissions contained in the statement of defence. BACON, V.-C., granted a perpetual injunction to restrain the defendant from infringing, but refused to order an inquiry as to damages.

Appeal to the Court of Appeal (Esher, M.R., Lindley, Lopes, L.J.J.). The plaintiffs' contention was that they were entitled to a general inquiry as to damages both in respect of the ten telephones mentioned and also in respect of any other infringing articles that they might on the inquiry find the defendant had possession of.

Order varied. No costs.

ESHER, M.R.—It seems to me that in the position of things here, the plaintiffs, having accepted the statement of defence and acted upon that as an admission, must take it as it stands, and that therefore they must take the negative part of it as well as the affirmative. If they take the judgment in this form it must be upon this footing, that there have been only the ten infringements mentioned in the statement of defence, and that there have been no others. If the plaintiffs think fit to have the judgment altered and to go on against this defendant for the damages to be paid by him in respect of these ten infringements, I think we must allow them to do so; but it is with a strong (I do not know whether it should be part of the order or not) ruling on our part that they shall have no right to ask the defendant on that inquiry for the particulars of any other alleged infringement whatever.

UNITED TELEPHONE COMPANY v. HENRY.

[1883—4 2 O. R. 11.]

Infringement—Loan.

Action for infringement of the same patent, No. 2909 of 1877. The defence only denied infringement. It appeared that two instruments, constructed in accordance with the specification of the patent, had been left at the defendant's shop to be repaired, and a workman of the plaintiff, one *Ward*, had obtained them on loan, the defendant refusing to sell them to him. A memorandum was signed by *Ward* to this effect.

Action dismissed.

BACON, V.-C.—I think that there is no ground upon which the plaintiffs' claim can be sustained. In my opinion the evidence is clear and conclusive; besides the difficulty I should be in from the conflicting evidence, the evidence I have last mentioned is clear and conclusive that there never was any intention on the part of the defendant to sell this instrument or to invade the patent of the plaintiffs in any degree, and *Ward* himself has proved that by the memorandum which he then signed.

Attention being then called to a counterclaim to have the instruments returned, the V.-C. said :—You admit that they are piracies; you cannot have them returned.

THE UNITED TELEPHONE COMPANY v. THE LONDON AND GLOBE COMPANY.

[1883—4. 26 Ch. D. 766 ; 53 L. J. Ch. 1158 ; 1 O. R. 117.]

Injunction—User.

Action for infringement of a patent, No. 229, of 1879. The A.-G. had given the plaintiffs leave to disclaim certain parts of 2909 of 1877, *vide supra*, p. 220, on condition (*inter alia*) that no proceedings for infringement should be taken against the defendants in respect of the 800 instruments the subject of this action.

The defendants gave notice that they were ready to remove from each of these 800 instruments all the parts which would infringe the patent 1879, No. 229, and they renewed this offer by their defence, which did not dispute the validity of the patent, but denied that the instruments had ever been or would be used.

Trial of the action.

Injunction granted with costs.

BACON, V.C.—That the defendants are in possession of instruments made in infringement of the plaintiffs' patent is confessed by them, and proved beyond the possibility of question. That, of itself, gives to the plaintiffs a right to ask for an injunction to restrain the defendants from making use of that which, by their own confession, is an unlawful possession, and would be if used an unlawful use. The defendants have in their possession 800 machines, which are themselves, as they confess I think sufficiently upon the record, infringements of the plaintiffs' patents; and they excuse themselves for it, first, on the ground of the fiat, which, I think, gives them no protection, and next, that it is not their intention to use the instruments. If it is not their intention to use the instruments, then the injunction which is asked for can do them no harm. That would not be enough to dispose of the case, but it is the right of the plaintiffs against the defendants to have an injunction against the defendants, who have the means, to the extent of 800 machines, of injuring their patent rights. 26 Ch. D
775.

Then the defendants say that they offered enough when they said that they were willing to remove the parts complained of. If that also carried with it an undertaking never to use them again, that might be something; but they might be removed to-day and restored to-morrow, and the whole 800 might be sold, used, and exercised in the way which the terms of the patent refer to, 26 Ch. D
776.

Against that danger or possibility of danger the plaintiffs, in my judgment, are entitled to protection in the shape of an injunction. As to the delivery up, I cannot say I see my way to make any order in that respect. It might be to do more mischief; it might merely to destroy. All I have to do in this suit is to entertain the plaintiffs' application that they may be protected against a wrong which is imminent unless they are protected by the injunction, and therefore to that extent I grant the injunction. The damages I have not heard anything at all about, and I make no order respecting damages.

UNITED TELEPHONE COMPANY v. MOTTISHEAD.

[1886. 3 O. R. 213.]

Separate issue as to Infringement.

Action for infringement of the patent 2909 of 1877, referred to *supra*, p. 220.

The defendants by their defence denied the validity of the patent, and denied the alleged infringement, and moved before KAY, J. for an order under O. XXXVI. r. 8, that the issue whether the defendants had infringed be tried before the other issues in the action.

KAY, J., said that unless the defendants admitted the validity of the patent, the question of infringement could not be tried by itself. He declined to take a qualified admission that it was valid for the combination and not for the component part.

UNITED TELEPHONE COMPANY v. S. GEORGE.

[1885—6. 3 O. R. 33, 321.]

Interlocutory Injunction—Infringement—Costs.

Action for infringement of the same patent No. 2909 of 1877, which had been held valid in the action against *Bassano* (*supra*, p. 220).

Motion for an interlocutory injunction.

Infringement was denied, but the alleged infringing articles were considered by the learned judge substantially identical with those that had been decided to be infringements of this patent in a case in Scotland.

The validity of the patent was not denied.

Injunction granted.

KAY, J.—The Court is always ready to interfere upon interlo-

outory motion where a patent has been established, and where there really is not substantially any case to be tried at the hearing. The sole issue—that of infringement—came on for trial before STIRLING, J. The defendant's transmitter was thus made:—

A conical mouthpiece directed the waves of sound on to a disc of carbonized leather. In contact with the disc was a carbonized wood ball which had fixed through it a copper wire, and the ball and wire were suspended from a flexible conductor so that the ball rested lightly by gravity against the disc. This was connected with a galvanic battery, and the main question at the trial was whether the instrument when in use with the battery made a closed circuit. The defendant contended that this was not so, but that the action of the sound waves was to separate the disc entirely from the ball so as to set up a series of makes and breaks in the electric current. On the evidence the Judge came to the conclusion that the defendant's contention was wrong, that he had infringed the patent, and gave judgment for the plaintiffs.

STIRLING, J.—The defendant admitted himself, upon his own cross-examination as to his disc, that “it will vibrate with the air when I speak into the instrument.” Therefore it is a disc which vibrates with the air when the instrument is spoken into, and consequently it is plainly and clearly a diaphragm within the meaning of *Edison's* specification. * * *

The defendant used two kinds of carbons, and he says that those are hard and incompressible; and in a sense no doubt that is true. It is true in a sense, that is to say, as I do not find it to be disputed, that pinching them with the nails makes no impression upon them; but there are certain qualifications, even by the admission of the defendant and his own witnesses, to be given to that consideration. In the first place, the defendant himself admits that the carbon in the disc is capable of being thrown into vibration. Now what follows from that? The vibration of the tympanum or the membrane, such as is spoken of in this specification, operated by sound is of course a totally different thing from the vibration of a pendulum swinging by its mass. The vibrations are occasioned by the parts of the vibrating plate moving relatively to themselves, the plate as a whole remaining fixed. Therefore the mere fact of its being capable of vibrating to sound shows that, to a certain extent at least, it is susceptible of change in form, and therefore it is not enough to say merely that it is hard or that it is incompressible in a sense. The mere fact of its being capable of vibration shows, as I say, that it is capable of change of form. That was very clearly

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explained and put by one of the defendant's scientific witnesses, *Walenn*, who spoke expressly of both the disc and the ball as being compressible, and, when it was put to him, he, I think, explained very fairly what he meant, at all events with reference to the ball, by saying, that it was elastic like a billiard ball, and therefore compressible. Does the substitution of the mode of suspension make any difference? The plaintiffs' witnesses say, and *primâ facie* say undoubtedly, that the substitution of this mode of suspension is a mere mechanical equivalent for the spring, and so, *primâ facie*, it is. The spring operates by creating a pressure which drives the ball up against the disc, and so does the mode of suspension, except that gravity is the force which is called into play instead of the pressure of the spring. But it is said, and contended by the defendant, that although *primâ facie* this would seem a mere mechanical equivalent for the spring, yet in truth and in fact the *modus operandi* of the two telephones are totally different, and that his telephone, in truth and reality, operates in a manner similar to the old telephone of *Reis*, that is to say, by creating numerous makes and breaks of current and not by creating variable resistance or variations in one and the same current. * * *

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All that the plaintiffs' witnesses admit is that there is a roll, and in fact in strict scientific language a rolling implies constant contact between the two substances. When you roll a ball along a table, although the point varies, one part of the ball always remains in contact with the table, and the motion is a totally different motion from what would be given if the ball were thrown up at a very slight angle, and if it travelled along the table by a series of hops. What the witnesses admit is that there is a roll, but by admitting that they do not appear to me to admit in any way that there is at any moment a severance or a make and break between the disc and the ball.

The plaintiffs had costs as between solicitor and client.

UNITED TELEPHONE CO. v. SHARPLES.

[1884—5. 29 Ch. D. 164; 54 L. J. Ch. 633; 2 O. R. 28.]

Infringement by Experimental User.

Action for infringement of the same patent, 2909 of 1877, consolidated with an action for infringement of a patent, 4765 of 1876 (see vol. i., p. 472).

The defence to both actions only denied infringement. The

defendant, an electrician, had purchased from a company at Rotterdam instruments constructed in accordance with the specifications of the patents, but alleged that they had never been used in this country except by his pupils for the purpose of experiment. The plaintiffs asserted they had been sold to a Mr. Berleim in Moscow.

KAY, J.—It is admitted by counsel for the defendant that if a man buys an instrument which he knows would, if made, sold, or used in this country, be an infringement of a patent in this country, if he buys it abroad, imports it into this country, has it in his possession, and sells it, although to a foreign customer, that would be a user which would be an infringement of the patent. I confess, as at present advised, I should have very little hesitation in saying that that would be so; and in this case the balance of the evidence, in my opinion, is in favour of the theory of the plaintiffs, that that is the thing which was actually done in this case.

The alternative story is this:—The witness *Sharples* says, “We used them for the purpose of experiment; the cost of them was so small that we could afford to allow our pupils to pull them to pieces, or experiment with them.” Now they had, as he says, a number of the so-called royalty-paid instruments; they were more costly, and he says, again and again, “We could not afford to let our pupils use those.” And I am asked to say that that was not a user in this country. What does a pupil mean? They say that the pupils are persons who do not pay anything for being taught, but, on the contrary, that after they had been a certain while in the business they, or certain classes of them, receive some payment; but the very word “pupil,” and this evidence which is given, shows me plainly that they are young persons who are admitted into this business for the purpose of learning the business, and, whether they pay or not, it is obvious enough that they are paid very much less than an ordinary assistant would be paid who did not want to learn the business. They are admitted upon the terms that part of the remuneration they shall get for their services shall be instruction in the business. That is apparent on the very face of this statement; and to say that to buy a telephone which is an infringement of a patent in this country for the purpose of instructing your pupils who are learning the business, to let them use, to let them experiment with, to let them, if they please, pull in pieces, for the purpose of saving the expense of using the patent telephone, experimenting with that or pulling

that to pieces, is not a user in this country, is a thing I cannot accede to. It seems to me plainly to be a user. If it were nothing but this, that it was fixed between the lower room and the switch room for the purpose of being used by the pupils who could not be trusted with the use of the more costly instruments, it would be a part of the instruction of those pupils, and the person who so used it would be getting the advantage of instructing those pupils by means of these cheaper instruments, because he did not like to put into the hands of his pupils the more expensive instruments. I am told that that is not a user of the patent. I asked Mr. *Goodeve* how far he carried his proposition—whether he carried his proposition thus far, that there could be no user of a patent unless it produced a direct pecuniary advantage to the person who used it? At first he seemed inclined to go so far, but I think at last he receded from that position because I put to him the very obvious case of a man buying what he knew to be a pirated Singer sewing-machine, for example. Suppose, the real thing being protected by a patent, that he buys a cheaper instrument which he knows is made in infringement of the patent, and buys it for some member of his household, who uses it in the household, let us say, for amusement simply—would that be a user or not? Of course, it could not be denied, because, although it did not produce to him one farthing, or save him the expense of one farthing, there would be no doubt whatever it would be a user in this country. Therefore Mr. *Goodeve* modified his proposition, and said “Oh, no, it must be a user for the purpose of advantage.” Then, is not the user which I have been describing a user for the purpose of advantage? If not, I do not know what advantage or user means. It seems to me clearly that there was a user even if I accept that story.

The validity of the 1876 patent was certified as in question in a former action, but not that of the 1877 patent, but the learned Judge directed the taxing-master only to allow the plaintiffs such costs as they would have been entitled to had they joined both patents in one action.

THE USEFUL PATENTS CO. v. RYLANDS.

[1885. 2. O. R. 255.]

Experimental User.

Action by assignees of a patent granted to *Codd & Foster*, 27th Dec., 1873, No. 4268, for “Improvements in constructing bottles,” against a licensee. The invention described a tool by which

grooves of uniform depth might be cut in the necks of aerated water bottles. The main question was as to whether certain tools, one of which produced was marked B or No. 18, were within the patent, and on this point evidence was given which is not intelligible without the models. Defendant further wished to cut down the ambit of the specification by showing user of B or No. 18 before the date of the patent: this user was said by the plaintiffs to be only experimental.

On this point CHITTY, J., said:—Before the provisional specification was obtained—and I have said that was obtained on the 27th Dec., 1873—a spring tool, substantially the same as B or No. 18, was sent by *Codd*, the intending patentee, to *Rylands*. That was in the month of *Sept.* or *Oct.* of that year. As a conclusion of fact, I state that that instrument was undoubtedly sent by *Codd* for use by *Rylands* alone, and to be kept secret. It was shown that he was to keep it secret, but some suggestion was made that he was not able to keep it secret in the glass houses, and there was a suggestion, but no evidence, that the glass houses were open to anybody who chose to go in. I am by no means satisfied that anybody did go in, considering that one at least of the witnesses described the place as being extremely hot. But it is quite immaterial. A man going in would not necessarily see the tool or take the tool up. But the tool itself was sent by *Codd* to *Rylands* as a matter of confidence, and to be kept secret. Now, it is proved by the evidence that two other similar tools were made by *Butler*, who was *Rylands*' fitter about this time, and that those tools were made by the permission of *Codd*. It is proved also to my satisfaction that *Rylands* turned out at least 600 dozen bottles as samples. All these bottles were sent over to *Codd*, or to persons who were interested with *Codd* in business, carrying on that business at the same place as *Codd* himself. Now, were they sent as samples or not? At first sight 600 dozen seems far beyond the number required for samples, but that observation is at once displaced by a circumstance I am about to mention. You must consider for what purpose the samples would be required. It would be to show the uniformity of the depth of the groove. One bottle would be useless, two bottles would be useless; dozens of bottles would be, having regard to the number that would be required, also useless by way of sample, because they might easily choose out a couple of dozen or a couple of gross even where the grooves were more or less uniform. The result is that a very large number was required, and even the

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defendant himself admitted that as much as five gross or six gross would form a sample. But the evidence shows that a much larger quantity than that was required as a sample. I think it was proved with regard to one parcel of goods to be sent out that there were no less than 157 dozen. But I decline to go into this beyond what I have done, and I state now a second conclusion, that the bottles that were sent out were also sent out by way of experiment, and when I spoke just now about the 600 dozen bottles, of course I meant the 600 dozen that were proved to be sent before the 29th Dec., 1873, the dates of the provisional specification.

WALTER C. CHURCH ENGINEERING COMPANY v. WILSON.

[1886. 3 O. R. 123.]

Particulars of Breaches—Double Claim.

Action by assignees for infringing a patent granted the 21st Feb. 1872, No. 563, to *W. C. Church*, for "improvements in steam engines." For the purpose of this abstract it will be necessary to refer only to *Claim 2*: "The peculiar construction and arrangement of equilibrium circular slide-valves and their combination with the peculiar curvilinear steam and exhaust ports as hereinbefore described." The particulars of breaches stated that the defendants had infringed the 2nd, 3rd, and 4th claims, and went on, "The plaintiffs complain in particular, and by way of illustration, of the following, naming specific sales by defendants to certain persons."

The defendants took out a summons for better particulars stating what portions of the plaintiffs' specification were alleged to be infringed, with reference to pages and lines of such specification.

SMITH, J., at Chambers, made no order. On appeal the Divisional Court (Grove, Stephen, JJ.) dismissed the appeal.

GROVE, J.—I have seldom got much information from particulars of objection or particulars of breaches; my information has generally been derived from reading the specification of the plaintiff, and reading the specifications of any alleged antecedent inventions, and seeing generally a few models in cases of mechanical patents. I had in those cases models of most of the parts which were really in dispute before me. I should think that in nineteen cases out of twenty, and probably more than that, the case of the other party is perfectly well known. In this case it must be assumed to be exceedingly well known, because the plaintiff in his particulars of breaches gives the particulars of the machines that

he says are infringements, and says where they are, to whom they were supplied, and where they were exhibited, and gives detailed particulars of the machines. There is the objection to that, namely, that the plaintiffs do that by saying that "they complain in particular, by way of illustration, of the following instances." The plaintiff now is perfectly willing to confine himself to those instances, provided he has liberty (which he has without the permission of this Court, though he may require the permission of a judge to do it) to apply to add to his particulars any other machine or other matter of which he may receive information, and which he may give evidence of at the proper period, namely, at the trial. That is a matter which we have not before us, but it will be a matter which, if opposed, will come before some judge, who will decide whether he can do that or not. Complaining of a thing in particular and by way of illustration might leave the plaintiffs open to complain of other things, and saying these are illustrations of others will lead to controversy. Subject to that limitation, it seems to me that the particulars are sufficient, because he gives the machines that he complains of, and he speaks of the heads of the invention in respect of which he says they are infringing. It is true the second claim looks, on the face of it, like a double claim. To my mind it conveys a double claim, but it conveys a double claim in which the one part is mixed up with the other, because it complains of the combination of A and B, and of the arrangement of A and B. Putting the simple illustration which I endeavoured to put, he complains of the bolt or latch and of the receptacle for the bolt or latch, and he says, "My bolt is a new form of bolt, and my latch is a new form of latch. I allege myself to be the inventor of both novelties, and I also claim the new combination of my bolt with my latch." Really there is nothing to puzzle anybody in that. The defendants must know whether they use both parts in combination, or whether they use each of them separately in combination with something else which is not the plaintiffs'. It can, after all, only be judged of when you come to see the machines. I think therefore that every reasonable information is given by these particulars. There are three or four claims which are said to be infringed, and the particular machines which infringe those claims are indicated and specified in the particulars of breaches. It seems to me that the plaintiffs have given more information indeed than is necessary; and merely to evolve the information in some other form of words, or to mark the parts of the specification of which they complain,

when there are claims, seems to me quite unnecessary. What it might be where the machines are not given or where the specification has no specific claims, but only a description of the invention and a general claim of novelty, is a very different thing.

WALKER v. HYDROCARBON SYNDICATE.

[1884—5. 2 O. R. 3 ; 3 O. R. 253.]

Revocation—Costs.

This was a petition presented in *Jan.*, 1884, under s. 26 (*supra*, p. 12), for the revocation of two patents which were vested in the defendant company, the first granted *Jan.* 8, 1880, No. 86, to *H. J. Haddan* for "improvements in apparatus for generating heat from hydro-carbon oil" (a communication, &c.), the second granted *March* 28, 1881, No. 1370, to *A. J. Boulton* for "an improved method of burning hydrocarbon oils together with steam or water for the purpose of generating heat." The specifications of both patents described apparatus by which petroleum might, in the form of a spray or pulverized, be used in furnaces, and it was the apparatus only that was claimed. The petitioner *Walker* had a patent granted to him 7th *Dec.*, 1875, No. 4241, for "an improved method of, and apparatus for, applying petroleum and other hydrocarbons, without or with wood, &c., for combustion in furnaces." The specification described his apparatus, and *claimed*: "The employment in combination of air gas and of hydrocarbons or other liquid fuel in the form of spray or in a finely-divided or pulverized condition, in conjunction or not with wood, charcoal, peat, or other fossil fuel, for the purposes of heating, substantially as hereinbefore described and illustrated by the accompanying drawings."

The petition alleged that *Walker* was the first and true inventor of the inventions patented by *Haddan* and *Boulton*.

The petition came on before BACON, V.-C., and evidence was given *vis à vis* that at the date of *Walker's* patent it was well known that petroleum could be used in a finely-divided spray for the purpose of combustion, and a specification of one *Wise*, 16th *Oct.* 1865, No. 2661, was put in to show this. The petitioner had no notice of this before the trial, and it was objected to on his behalf; but it was admitted, as was also other evidence, to show the state of knowledge in 1875. Evidence was given to show that there was no resemblance between the apparatus described in the three patents. The petition was dismissed with costs.

BACON, V.-C.—It would be most unjust towards *Walker* to read his claim and his specification as if he were claiming any invention for the application of petroleum for purposes of fuel as he has here described. On the contrary, he must be taken as a matter of construction and of fair honest dealing to have admitted that there was the mode of using petroleum, and utilising its useful qualities, preventing the ravages and disappointment that would ensue if it was disposed of otherwise than in the form of spray, which is so clearly described in *Wise's* specification. Keeping that in view, *Walker's* specification is for a method and only for a method; that is, in other words, it describes an apparatus by which the object he has in view can be accomplished. * * *

An appeal was entered, and an application was made to the Court of Appeal (Cotton, Lindley, Lopes, L.JJ.) to postpone the hearing and to admit further evidence. The Court refused. The appeal was subsequently withdrawn by arrangement. 3 O. R.
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THE WASHBURN COMPANY v. PATTERSON.

[1884—5. 1 O. R. 157, 191; 2 O. R. 27.]

Practice—Appeal—Costs.

Action for infringement of two patents (i.) granted to *H. H. Murdock*, March 7th, 1876, No. 978, for “improvements in the manufacture of barbed fence wire” (a communication, &c.); (ii.) granted to *H. Gardner*, Aug. 4th, 1877, No. 2990, for “improvements in machines for manufacturing barbed cable fencing” (a communication, &c.).

The defence raised various issues, and at the trial BACON, V.-C., found all the issues in favour of the plaintiffs, and gave them the relief they asked, and (*inter alia*) an order that the defendant should deliver up to the plaintiffs the infringing machines, and such barbed wire as the defendant had manufactured by means of the infringing machines. The defendant asked that the order for the delivery up of the machines should be suspended, as the defendant intended to appeal, but the V.-C. refused to suspend the order unless an undertaking were given by the defendant not to remove the machines out of the country until the appeal had been disposed of. 1 O. R.
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This order was made on the 23rd June, 1884. An application was, on the 25th July, made for an order that offending machines should be delivered up within seven days. It appeared that an 1 O. R.
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appeal was set down on the 18th *July*. It also appeared that eight machines had been taken abroad since the judgment.

BACON, V.-C.—It would be right to perfect the original order by fixing seven days as the time within which the machines should be delivered up to the plaintiffs. I shall suspend the order pending the appeal upon the defendant's solicitors giving an undertaking that, pending the appeal, no barbed wire machines belonging to the defendant, and such as are complained of by the plaintiffs, shall be removed out of or used in this country; and that all barbed wire of the defendant now in this country be delivered up, and that no such barbed wire be sold or imported into this country by the defendant.

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On the 5th of *Nov.*, 1884, on the application of the plaintiffs, the defendant was ordered to give security for costs. This not being given, on the 16th *Feb.*, 1885, the plaintiffs moved to dismiss the appeal.

The Court (Baggallay, Bowen, and Fry, L.JJ.), after consulting Brett, M.R., and Cotton and Lindley, L.JJ., laid it down as a general rule that when security for the costs of an appeal is ordered to be given, and three months or what the Court considers a reasonable time has elapsed without such security being given, an order will be made for the dismissal of the appeal, unless there are extenuating circumstances, in which case the Court will take such circumstances into consideration, and will, if it grants further time, fix that time itself. In the present case a reasonable time having elapsed, and no extenuating circumstances having been shown, the appeal would be dismissed.

WATLING v. STEVENS.

[1884—6. 3 O. R. 37, 147.]

Combination—Publication stating Old and New—Variance between Provisional and Complete—Particulars—New Evidence on Appeal.

Action brought in 1884 for infringement of a patent, 16th *July*, 1879, No. 2886, to *John Watling* for "improvements in spring tip vans." The invention related to vans intended to carry very heavy loads, and according to it the body was detached from the frame beneath, and the motion of the van to and fro for the purpose of tipping was facilitated by wheels which were inserted into the frame, and which wheels corresponded with a steel bar running along the bottom of the van. To prevent the body of the van from moving laterally in either direction, its course was

guided by two plates fixed to the frame, and running up the side of the body of the van; and the tipping of the van, and its stopping at the right point for the purpose of tipping, was secured by the insertion of a bolt into the body of the van which ran in a slotted link forming part of the side guard, and the stoppage was effected by the bolt coming in contact with the further end of the slotted link. The provisional specification stated:—This invention relates to the construction of tip vans or waggons, by which means vans or waggons may be made to tip their loads with the same facility as at present obtains in the case of two-wheeled tip carts. It then went on to give a sketch of the invention. The complete specification described the van with reference to two figures and letters corresponding to the parts thereof. *Claims*: 1. The application of a four or two-wheeled van or waggon to act as a tip van or waggon, with the slotted links or levers, with parts hereinbefore described and illustrated by Fig. 1 and letters A, B, C, D, E, F, G, and H, or any modification thereof; 2. The application of a tip van or waggon on two or four wheels by means of the side slot or groove-guards with parts hereinbefore described and illustrated by Fig. 2 and letters A, B, C, I, and J, or any modification thereof.

The second figure and claim varied from the first only in the mode of controlling the angle of tip, the mode described in the first being the slot and bar. This slot was described in the provisional specification, which added, "Other kinds of mechanism for controlling the angle of tip may be employed."

The Particulars of Objections, besides denying infringement, stated:—

1. That the plaintiff was not the true and first inventor of the alleged invention.
2. That the said alleged invention was not new.
3. The specification does not sufficiently describe and ascertain the nature of the said alleged invention, or sufficiently distinguish between what was old and what was new.
4. That the invention, as described, was not useful.
5. That the invention was previously published in the following specifications, naming them, and (*inter alia*) one of Greig, No. 4284, of 1874.

The main questions at the trial were novelty, variance between provisional and complete, and distinction between what was old and what was new.

MATHEW, J., sitting without a jury, gave judgment for the plaintiff.

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The defendant appealed, and ten days before the hearing applied to the Court of Appeal for leave to adduce fresh evidence on the hearing of the appeal, alleging that such evidence had only been discovered two days before the application. The Court said that the appellant might have his fresh witnesses ready to be called, and then, if the Court considered their evidence sufficiently material, they would be able to hear it; but the witnesses were to be produced at the appellant's expense.

On the first day of the hearing the Court (Esher, M.R., Bowen, Fry, L.JJ.) refused to hear these witnesses, as no affidavit was produced that this further evidence first came to the defendant's knowledge after the trial. On the second day such an affidavit was produced, but the Court held it to be too late. Appeal dismissed.

ESHER, M.R.—With regard to *Greig's* patent, it was only on paper, and it never has been used. The learned Judge came to the conclusion that that could not really be made out by an ordinary workman, but if it could, to my mind that patent was a patent for a combination. I am equally clear that this patent is a patent for a combination, and it is obvious to my mind that the two combinations are absolutely different. Therefore *Greig's* could not be said to be an anticipation of this.

Then it is said that the specification is bad. It is as ill-drawn as it can be, and it has, as nearly as possible, rendered this patent invalid. But I think, looking at it fairly, and, as has been said, with a view of making it good so far as reason will allow, rather than destroying it, the patent having been granted, it is sufficiently clear to show what it is that is meant. To my mind it is for a combination, and describes a combination,—in an odd way certainly,—but it sufficiently describes it so that one can understand what is meant. I cannot help thinking that the combination is really a combination of three elements; that the one is a frame running along the whole length of what is to be supported; that that which is to be supported is separate from the frame and is made to run along the frame in order to get means of tipping it. Therefore there is the frame, the separation from the frame, and then there is, when you get to a certain length in sliding along, the means of controlling more or less the angle.

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Then it was said that the beginning of the final specification states that this is an invention by which means vans or waggons may be made to tip their loads with the same facility as at present obtains in the case of two-wheeled carts. Then, when the claim

comes, it is "the application of a four or two-wheeled van," that is to say, the application to a four-wheeled or a two-wheeled van, and it is said that that variation is fatal to the patent. I do not think myself that the question of wheels is really a material matter in this patent. As I have said, I think it is a combination to be applied to waggons whether of four wheels or six wheels—a combination of the three things that I have said. Even with regard to a two-wheeled waggon or cart, it is a different mode of making it. The material parts of the combination, even as applied to that, being this frame that runs along so as to support the upper part of the cart, the upper part of the cart sliding along that, till it comes to a place where you can more or less, as I say, by the means described, check the angle. I cannot see that the number of wheels is a material part of the patent, or is a material part of the claim, or is any part whatever of the combination which the plaintiff has invented. To say that you can apply the patent to one thing, and then to say that it is not an infringement because that very same thing is applied to a similar thing, is a false point. Even if the two-wheeled carts were not named here in the patent, I cannot myself think that there would be no infringement of the exact combination producing the exact effect, because a person applied it to a two-wheeled cart instead of to a four-wheeled waggon. Even if it had not been mentioned, I cannot see that the introduction of that application to a two-wheeled waggon is fatal to this patent.

The main question which the parties came here to argue, is that it is said that the complete specification goes beyond, and too far beyond the provisional specification, and that therefore the whole patent is bad. I think that the law with regard to that is this—that if the complete specification sets out and claims an invention independent of that which is in the provisional specification, besides also describing that invention which is in the provisional specification, then the complete specification is bad. It would be equally bad if the invention described in the complete specification were a wholly different invention from that described in the provisional specification, because, as has been said, the patent is not given then for the invention which is described in the provisional specification. Therefore, if there were only one invention described in the provisional application, and only one in the complete specification, but those two inventions were wholly and substantially different, the patent would be bad. So if an invention is described in the provisional specification, which invention

is also described in the complete specification ; but in the complete specification another and distinct invention is described and claimed, then it is bad because with regard to the second invention so described and claimed in the complete specification, there would be no provisional specification to cover it.

Then comes the question whether this complete specification breaks either of those rules. I think it does not, and that there is no new and independent invention described in the complete specification which was not in the provisional specification, but that all that occurs here is that the invention which is described in the provisional specification, is completed and amplified in the complete specification. I think that to amplify the invention which is in the provisional specification, in the complete specification, does not vitiate the complete specification. I also think the appellants were not justified in bringing forward this objection as to the difference between the provisional specification and the complete, because that objection is not properly put forward by them in the objections.

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BOWEN, L. J.—The main point argued before us was that the complete specification went beyond the provisional * * * * Whether, on the true construction of the Act, the absence of further particularity in the objections was a reason why the appellant should have been precluded below, or should be precluded here from taking this point, is a matter on which I desire to express no opinion.

WESTINGHOUSE v. LANCASHIRE AND YORKSHIRE RAILWAY COMPANY.

[1882—4. 1 O. R. 98, 229.]

Construction—Infringement—New Trial.

Action for infringement of two patents:—The first granted 25th Nov., 1873, No. 3840, to *C. D. Abel*, for “improvements in the means and apparatus for working brakes on railway trains by fluid pressure” (a communication, &c.); the second, to *G. Westinghouse*, 1st May, 1874, No. 1540, for “improvements in working brakes on railway trains.”

The action was tried before a jury, who found for the plaintiff on 3840, and for the defendants on 1540.

The Judge reserved for further consideration points as to 3840.

That specification referred to a number of previous specifications

of the plaintiff (relative to the well-known Westinghouse break), and consisted mainly of improvements in detail.

Claim 1 :—"The improvements in the construction of the triple-valve box substantially as herein described in reference to figures 10, 11, 12, and 13 of sheet 3; such improvements consisting in the method of securing the cover, in the use of a flexible metallic diaphragm, having limited play between the sloping faces of the valve box and its cover, and in the construction and arrangement of the valve S^3 , and the passages to and from it."

The method of securing the cover as described was old. It was contended that this was claimed separately.

On this point DENMAN, J., said :—Though not without considerable doubt upon the point, I have come to the conclusion that the plaintiff is entitled to judgment upon this question. I think that it is necessary to look at the whole of the specification, and at the state of knowledge at the time of its publication, in order to decide whether a particular claim is a claim to a combination of several things, some new, and some old, or a claim to several distinct inventions. So, looking at claim 1 in connection with the various passages in the specification, and the diagrams relating to the triple-valve box, I have come to the conclusion that the claim does sufficiently, though not in the best possible manner, give information to persons acquainted with such machinery that the thing claimed is the triple-valve box described, or in other words, the combination of the cover described, the flexible metallic diaphragm described, and the valve S^3 , and the passages to and from it constructed and arranged as described, all constituting an improved triple-valve box. If this is so, the admission as to the want of novelty of the cover alone is immaterial.

1 O. R.
101.

As to *Claim 2*, which was :—"The use of a loaded valve for permitting the escape of the fluid leaking into the pipe of the brake cylinder, except when such pipe is charged sufficiently to cause the brakes to be applied substantially as herein described," the Judge said :—The first question raised was that it is a claim for any loaded valve used as described, and therefore bad, as there could not be any novelty in the mere use of a loaded valve. I am of opinion that this is not the real meaning of the claim, but that the claim is limited to the use of such a loaded valve as that described, or any mere colourable variation of it.

1 O. R.
102.

The Judge then entered judgment on 3840 for the plaintiffs.

The jury had found at the trial that the defendants had infringed the 4th claim of 3840, which was for :—"The combination of the

guided brake levers A^2 with the diagonal and cross ties D and D^1 , and the brake beds D , arranged and operating substantially as herein described in reference to the figures on sheets 1 and 2 of the accompanying drawings."

This part of the invention had relation to a mode of applying the brake blocks, one on each side of the wheel, so as to relieve the axle from strain. The specification stated:—"Each of the wheels has on each side of it, that is to say, towards the front and towards the rear of the train, a brake block hung by a link from the framing of the carriage. The two front blocks are connected together by a truss or triangular framing somewhat like the principal of a roof laid on its side, and the two rear blocks are similarly connected, and the apex of each of these trusses is jointed to the brake lever, the one to a point in the lever above the other. The lever itself stands vertically midway between the wheels, and as nearly as possible in the vertical line passing through the axle of the pair of wheels, and in order that it may clear this axle, and have room to play, it is made with a bend, so that its lower part, to which the brake trusses are connected, comes immediately below the axle, while its upper part, to which the brake rod is connected, comes above the axle. To support and guide this lever it has mounted on its upper end a roller, which can run in a horizontal slot in a bracket attached to the framing of the carriage, which slot may be simply formed as a space between the under side of the framing, and a bar in the shape of an elongated staple attached thereto."

The defendants had worked under a patent of one Chapin, 1872, No. 2973, but had modified his break-lever, so as to guide and support, but his brake-lever was not the same as the plaintiff's lever A^2 , nor had they used the rest of the plaintiff's combination.

The Divisional Court (Grove, Huddleston, JJ.) entered judgment for the defendants, holding there was no evidence of infringement.

1 O. R.
241.

GROVE, J.—Practically "substantially as herein described" come to nothing. It is supposed, and probably it does have some effect when counsel are addressing the jury, to say, "We claim it substantially as herein described;" but they are idle words, because, if the infringer does what is "substantially herein described and claimed," he just as much infringes the patent, whether the word "substantially" is used or not. So that they are mere catch expressions, and no real use at all; but some patent agents are very fond of putting them in, and possibly, as I have said, it may be found advantageous when trying cases

before a jury, but they do not alter the law, or carry it a step further, because the patentee, when he claims his invention, claims it in connection with the drawings, and when he describes the nature of his invention, any person who substantially adopts that invention as claimed by him, infringes his patent, and not a bit the more or the less, because the patentee puts in the word "substantially." It is simple verbiage.

The plaintiff has for his own purposes, and wise purposes, carefully avoided *Chapin's* patent. He has used the definite article "the" instead of the indefinite article "a." "*The* brake levers *A*" instead of "*a* guided brake lever." If he had used the expression "*a* guided brake lever," he would have been in very great danger of his patent being bad. His invention is a different one. The real object of his specific invention is a different one, namely, a lever theoretically passing through the axis and having equality of the two triangles. Those two important points are not infringed by the defendants, nor any parts, as far as I can see, viewing it literally, of the plaintiff's invention, which parts are not common to *Chapin's* as well as to the plaintiff's patent. 1 O. R.
243.

As to the patent No. 1540, the jury having found claims 4 and 5 were bad, and that the defendants had not infringed claim 2, a motion was made to the Divisional Court to order a new trial on the ground that the finding as to infringement was against the weight of the evidence.

The Court (Field, Lopes, JJ., *diss.* Manisty, J.) refused the motion. 1 O. R.
248.

WHEATSTONE v. WILDE.

[1861. Not reported.*]

Interlocutory Injunction—Agent—New Patent.

Suit for infringement of a patent granted 2nd *June*, 1858, No. 1241, to *Charles Wheatstone*, for "improvements in electro-magnetic telegraphs." Complete specification dated 2nd *Dec.*, 1858.

An interim injunction had been granted *ex parte*, and this was a motion to continue it till the hearing.

It appeared that the defendant had bought two of the plaintiff's instruments from him, and it was alleged that the defendant had proposed to act as agent for the plaintiff for the sale of his instruments. This was however denied.

Injunction continued.

* For the notes of this case I am indebted to T. Aston, Esq., Q.C.

WOOD, V.-C.—What struck me on first reading the bill was this, that there was a certain fact stated which operated on my mind, which is denied, of the defendant having applied to the plaintiff for an agency. That fact is denied. That did operate on my mind as raising a much stronger case against an individual defendant than was ordinarily considered to be raised against anybody in the world, one of the general mass of the public, who asserts a right of the public. A person who endeavours to place himself in the position of an agent, and afterwards deals in the manner in which this gentleman is described to have dealt, is in a different position from a mere ordinary manufacturer who says, "I have a right as a rival manufacturer, if I find a flaw in your patent, to avail myself of that flaw; or if I make a distinction between my invention and yours, I have a right to avail myself of that distinction, and say that I will go on manufacturing, and the Court will not stop me, until a court of law has laid down that I am wrong." The position of an agent is of a different character. Whatever information he has gained is acquired confidentially, and there is a *primâ facie* presumption against his coming into the field as a fair competitor against the person who originally obtained the patent. The presumption was strong on that part of the case when I granted the interim order. That is now a matter of disputed fact, but one cannot impute any unfairness to the plaintiff. The plaintiff says "It is so," and the defendant says "It is not so." That is matter which may hereafter have its weight. As to unfairness on the part of the plaintiff in suppressing anything, I do not find anything of the kind in the correspondence. All that occurred is this—the defendant has a communication before the writing of a letter—whether it was in May or the beginning of June it is not denied he has a communication with the plaintiff, in which the plaintiff shows and explains to him the working of the patent invention, as to which I made a remark myself that it may well be said that no doubt the defendant could have gathered the same information by inspecting the specification of the plaintiff, which is already public. That remark is subject to this qualification, that everybody must know that there is a great difference between reading a specification and having an intelligent explanation from an intelligent inventor, such as Mr. *Wheatstone*. The information derived from Mr. *Wheatstone's* explanation of this specification would be of considerable value to this gentleman in reference to his own proceedings, if he were minded to make something after the example

of Mr. *Wheatstone's* instrument, as acting for Mr. *Wheatstone*, which seems then to have been in the contemplation of the defendant, although he swears—at present there being oath against oath, I am bound to take it that it is so—that he never offered to act as agent.

As regards the position of the defendant, the course he has taken has considerable operation in my mind not bringing it unquestionably to anything like the case which I had before me, looking on him simply as an agent and nothing else; but it has strong bearing on the enjoyment of the patent and whether the character of that enjoyment ought to influence the Court in granting the interim injunction. First it is sworn positively by Mr. *Wheatstone* that he made large profits by sale. The enjoyment of the patent is certainly not quite three years from the date of the specification, or rather more than three years from the date of the patent.

Then, you have a subject-matter in which inventors have been very active or very much on the alert. That is shown by the defendant's affidavit. Numerous patents have been taken out. There is *Siemens'* patent and there is *Dujardin's* patent. These patents have been taken out, and you have therefore this strong fact, if we could have any doubt upon it, that there is a great desire on the part of all those who bend their minds to speculations of this description, to obtain the possession of something which should be valuable as regards electric telegraphs in consequence of the very great value which is attached to such a mode of operation when once novelty can be ascertained and secured. Therefore, if this gentleman has for three years been going on selling these articles without any invasion of his patent, that of itself is a very considerable circumstance to be had regard to, looking to the character of the invention and the anxiety which has been manifested by all persons, as far as they can, to obtain the benefit of this particular trade, as one may call it, in electric communication.

YOUNG v. ROSENTHAL.

[1883—4. 1 O. R. 29.]

Novelty—Infringement—Utility—Costs.

Action for infringement of a patent granted to *Young & Neilson*, Jan. 10th, 1879, No. 116, for "improvements in stays and corsets."

The invention consisted in arranging the seams of the stay diagonally instead of vertically whereby the strain was not, when the stay was in wear, at right angles to the seam, and by this means the stays were rendered less liable to split.

The defence denied novelty, utility, and infringement.

The action came on for trial before GROVE, J., and a special jury.

1 O. R. 32. GROVE, J., directed the jury:—With regard to infringement and novelty, they are two quite distinct issues. A man may infringe a patent although the patent is not new, because to infringe a patent is to imitate it—to use not necessarily the whole but any material part of the invention. It may turn out that a man infringes a patent, and that the jury would be right in finding that he had infringed the patent, but then it might be said, “The patent is not new,” and, therefore, although you have technically infringed it, that is, although you have made stays or parts of stays in the same manner as the patent, yet, if what you have made, or if, indeed, any portion of the material part of the patent which is claimed is not new, then the patent is invalid, because the patentee has got a patent for a thing which he did not invent, or if he did invent it he was not the true and first inventor. If it was in public use before, even by one person, his patent is bad. Mere private use in the closet, mere experimental working in a laboratory, without publishing the invention, but keeping it a secret with a view possibly of a patent being taken out, would not invalidate it. But, if it is once publicly used or sold in a shop, or publicly used in a carriage, or on the person, or in any such way, then the public have a right to it, and the patent is bad.

1 O. R. 33. If the patentees’ patent is intended to be for seams straight in themselves, placed vertically with regard to the perpendicular of the body, a man who uses the straight seams will infringe the patent. But then, supposing a man uses a seam slightly curved. If that is substantially the same thing, then the man infringes the patent, although the seam he uses is not quite straight, but is nearly straight, because he would “substantially” infringe the patent. But then you must apply the same rules to the alleged anticipation. If the patentees have a right to claim, as substantially their invention, slightly curved lines, then slightly curved lines made and used before this patent would be an anticipation of the invention. They cannot have it both ways. They cannot claim the benefit of the word “substantially” in support of their invention, and ignore the word “substantially”

in respect of anticipations of their invention. You must administer the same measure, so to speak, to both. * * * * I think 1 O. R. 34.
 in law utility means an invention better than the preceding knowledge of the trade as to a particular fabric. It does not mean abstract utility. Therefore, even if you are of opinion (I do not know whether I ought to express an opinion that it is foreign to the matter) that stays are very bad things, you must not say this is useless because stays are bad things. You may think that stays compress the heart, the lungs, the stomach, and the diaphragm, and are very injurious things. Probably you will require no more evidence of that than that if ever a woman is taken ill and is sick and faint, or anything of that sort, the first thing done is to loosen her stays and get rid of that difficulty at all events. However, that is not the sort of question in regard to utility with which we are accustomed to deal in patent cases. * * * * You 1 O. R. 36.
 must construe the matter as favourably for the public as you construe it for the patentees. You must not say we will give the patentees every advantage; we will say that a person infringes their patent although he does not actually copy it, but we will also say their patent cannot be anticipated unless it is exactly a literal copy of the old * * * *.

The plaintiffs have to make out their case. They have to satisfy 1 O. R. 40.
 you upon the points which they ask your verdict upon, namely, that it is new, useful, and infringed. Of course, if they prove *primâ facie* novelty, then the defendants have to show you that it is not new. In that sense you may say the *onus* is inverted. The plaintiffs, first of all, have to satisfy you that they have a good case upon this, and, if they do so, then still they must satisfy you as to infringement and utility.

It is not necessary in order to anticipate a patent, and to say 1 O. R. 40.
 that it is not new, that the new thing should be exact and identical with the patent. The question is—are they really substantially what is claimed? Could the patentee (that is not a bad test) stop the public from using them under his patent? If he could, and they had been used before, then his patent is bad, because he has no right to stop the public who used it before. You must look at the matter in that way, using the word “substantially” and applying it fairly both to the plaintiffs on the one hand and to the public on the other.

And in answer to a question by the jury his Lordship said:—
 In regarding the word “useful” you must take it as I said, not in the abstract sense. The question is not whether stays were in

existence before and were useful, but are you satisfied from the evidence, taking stays as what they were before, that there is anything in the plaintiff's invention which is more useful than the stays people had before. Is there any new point of utility? If there is any new point of utility in the plaintiff's invention which was not in any previous known thing, then you may say it is useful, but if you think it is not as good as those existing before, or no better than those existing before in any particular point, then you would say it was not useful.

The jury found that the defendants had infringed the plaintiffs' invention; but that such invention was not novel or useful.

The plaintiffs asked for a certificate under s. 29 (6) *supra*, p. 14.

GROVE, J., gave the defendants the general costs and gave a certificate that the plaintiffs had proved their particulars.

PRIVY COUNCIL CASES.

BAILEY'S PATENT.

[1884. 1 O. R. 1.]

Form of Petition and Accounts—Salesman's Profits—Payment for Patentee's own Time—Adequate Remuneration.

Petition for extension of a patent granted to *Joseph Bailey* the 31st *Mar.*, 1870, No. 950, for "A new or improved apparatus for registering or indicating figures or numbers, applicable to seats of chairs, weighing machines, and other useful purposes."

The petition was presented by the administrator of the said *Bailey*, who died in 1882.

There was no opposition. The invention had relation to certain mechanism forming a lock convenient for determining the number of times a machine had been used.

Evidence was tendered to show that 400*l.* should be deducted from the nett receipts for the patentee's remuneration. The evidence was rejected; Lord BLACKBURN saying:—Their lordships do not wish by any means to be understood to say that this might not be a very proper deduction made for work which might have been done by some one hired for the purpose. If work was done by a third person hired and paid by the patentee for the purpose, then the remuneration that the patentee gave to that person might be deductible; and if, instead of that, the patentee had done the work, then it might be that a proper remuneration—a *quantum meruit*—would be allowed to the patentee himself for doing it. Their lordships are by no means to be understood as saying that that would not be a proper allowance. Whether the *quantum meruit* should be 400*l.* or 4000*l.*, or whether it should be reduced to a nominal sum, must, of course, in every case depend upon the circumstances of the particular case. In a proper case, when it was properly raised, their lordships would not be prepared to say that such a point might not be proved in evidence; but then their lordships think that where such a claim as that is going to be made, it is necessary that it should not be raised for the first time

upon the argument at the bar, but that it should appear on the accounts that such a claim is going to be made. At all events, if it does not appear on the accounts, it should appear in the petition, or somewhere or other.

On the accounts 7951*l.* appeared as the sum received for sale of locks, the actual cost of manufacture being 2072*l.* No sum was inserted in the accounts or stated in the petition as due to salesman's profits. As to this sum of nearly 6000*l.*, Lord BLACKBURN said:—It is said that that is to be considered, not as profits made by the patentee as such,—not manufacturer's profits—but as consisting of profits made by him as a salesman. It is quite plain from the facts of the case that a great portion of that sum is profit which the patentee received, because he, being the patentee and having the patent, was able to sell the locks; and it is quite impossible to suppose that anything like this very large sum of 6000*l.* would be an ordinary salesman's profits. Something would be deducted from it. How much, we cannot say, but it is not likely to be a very large sum * * * * Whether or no such a claim ought to be permitted, their lordships think there ought to be due notice to call the attention of everybody to such a claim being about to be made, and that it should not be made for the first time in the argument of counsel at the bar. On this point also their lordships do not think that any evidence should be now received.

Extension refused.

LORD BLACKBURN:—What the statute says is, that the Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public. [Sec. 25 (4), *supra*, p. 11.] Upon that, evidence has been called, which shows what can hardly be disputed, viz., that the invention which is the subject of the patent is a beneficial invention; but as to the petitioner showing there was any special or peculiar advantage in the invention in relation to the public to entitle the patentee to the large reward of an extension of his patent, their lordships are of opinion that he has totally failed so to do.

Then what their lordships have next to consider is the profits made by the patentee as such. The point has been suggested that there might be some amount deducted from the amount put down as nett receipts. Supposing the utmost sum that could be deducted from the receipts on that account was to be deducted, it would still leave what their lordships could not but consider an adequate remuneration. If the nett remuneration, which is put

down here as 8038*l.* 16*s.* 4*d.*, were reduced by deducting the profits made by the patentee as salesman incidentally to supplying locks, and supposing it were, say, 1200*l.* or 2000*l.*, even that would leave 6000*l.* nett profit made during the time of the patent as remuneration. Their lordships cannot see that that is at all such an inadequate remuneration as to make it right and proper to advise that the monopoly should be extended.

BRANDON'S PATENT.

[1884. 9 App. Ca. 589 ; 53 L. J. P. C. 84 ; 1 O. R. 154.]

Practice—Date of Presentation of Petition—Patent granted before 1884.

Petition for extension of a patent granted 31st *Oct.*, 1870, No. 2865, to *A. H. Brandon*. The petition was presented on the 23rd of *May*. The Registrar refused to admit it on the ground that it was not presented at least six months before the time limited for the expiration of the patent in accordance with s. 25 (1) (*supra*, p. 11).

The petitioner now moved that the petition might be admitted.

LORD WATSON:—Their Lordships have come to the conclusion that the petition presented upon the 23rd *May*, 1884, ought to be received. It is obvious that the petition would not be competently presented if the provisions of s. 25 applied. But their Lordships are of opinion that those provisions do not apply, and that the proceeding falls within the exceptions introduced by the 113th section (*supra*, p. 27). The provisions of sub-section (a) of that section must be read distributively, and so read they declare that the enactments of the new statute shall not affect any patent granted before the commencement of the Act. And they also declare in express terms that those enactments shall not affect any right or privilege which had accrued to the patentee before or at the commencement of this Act. Now, the patent which was held by the present petitioner at the passing of this Act of 1883, was an exclusive right to use a certain invention for a definite period of time, but, as incidental to that right, he had, by virtue of the provisions of the Act 5 & 6 William IV., the further privilege of leave to apply for a prolongation of his patent, at any time before its expiration, upon such grounds as commended themselves to this Board. That right had accrued to him. He was in a position, if he had chosen, to make the application at the date when the new statute came into force;

and their Lordships find it impossible, looking to the precise terms of s. 113, to hold that that privilege, which was incident to and part of his patent right, was taken away by the provisions of the new Act; or rather, they find it impossible to hold that it is not a right included in the express reservation made by s. 113. They will therefore direct that the petition be received, and the usual procedure followed.

CHURCH'S PATENT.

[1886. 3 O. R. 95.]

'Mortgagee not a party—Merit—Anticipation by useless machine.

Petition for extension of two patents, each granted to *W. C. Church*, (1) 21st Feb., 1872, No. 563, for "Improvements in steam engines," (2) 19 Aug., 1872, No. 2469, for "Improvements in steam and hydraulic engines." In 1882 a limited company was formed to work the patents. The capital of the company was divided into 1000 shares of £10 each, and of these 333 fully paid up were allotted to *Church* as the consideration for his assignment of the patents to the company.

The petition was presented by the company, but the patents had been mortgaged to one *Robinson* to secure advances up to £2000. A sum of £770 was in fact due to *Robinson* at the date of the petition.

Objection was taken that *Robinson* was not a petitioner, and if the opponents succeeded, they had no security for their costs.

Their Lordships held that the mortgagee, as legal owner, ought to have been a party, but that the irregularity was not so serious as to be fatal to the further hearing, since if it had been discovered before the hearing it might have been set right. Under the circumstances it was sufficient if the parties agreed, if extension were granted, to insert the mortgagee's name so as to give him the same security under the new patent as he had under the old.

The extension of the first patent was opposed, and reliance was placed on a patent to *Webb*, No. 3403, of 1869, as anticipating *Church*, and the Attorney-General in the exercise of his right referred to a prior specification of which the petitioners had no notice.

Extension of first patent, and of so much of second patent as related to the invention claimed in claims 8, 9, 10, 11, for five years.

LORD MONKS WELL.—In regard to the first patent, upon the evidence their Lordships are satisfied that *Church* did produce a

useful machine, and an improvement upon the former machines ; that is to say, that part of the steam engine to which his invention relates ; and it further appears that it is his invention alone which in this respect has had no success. But the extension of the patent to him has been opposed mainly upon the ground of want of novelty, and therefore want of merit ; and their Lordships have heard very ingenious arguments, which they have listened to with great attention, to the effect that *Church's* machinery in these two patents of 1872 had been anticipated in the first place by himself, and in the second place by *Webb*. If it had been shown to us that *Webb's* patent had been acted upon and that any workable machine had been made under that patent, the case would have assumed a very different aspect ; but in the absence of *Webb*, who might have given evidence upon that subject, and in the total absence of any evidence whatever that any machine was made under *Webb's* patent of 1869, or at all events until he took out his second patent in 1878, it appears to their Lordships that *Webb's* specification must be treated as having had no practical result, any more than the previous specification of *Church*. Under those circumstances it appears to their Lordships that the invention being undoubtedly a useful one, the objection upon the point of novelty does not sufficiently impress them to induce them to withhold advice to Her Majesty that the patent should be prolonged. The invention has not been as much adopted as might have been expected, and some of the licensees, for reasons which have not been altogether explained in all cases, though they may have been in some, have not continued, as might have been expected in a highly meritorious invention, to make the articles and pay the royalty. On the other hand it would appear that latterly, especially in the last year, the invention has been taken up by the Admiralty, and that several of the Queen's ships and other important ships have been fitted with *Church's* apparatus, and it does not appear, as far as the evidence is concerned, that in any case *Church's* apparatus has failed, and it appears when adopted to have been a uniform success.

No costs were given, their Lordships thinking there was very good ground for the opposition, it being a very doubtful case, and one in which they had had great difficulty.

COCKING'S PATENT.

[1885. 2 O. R. 151.]

Extension—New Patent subject to conditions of new Act.

Petition presented by *J. T. Cocking*, for the extension of a patent granted to him 6th *Sept.*, 1871, No. 2353, for "Improvements in splints, and in the manufacture of sheets of material for forming splints."

It was opposed by *Clarke*, a chemist.

The Attorney-General did not dispute the merit and raised no questions on the accounts, but suggested that there was a doubt whether s. 22, taken with s. 45, applied to a patent which was extended.

Their Lordships did not consider the doubt was well founded, as when extension was granted it was in the form of a grant of a new patent for the prolonged term.

Extension for five years.

DUNCAN & WILSON'S PATENT.

[1884. 1 O. R. 257.]

Unsatisfactory Accounts.

Petition for extension of a patent granted 19th *Nov.*, 1870, No. 3031, to *G. Duncan* and *W. A. Wilson* for "Improved machinery or apparatus for folding paper." The petition was presented by the *Victory Printing and Folding Machine Company*, to whom the patent had been assigned in 1872.

Extension refused.

SIR B. PEACOCK.—Their lordships are of opinion that the invention was an exceedingly ingenious and meritorious one, and that it was useful. The Attorney-General has admitted these facts.

The patentees in the first instance endeavoured to work the patent, but they were unable to do so, and they sustained a loss. In the year 1872 a company was formed for the purpose of working the patent, and the patentees assigned to that company the benefit of their patent, with an express stipulation that the assignees should be at liberty, if they found it necessary, to use their names in any subsequent application which they might make to Her Majesty for the extension of the patent; so that, from the very first moment after the company had taken an assignment of the patent, they had it in their minds that it might become necessary

thereafter to apply to Her Majesty for the extension of the patent. His Lordship then referred to *Saxby's* case (vol. i., p. 565), and to *Adair's* case (vol. i., p. 580), and continued:—The assignees, the company to whom the patentees assigned their patent, were a company formed not merely for working the patent, but for carrying on manufactures of a similar nature. Accordingly their business was not confined to manufacturing the patented article, but was also extended to what was called a factory, including a jobbing business. It was, therefore, necessary for the petitioners, according to the cases to which reference has been made, so to keep their accounts that, if it became necessary to apply to Her Majesty for an extension of the patent, the accounts might show everything which could be applied to the patent business, and not to leave it in doubt. There would have been no difficulty as regards travelling expenses, if any travelling expenses were incurred for the purpose of carrying this patent into execution, in entering under the item of "Patent" the amount which was expended from time to time in the travelling expenses. So with regard to advertising and the commission. Taking those items of the general charges altogether which are not specifically shown in the accounts to have been applicable to the patent part of the business, and which have been charged against it, there is nothing to show that the other portion was attributable to the patent business. So with reference to the advertisements and the other charges; they are also in a similar way included in the general charges, but specific items have been charged against the patent business and against the particular items of the factory business. Those items altogether amount to a sum of about £4,000, which added to the alleged profits of the business of £15,000, would make the profits £20,000 instead of £15,000.

It is said in the general statement that £15,577 being the whole manufacturing profits, one-third of that alone ought to be attributed to the patent, and the other two-thirds ought to be attributed to the general manufacturer's profits. But it was laid down in *Hill's* patent (vol. i., p. 549), where the patentee was also a manufacturer, that two-thirds was too much to be attributed to the general manufacturing profit, and that one-third was too little to be attributed to the patent profits. But there is no specific rule which can be acted upon. Their Lordships think that in this case to give one-third only to the patent, and to take two-thirds of the whole profits as manufacturing profits, was more than ought to be allowed.

FURNESS' PATENT.

[1885. 2 O. R. 175.]

Merit—Patentee's own Time.

Petition for extension of a patent granted to *H. D. Furness*, 15th Sept., 1871, No. 2437, for "An improved method of lubricating the cylinders and valves of locomotive and other engines."

The patentee died in 1880, and his widow assigned the patent to Messrs. *Wilson*, who agreed to pay her royalties. The petition was presented by Mrs. *Furness* and Messrs. *Wilson* jointly.

Extension refused.

LORD MONKSWELL.—With regard to the invention, it appears to their Lordships that it is one of merit and of utility, but it does not appear to them that it is an invention of such rare and exceptional merit as sometimes comes before their Lordships' Board, and which rare and exceptional cases are treated as to a certain extent exempt from the rule applicable to ordinary patents. The question comes to this: whether, having regard to the merit of the invention, such as it is, their Lordships are able, in the words of the last Patent Act which has been passed (sec. 25, *supra*, p. 11) to represent to Her Majesty that the patentee has been inadequately remunerated by his patent; and unless their Lordships are able to make such a report, Her Majesty has no power to extend the term of the patent.

The question of remuneration stands thus:—The patentee himself up to the time of his death received 1,794*l.*, according to the accounts, as the profit on the patent. Since his death the widow has received a sum of 3,178*l.*, making altogether the profit on the patent 4,972*l.* But, in addition to this, the other petitioners, the Messrs. *Wilson & Co.*, have manufactured the patent, and have made, according to their own showing, a sum of some 940*l.*, which brings the total sum up to 5,912*l.*, or, in round numbers, very nearly 6,000*l.* But it appears also that the patentee during his lifetime made charges yearly on account of the time which he occupied in attending to this patent. He has charged 100*l.* in the first year, 300*l.* in another year, and 400*l.* in some other years, making altogether the sum of 2,400*l.* Their Lordships are not altogether satisfied that the whole of the time for which he charges in those years, and for which he puts down 2,400*l.*, has been devoted to the extension and furtherance of this patent, and they think at all events that a considerable portion of this sum of 2,400*l.* may be properly taken as profits of the patent. This

being added to the figures which have been before mentioned, it appears to their Lordships, on the whole, that they are unable to say, in the words of this Act, that the patentee has been inadequately remunerated.

HORSEY'S PATENT.

[1884. 1 O. R. 225.]

Uberrima Fides.

Petition for extension of a patent granted the 30th Nov., 1870, No. 3145, to *J. G. Horsey*, for "An improved method in the manufacture of brushes and brooms."

The petition was presented by a company, and stated that the said company had been formed to work the patent, and had acquired it for 3,250*l.* cash, and 23,750*l.* in fully paid up shares. It was further alleged that neither *Horsey* nor the company had received adequate remuneration.

Extension refused.

Sir R. COLLIER:—It has been repeatedly laid down that the application for the extension of a patent being one purely of favour, and in no sense of right, *uberrima fides* must be observed by the petitioners to this Court. Their Lordships cannot help thinking that in the present case *uberrima fides* has not been maintained. The plain meaning of the petition, on the face of it, is that a company has been formed independently of the patentee, with whom the patentee has entered into a certain agreement, and to whom he has assigned his patent.

The facts turn out to be these:—*Horsey*, the patentee, had borrowed a great deal of money of one *Birkett*; a very common transaction, to which there would, of course, be no objection. *Birkett* and *Horsey* sought to form a Limited Liability Company for the purpose of taking this patent, and they went so far as literally to comply—to comply with the letter of—the Act, which prescribes the conditions under which a Limited Liability Company should be formed. But no such company, in any commercial sense, was ever formed at all. Seven persons were given seven shares as a nominal compliance with the Act. The persons really interested continued to be *Birkett* and *Horsey*; and the application practically is solely on behalf of *Birkett* and *Horsey*,—this company being non-existent, or, to use popular language, a mere sham and pretence. Under these circumstances it appears to their Lordships that it has not been candid on the part of the petitioners

to withhold this state of facts from their Lordships, and to give them to understand on the face of the petition that a *bonâ fide* company—a real company I must call it—was formed, whereas no real company was ever formed at all.

NEWTON'S PATENT.

[1884. 9 App. Ca. 592; 52 L. T. 329; 1 O. R. 177.]

Foreign Patents—Adjournment to Amend—Costs.

Petition for extension of a patent granted 1st Aug., 1870, No. 2147, to *A. V. Newton*, for "Improvements in pulverising stone" (a communication, &c.). The patent was assigned in 1871 to *Tilghman*, and in 1874 was assigned to *Tilghman's Patent Sand Blast Co., Limited*, who presented this petition alleging that both they and the patentee had been insufficiently remunerated. No reference was made in the accounts to certain foreign patents for the same invention which had been granted to *Tilghman*. Opposition by various parties.

Extension refused.

Sir A. HOBHOUSE:—For the present purpose, no distinction can be drawn between the petitioners and *Tilghman* himself. Objections were made to the petition by various parties, and one of the objections was to this effect, that *Tilghman*, and all persons for the time being owners of the invention, have obtained with him all like privileges for the monopoly or exclusive use of the said invention in certain foreign countries and British colonies, which have been allowed or were about to expire, and that no sufficient information is afforded by the petition as to such patents or privileges. In point of fact, the petition is entirely silent with regard to any profits obtained upon the foreign patents. The petition was not amended after those objections were put in. Now, the reason given for that is, that by the new Patent Act of last year the practice of this committee has been altered, and that it is not necessary for the petitioners to produce the accounts relating to foreign patents. (His Lordship read sec. 25 (4).) Now, it is quite true that in that section one particular class of profits is specified as something absolutely necessary to consider. There is nothing whatever in the section to say or to intimate that the committee shall not look at other classes of profits, but they are to look "to all the circumstances of the case." It is difficult to suppose that the legislature could have intended to alter the rules adopted by this committee, resting on no previous statutory enactment, but

on what was found to conduce to the justice of the case, and to the public convenience.

Their Lordships are of opinion that no such alteration is made by the statute; and that looking now, as they looked before, to all the circumstances of the case, they find it to be a very material circumstance that they should know what has been received by way of profit on the same invention in foreign countries. It may be the determining point of the case—it may prove not to be so,—but that is a point on which the committee must form their own judgment, and it is for the petitioners to supply them with materials for that purpose.

This petition was to have been heard on the 10th of last month. At the petitioners' desire it was postponed to the present day. We are now on the 8th of *July*, and the petitioners propose that there shall be an adjournment for some period, in order that they may furnish their opponents with the accounts which they have neglected to produce—in effect, in the face of the objections, refused to produce—up to the present time. It is obvious that at this period, the patent expiring on the 1st of *Aug.*, the opponents would have a very short space of time within which they could test the genuineness and the propriety of those accounts. Their Lordships think that in a cumbrous case of this kind, with many opponents, who meet here at great trouble and great expense, the petitioners must bear the consequences of their refusal to produce the accounts. They decline to allow any adjournment, and the petition must be dismissed.

Their Lordships directed the Registrar to apportion one set of costs between the opponents.

SMITH'S PATENT.

[1885. 2 O. R. 14.]

New Patent Granted.

Petition presented by *W. W. Smith*, for extension of a patent granted to him 2nd *March*, 1871, No. 552, for “improvements in the construction of anchors.

There was no opposition.

New patent granted for 7 years.

Sir B. PEACOCK.—Their Lordships entertain no doubt that this patent is a meritorious one, and that they ought to recommend Her Majesty to prolong it.

The question then arises whether the patent ought to be prolonged by means of an extension, or whether their Lordships

should recommend Her Majesty to grant a new patent? The practice has been to grant a new patent; and their Lordships think, that in this instance a new patent ought to be granted. Their Lordships are of opinion that the patentee has not received sufficient remuneration, and that the new patent ought to be granted for a period of seven years. The new patent will be granted under the provisions of s. 25 (5) (*supra*, p. 11). Their Lordships are of opinion that it is unnecessary to recommend that the new patent should contain any particular "restrictions, conditions, and provisions." As has been admitted on the part of the patentee, the new patent will be subject to the provisions of ss. 22 and 27 of the Act which apply to new patents granted after the passing of the Act.

His Lordship, in answer to counsel, stated that no new specification need be filed.

STEWART'S PATENT.

[1885. 3 O. R. 7.]

Novelty as Merit—Readiness to give Benefit to the Public—Costs.

Petition by *Duncan Stewart* for extension of a patent granted to him 4th Dec., 1871, No. 3269, for "improvements in sugar cane mills."

There were various opponents.

Evidence of prior publication was admitted tendered by the Attorney-General, but of which the petitioners had no notice.

Extension refused.

LORD MONKSWELL.—Their Lordships are satisfied that the invention, whether or not it may have sufficient novelty to sustain the patent, upon which they give no opinion, has been so far anticipated by previous patents and by actual user of machines in this country as to deprive the invention of that degree of novelty which would be necessary in order to justify their Lordships in advising Her Majesty to prolong its term. What novelty it has is certainly of a somewhat minute description, and does not constitute that exceptional merit which is necessary in order that a patent may be properly extended.

Their Lordships are not quite satisfied that the patentee has at all times been as ready to give the public the benefit of his invention as might be desired.

The opponents applied for costs. The two anticipations most relied on were not brought to the petitioner's notice till the hearing on the previous day. Under the circumstances their Lordships gave no costs.

APPLICATIONS FOR PATENTS.

JONES' PATENT.

S. 33—What is one invention.

In this case the C. G. had refused to accept an application for a patent upon the ground that the provisional contained more than one invention. On appeal to L. O., HERSHEY, S. G., said:—It seems to me that the general object of the invention is the test by which the question of one invention must be decided.

If you have a particular general object of an invention to make rails rest more securely, and you describe one or two or three devices of an analogous nature, cognate devices, for carrying it into effect, I should say they were all one invention; but if there is no common purpose so that you could say, "I use this as a substitute for that," both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them except that both are used in connection with rails, and it strikes me that would be two inventions.

I should always allow alternative devices for producing a particular object as one invention. But if you say I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct, then those are six inventions.

The difficulty I had when I read this *provisional* throughout was that it did not sufficiently point out the common purpose which binds them altogether as one invention. For example, the advantage obtained by this sleeper might be entirely independent of the advantage obtained by that sleeper invented for a totally different purpose.

I am clear about the principle expressed above. You can only have one invention. If your invention is to get rid of the insecurity in a rail by a new mode of fastening it, for example, if you say, "I do it in this way or that way," then that is all one invention. It is an invention by one or other of those devices which are cognate devices for securing the rail, and that is one invention; but if you say "improvements in sleepers," and you do not claim for the combination of them (of course, if you claim for the combination of them, then I allow that goes to the combination), but supposing you say, "Well, I have invented a sleeper which has such and such merits, and I have invented another

sleepers which has totally different merits, and a third which has still different merits," they are all sleepers, but they would be three inventions and not one invention. They have nothing in common except the fact that they are sleepers. That is the real test.

You may get in one patent the combination, and you may get all subordinate parts of that combination, so far as you claim to use them for the one main purpose, but if you are going to claim a subordinate part, or one of the elements of the combination for a purpose independent of the purpose of the combination, then you have got an extra invention, and it is not all one.

The S. G. directed the application to be accepted upon words being inserted in the provisional showing to his satisfaction that the respective parts had one common object.

Agent, *Mewburn*.

HEARSON'S PATENT, 1885, No. 11437.

S. 33—*Question of One Invention.*

Hearson applied for a patent for "improvements in apparatus for rapidly heating flowing water, *a part of which improvements is applicable to other purposes.*" The provisional specification described an apparatus consisting of several parts, including improved mechanism by which the turning of the taps of a geyser otherwise than in the required order was prevented.

At the end of the provisional the applicant stated "the arrangement hereinbefore described for locking the water and gas cocks is applicable to oxyhydrogen light apparatus, and to other apparatus in which two cocks, or a number of cocks, are required to be turned in a certain order."

The C. G. being of opinion that the part of the title in italics and the above quoted clause made the specification contain more than one invention required an amendment. On appeal to the L. O., appeal dismissed.

DAVEY, S. G.—I think the applicant has invented: *First*, an improved cock or arrangement of cocks which he describes as applicable not only to geysers and the particular apparatus described by him, but also to other apparatus. *Second*, an apparatus for an improved geyser consisting of a combination of several parts, of which one is his new and improved arrangement of cocks.

Under these circumstances, I think that in order to comply with s. 33 the applicant must omit the last paragraph of his provisional specification and the corresponding words in his title.

If he desires it, he may make a separate contemporary application for his new and improved cock, or arrangement of cocks, by itself. He may also, of course, describe the cock, or arrange-

ment of coaks, as part of his combination or apparatus which he also claims to have invented, but he should, I think, in doing so, refer to his contemporary application if he desires to make one.

Agent, *W. T. Whiteman.*

ROBINSON'S PATENT.

S. 33—One Invention—Title—Costs.

Application for a patent accompanied by a provisional for an invention of "improvements in the art of producing and utilizing induced electrical currents for telegraphy and other purposes."

The invention consisted in the employment in telegraphic transmitting and receiving instruments of a certain appliance. The C. G. objected to the title stating that this appliance could be applied to purposes other than telegraphic, and required an amendment of title so as to limit the invention to such purposes, and informed the applicant that if he desired to claim the general use of the appliance for the production of induced currents it must form the subject of a separate patent.

Appeal to the L. O., *HERSCHELL*, S. G.—If you intend to claim as a combination the whole of this apparatus as one telegraphic apparatus, then it might all be included in one specification, but if you are including for all purposes the invention of "the appliance," then it is something different, which cannot be protected by the same patent.

I should allow this if the whole was limited to telegraphy, because that would make an improved telegraphic arrangement, and, although consisting of several parts, I should allow it to be included in one patent; but if you have two separate things like this, which can only be allowed together because they all go to make up one better kind of instrument or machine, then I should never allow the use of a part of that for a purpose independent of the main purpose of that machine.

It is, therefore, a question for you whether it answers your purpose better to protect "the appliance" for all purposes, or to protect improved telegraphic apparatus which consists in the employment of "the appliance" therein. I will allow either of those, but it is for you to say which will be the most to your advantage.

The applicant elected to take a patent for the general use of "the appliance." The S. G. allowed the title to be amended to "improvements in the art of producing and utilizing induced electrical currents," the description of the telegraphic apparatus being struck out from the provisional.

Application was made for the return of the appeal fee which had been paid, but the S. G. refused to advise its return.

Agents, *Thompson & Boulton.*

SMITH'S PATENT.

C. G. has no power to require claim to be amended.

In this case the C. G. required the applicant to omit certain claims, and to add certain words to other claims, contained in a complete specification left after a provisional. The applicant appealed against this requirement. Appeal allowed.

HERSCHELL, S. G. (without going into the merits of the case) said:—This point has been considered by the A. G. in conjunction with myself; we have come to the conclusion that provided the specification ends with a statement of the invention claimed distinct from the description of the invention contained in the specification, sub-s. 5 of s. 5 (*supra*, p. 4) is complied with, and that there is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. I should only guard myself by saying this, that if the statement of the invention claimed were such as "I claim the invention described in the specification," that would be regarded as a mere colourable compliance with the terms of the statute, and not as a distinct statement of the invention claimed because it would merely refer back to the previous description. Therefore, I think there must be a real statement of the invention claimed, but if there is such a statement I do not think it is competent to the Patent Office to enquire whether it goes beyond or is in conformity with the description of the invention. There is no doubt a claim of a particular machine in saying, "I claim the improved bicycle substantially as described," or "I claim the improved incandescent light," or anything which clearly points to what the invention is. But merely to say "I claim the invention described in the previous specification" is a case in which, although it has the form of a claim, I should think it was not a distinct statement of the invention claimed.

Agent, Carpmael.

OPPOSITION TO GRANTS.

AINSWORTH'S PATENT, 1885, No. 5176.

*Appeal to L. O. by opponent—Absence of applicant at hearing of appeal—
Adjournment—Costs.*

This application was opposed by *Rushton*. The C. G. decided to seal a patent.

Rushton appealed, and a copy of the notice of appeal was sent by him to *Ainsworth*. The L. O. clerk issued notices of hearing and posted them to the agents of the respective parties, but at the hearing no one appeared on behalf of *Ainsworth*, but no notice had been given that he did not intend to appear.

WEBSTER, A. G.—I will let you explain the mechanism to me, and if I should decide against the respondent he will have to apply to me to be heard, and to show why he was not here to-day, and will have to pay the costs of the adjournment.

After hearing the appellant, the A. G. reserved his decision. Prior to any decision being given, the respondent applied *ex parte* to the A. G. to be heard, and having satisfactorily accounted for his non-attendance on the previous occasion, A. G. directed the respondent to pay the appellant's costs of the adjournment, and upon this being done another hearing was fixed.

BAILEY'S PATENT, 1884, No. 12067.

Opposition on prior Provisional Specification—New Evidence before L. O.

Bailey applied for a patent for "improvements in attaching knobs to the spindles of locks and latches." *Talman* gave notice of opposition on the ground that the invention had been previously patented, and seven or eight prior specifications were mentioned in the notice.

At the hearing before the C. G. objection was taken on behalf of the applicant that three of the inventions mentioned in the notice had only received provisional protection, and that as no patents had been granted for them they did not come within the terms of s. 11 (1), "*patented* in this country," and that therefore they could not be cited against the applicant.

The C. G. sustained this objection.

After hearing the case with respect to the inventions for which prior patents had been granted, the C. G. decided to allow a

patent to be sealed conditional upon certain amendments being made in the claims.

The opponent appealed to the L. O., and urged that the C. G. was wrong in refusing to allow the inventions which had only received provisional protection to be referred to.

DAVEY, S. G., was of opinion that the C. G. was right, and declined to admit them, as not coming within the terms of s. 11 (1).

The appellant sought leave under L. O.'s rule 8 to put in a further specification of a patent, the existence of which had come to his knowledge since the hearing before the C. G.

DAVEY, S. G., refused to allow this to be put in, as L. O. r. 8 related to evidence, and the specification it was desired to put in was not evidence but an additional ground of opposition.

Upon the main point the appellant argued that if the applicant's claims were amended as directed by the C. G., the opponent would be placed in a worse position than he was by the original claims, and asked that if the patent be not refused it should be granted for the invention described in the specification in its original form.

The applicant preferred to leave the specification as originally drawn, and the S. G. varied the C. G.'s decision by directing the patent to be sealed upon the specification originally left.

No order as to costs.

Agent, *Skerrett*, for applicant.

CHANDLER'S PATENT, 1886, No. 3100.

C. G. requires Amendment—Time for Appeal—Appeal withdrawn.

Messrs. *Chandler* applied for a patent for "improvements in regenerative gas lamps or lanterns," and in their provisional specification the invention was described as follows:—

This invention relates to improvements in regenerative gas lamps whereby the lighting power of the lamp is considerably increased.

In carrying out our invention we construct the burner somewhat in the manner of what is known as an Argand or ring burner, but closed at its lower part, to the centre of which is connected the supply pipe, which passes up through the centre to the top of the lamp; the body of the lamp is of the usual form, and is provided with a glass of suitable shape hinged thereto; in the said body we provide a chamber, into which the air for feeding the burner is introduced through an opening or openings in the body; through this chamber pass a number of vertical flue tubes, serving to carry off the products of combustion; *within the said chamber we place a horizontal and annular partition, in which are a number of short tubes surrounding the said flue tubes and forming communication between the upper and lower parts of the chamber; the central portion of the lower part of the chamber is extended downwards to within a short distance of the burner.*

The action is as follows :—

The outer air entering the chamber as hereinbefore described on its way to the burner will be caused to travel through the upper part of the chamber and between the hereinbefore described tubes, and in its passage will become thoroughly heated by contact with the same ; it will then pass through the downward extension, and impinging on the flame of the burner will cause the said flame to be spread out in the form of a disc ; the heat and products of combustion pass out of the lamp through the hereinbefore described flue tubes.

In their complete specification the applicants followed the provisional, excepting that they had omitted the words in italics. The only other difference between the two specifications was that in the complete the applicants stated that they provided the central portion of the lower part of the chamber which was extended downwards to within a short distance of the burner "with a third tube, the space between this third tube and the extended portion of the chamber being enclosed with a series of concentric rings."

A sheet of drawings accompanied the complete specification, in which all the parts above-mentioned were shown and a description of the parts was given in the specification. In the description of the drawings "the Argand or ring burner, but closed at its lower end" was referred to as "*c* is our improved burner, which consists of an Argand or ring burner closed at the lower part, as clearly shown at fig. 1."

In the drawing the gas was illustrated as issuing from this "improved burner" in a vertical direction (the perforations for the issue of the gas being at the top), the flame being spread out in the form of a disc.

Claims : 1. The improved burner hereinbefore described and represented in the drawing and its use with regenerative gas lamps substantially as set forth. 2. The manufacture and use of the improved regenerative gas lamp or lantern substantially as hereinbefore described and illustrated in the accompanying drawing.

The Wenham Company, Limited, opposed on the ground that the alleged invention had been previously patented by *Clark*, 1881, No. 2869.

In the specification of this patent a lamp was described and illustrated in which the air supply was heated (in a manner similar to that described by the applicants) by passing through a central chamber to the flame. The burner was described as being "a ring or an Argand burner," and shown in the drawings with radial or lateral perforations for the issue of the gas, but like the applicant's burner was closed at the bottom. A perforated tube was shown in the drawings and described in the specification as "being perforated for causing a portion of the heated air to be more equally supplied to the interior surface of the flame," and this was alleged to be the same as the concentric rings or tubes described by the applicant.

Thomas opposed on the ground that the invention had been previously patented by him, 1885, No. 883.

In this specification was shown and described a gas lamp in which (*inter alia*) was "an air-heating chamber provided with a series of concentric rings or annular divisions to aid in distributing and heating air on its way to the burner." The burner in this specification was described as "a burner of curved or trumpet-mouth form, closed at its lower end, and having openings therein for the issue of the gas." On the drawings the gas was shown issuing in a radial or horizontal direction.

The Comptroller General gave the following decision :—

In this case the applicants stated that the one thing which they desired to protect was a burner like an ordinary Argand burner in which the gas issues in a *vertical* direction. But Messrs. *Chandler's* specification does not, in my opinion, sufficiently bear out this statement. It is true they say "the body of the lamp is of the usual form," and claim 1 is a claim to a burner *per se*, but nowhere in the specification do I find a reference to the fact that the holes from which the gas issues are limited to being so placed as to cause the gas to issue vertically. If the invention be limited to such a burner as that, I think the applicants would be entitled to their patent.

Thomas has clearly shown that the invention claimed by the applicants in claim 2 is covered by his patent, but with regard to *Clark's* specification, I am with the applicants so far as regards claim 2 as being a claim for a different arrangement of parts to what is described and claimed by *Clark*.

In all three specifications the burner is of what is known as the Argand type, and in each case is closed at the end.

For the above reason I refuse to seal a patent to the applicants upon their specification in its present form, but if the specification be amended so as to make it claim *only* a burner in which the gas issues from holes at the top so as to cause the gas to meet the air "end on," I shall be prepared to seal a patent to them for that invention, it being apparent from the specifications put in by the opponents that that is the chief difference between the three inventions in question. This amendment of the specification would also entail an alteration of the title.

The Comptroller's decision was dated the 14th *Dec*.

On the 28th *Dec*. *The Wenham Company* filed an appeal to the L. O. from that part of the decision of the C. G. "by which he offers to seal a patent on the application for patent 3100 of 1886 under certain conditions of alteration of the specification and claim therein named."

On the 30th *Dec*. the notice of appeal was withdrawn.

Subsequent to this the applicant submitted amendments to the C. G., and

On the 7th *Feb*. he approved thereof, and a copy of the applicant's specification so amended was forwarded by the C. G. to the respective opponents.

The amendments which had been made were as follows:—

The title was altered to:—

"An improved burner to be used in regenerative gas lamps or lanterns."

The opening paragraph of the specification was altered to:—

"This invention relates to an improved burner to be used in regenerative gas lamps, &c., &c."

The "Argand or ring burner" was altered to "the Argand or ring burner *with vertical orifices for the issue of the gas.*"

All reference to the concentric rings was struck out both from the specification and the drawings.

A statement was inserted that the air on its way to the burner through the passages and chamber would become heated by contact with the sides of the flues, and then pass through the downward extension of the chamber *"in the manner usual in regenerative lamps of this type."*

The following words were inserted just before the claim:—

"But our invention does not extend beyond the special form of the burner whereby the gas issues vertically upwards through the orifices and is caused to meet 'end on,' the heated air issuing vertically downwards through the tube i."

The 2nd claim was struck out entirely, and the 1st claim altered to:—

"The improved burner hereinbefore described and represented in the drawing used in combination with a regenerative gas lamp of the type herein described substantially as set forth."

Amended drawings were also filed, in which the concentric rings were omitted.

Within fourteen days from the date on which a copy of the amended specification and drawings were sent by the C. G. to the opponents, *The Wenham Company* filed a second notice of appeal, the ground of appeal being the same as was given in the first notice, which had been withdrawn. *Thomas* did not appeal.

The appeal came on, and a preliminary objection was taken that the notice of appeal had not been filed within the proper time.

CLARK, S. G.—I do not quite see that the decision of the C. G. has any operative force which would make an appeal reasonable until it was known how the decision would be carried out.

It was stated to the S. G. that in cases where by his decision the C. G. requires an amendment to be made *and does not in his decision settle the specific words of the amendment*, it is the practice of the C. G. to regard the time for appealing to the L. O. as dating from the day of forwarding to the opponent a copy of the amendment approved by him.

CLARK, S. G.—I think it is desirable that that should be understood to be the practice. It seems to me a reasonable practice with a view to preventing hypothetical appeals; because an appeal pursued against the original decision before it was

known how the specification was to be amended would be practically a hypothetical appeal.

The case then proceeded, and in the course of the argument

CLARK, S. G., said :—I will tell you how I shall deal with the question before me. If I find that in the provisional there is any reasonably direct indication—I do not say specific in all details—but a reasonably direct indication of the actual improvement which it is ultimately desired to protect by the patent, I should think then that any amendment was within the Comptroller's power. What I should like you to address yourself to is the question whether in the provisional there is any such indication.

Eventually the appeal was dismissed.

CLARK, S. G.—I have had some difficulty in making up my mind about this case, and it is not altogether without regret that I find myself compelled to give the decision I am going to give. If I had been in the position of the C. G. dealing with the provisional and the complete in the original form of that complete, I have very great doubt whether I should not have held that the invention so far as it was there described had been patented completely by *Clark* in his previous specification, but that is not the question that I have now to decide. Upon the argument before the C. G., he had specifically pointed out to him, and believed that he had found sufficiently indicated in the documents before him, what was the special and particular invention in respect to which the patent was desired, and he has given an opportunity to the parties to amend the specification so as to put the particular description of the invention claimed absolutely beyond doubt. It is for me to say whether he was wrong in allowing them to do that. I cannot come to the conclusion that he was wrong. I do find now, upon the specification as amended, a description of a particular improvement—or alteration which is not shewn to be worthless, and is of such a character as not to be shewn to have been specifically included in any other patent. Under those circumstances, I think I must support the decision of the C. G. and allow this patent to be sealed. Of course in doing that I have great regard to the fact which has been pressed upon me, that my decision the other way would be final, and that my decision this way still leaves it open to those who have been in controversy with Messrs. *Chandler* again to dispute the validity of this patent.

All that remains to be done is to deal with the question of costs. I must give costs upon this ground: an appeal was lodged against the decision of the C. G., and it was perfectly well known what the amendment was to be. That appeal was withdrawn. Then another appeal is lodged against the very same thing, only the carrying out the Comptroller's decision; and though I think that the second appeal was in time according to the proper practice and rule, still I think that the withdrawal of the first appeal indicated substantially that the opponents of this patent thought that they had limited it sufficiently for their purpose, and that therefore they

should not again have appealed against the decision. I decide to uphold the decision of the Comptroller, to allow the patent to be sealed, and I give the respondents their costs.

Counsel, *Bousfield; Moulton, Q. C.*

Agents, *Johnson & Co.; G. F. Redfern; Lloyd Wise.*

COOPER AND FORD'S PATENT, 1885, No. 1450.

Amendment—Alternative Decision—Time for Appealing.

Messrs. *Cooper and Ford* applied for a patent for "Improvements in knitting machines."

In the specification the applicants had described certain improvements in knitting machinery, and certain frictional driving gear.

Rothwell opposed on the ground that the driving gear had been patented by him, 1884, No. 8570.

For the applicant it was admitted that the driving gear he described was the same as that patented by the opponent, but it was urged that it was not claimed.

The opponent asked that a statement should be inserted in the specification which would remove the doubt whether the driving gear was claimed or not.

The C. G. remarked, that it was somewhat difficult to distinguish from the applicants' specification what they claimed to have invented, and in view of the decided similarity of certain parts of the opponents' invention with the applicants, he decided that the applicants should insert in their specification an acknowledgment of the existence of the opponents' patent, and state that they do not claim anything therein claimed. He added:—If the applicants will furnish me within 14 days from date with an amended specification which sets forth more explicitly what they intend to claim I shall be happy to reconsider the case.

In compliance with the latter part of the C. G.'s decision the applicants proposed to insert in the specification, immediately after the description of the driving gear, the following clause:—"To the driving of the shaft D by a loose driving wheel N and cone O we lay no separate claim, as friction driving apparatus of this kind has before been used for driving the shafts of knitting machines." The C. G. accepted the proposed amendment and directed a patent to be sealed when the specification was thus amended.

The opponents appealed to the L. O. on the ground that the amendment as approved by the C. G. was not in accordance with his original decision.

For the appellant it was contended that the C. G. required the claims to be altered, but instead of that he had allowed a disclaimer to be put in, which did not set forth more explicitly what was the invention claimed. The opponent had not had an opportunity of arguing upon the amendment before the C. G., and it was con-

tended that as the opponent had a right to oppose upon the specification in its original form, he should also have a right to oppose an amendment made in consequence of the opposition to the grant to the patent.

The C. G. had refused to allow the opponent to be heard upon the amendment on the ground that it was the practice of the office that an amendment approved by the C. G. in an opposition case formed part of the original decision, and could be appealed against, and the 14 days allowed for appeal did not in such cases date from the date of the original decision, but from the date of the comptroller's approval of the amendment.

It was contended therefore that the second alternative given by the comptroller was bad. By the first alternative he had ordered a reference to the opponent's patent to be inserted which satisfied the opponent and was a good order, because the opponent knew what that amendment was.

CLARK, S. G., overruled the objection to the C. G.'s order. He thought the order a good one, but if the opponent could show that the amended specification as approved by the C. G. did not sufficiently protect *Rothwell* (the opponent) he would vary it.

Upon the merits of the case, for the opponent it was urged that by the applicant saying in his specification that "friction driving apparatus of this kind had been used before," he cast doubts upon the validity of the opponent's patent, because it might mean used by the world in general, whereas the opponent had patented it, and it had been taken *en bloc* from the opponent's specification, which ought therefore to be referred to in the applicant's specification by name and number.

The applicant relied upon the words which had been inserted as being a sufficient compliance with the C. G.'s order.

CLARK, S. G.—The decision of the C. G. in the first instance was a decision which was in favour of *Rothwell*, inasmuch as the C. G. intended that *Rothwell's* patent, so far as the applicant's invention was alleged to infringe it, was to be protected by words put in. I think that the order of the C. G. was right, and the point I have to consider is whether the words that have been inserted do adequately protect the claim which was made by *Rothwell*.

I think they do sufficiently cover the matter alleged to have been infringed.

Well, then, it is suggested that even if those words are sufficient some reference ought to be made in the applicant's specification to *Rothwell's* patent by way of recognition of its validity.

That is a different question, and I do not think it necessary that such a reference should be put in.

Upon the whole I think that the words proposed sufficiently protect *Rothwell*, and I decide in favour of the respondent with costs.

Counsel, *Carpmael* ; *Goodeve*.
Agents, *Carpmael* ; *Chadwick*.

CUMMING'S PATENT, 1884, No. 8988.

*Previously Patented—Slight Difference as Ground for a Patent—Appeal
Subject to Costs.*

The applicant sought to patent "An improved fastener for bracelets," the object being to provide bracelets with an improved fastener, which also formed in itself a safety appliance or guard extending across the gap between the two halves of the bracelet when opened, and preventing one side of the bracelet from becoming disconnected from the other. The improvement consisted in so forming the bracelet that from one of the abutting ends of the bracelet a spring piece passed through a slot in the other end, the spring piece being prevented from leaving the side, by a stud fixed between the legs of the spring. Two shoulders were formed on the spring which, when the bracelet was fastened, engaged with the end of the opposite part of the bracelet, the extremities of the spring-piece being bent outwards so as to serve as push-pieces for unfastening the bracelet.

Jones opposed on the ground that the invention had been patented by him, 1882, No. 5194.

The object of the opponent's invention was the same as that of applicant's invention, and was carried into effect by forming the bracelet so that from one of its abutting ends a *guard-piece* with spring legs passed through a slot in the other end, and was prevented from leaving that side by a cross-piece fixed at the end of the guard-piece, and made larger than the before-mentioned slot. Formed on the spring legs were two shoulders which in the fastened position engaged with the other end of the bracelet. The extremities of the spring legs were bent outwards so as to serve as push-pieces to unfasten the bracelet. Various modifications were described in the opponent's specification, but in each of them a guard-piece or pieces passed from one of the abutting ends of the bracelet through a slot in the other end, a piece being fixed at the end of the guard-piece so as to prevent it passing out of the slot while allowing one side of the bracelet to slide on the guard-piece.

On the applicant's specification there was no part described exactly corresponding to the central guard-piece described by the opponent, and by the applicant's invention the spring-piece was prevented from leaving the side of the bracelet by a stud or pin fixed between the legs of the spring, whereas the opponent effected this object by making the cross-piece fixed to the end of the guard-piece wider than the slot on the end of the side of the bracelet on which it rested.

These appeared to be the only differences between the two inventions.

The C. G. decided that the two inventions were not the same, and directed a patent to be sealed.

On appeal, JAMES, A. G., although of opinion that the two

inventions were very nearly the same, thought that there was just sufficient difference (although a very slight difference) to justify him in affirming the C. G.'s decision. He felt, too, that if he refused a patent his decision would be final.

The A. G.'s attention having been called to the applicant's claim, which was as follows:—"The improved fastener for bracelets constructed substantially as above described and illustrated in the accompanying drawings for the purpose specified," and objection taken by the opponent to the word "substantially" therein, the applicant agreed to strike out that word from the claim.

Upon the question of costs, the A. G. said: "I am afraid if an appeal be made from the decision of the C. G., it must be taken subject to costs."

Agents, Phillips & Leigh; Haseltine & Lake.

DUNDON'S PATENT, 1885, No. 9575.

Opposition—Prior Patent not Sealed—Complete accepted—Evidence.

Dundon applied for a patent for "Facilitating the removal of butter and other goods from firkins, barrels, casks, and cases, and enabling the weight of same to be separately ascertained."

Paterson entered an opposition to the grant upon the grounds—(1) That *Dundon* had obtained the invention from *Paterson*; (2) That the invention had been patented by him in 1885, No. 7213 (See *Paterson's Patents, infra*).

The applicant's invention consisted in a disc hinged to a table or rest, and provided with a spring acting in such a manner as to automatically readjust the disc after each operation in combination with a pair of rollers.

The opponent's arrangement for facilitating the removal of butter from firkins, &c., consisted in the employment of a swinging block in connection with a fixed block and catch arrangement.

No evidence was filed by the opponent.

The C. G.—No evidence being adduced by the opponent in support of the first ground of opposition, I decide in favour of the applicant upon that point.

With regard to the further ground of opposition, *i.e.*, that the applicant's invention has been previously patented, I find that that allegation is not founded upon fact, inasmuch as no patent has yet been granted for the invention upon which the opposition is based, and therefore the question arises whether under these circumstances the opponent has a *locus standi* to oppose.

I do not, however, consider it necessary in this case to decide that technical point, as it is clear to my mind that even if it be admitted that the applicant's "disc hinged to a table or rest" is the same as the opponent's swivelling block, the inventions are not the same, for the hinged disc is not claimed separately but in combination with other appliances which are not to be found in

the opponent's specification. Therefore I direct a patent to be sealed upon this application.

Agents, *G. F. Redfern; Thompson & Boulton*.

EADIE'S PATENT, 1885, No. 739.

Part of Invention communicated by Opponent to Applicants—Patent to Applicants and Opponent Jointly.

Messrs. *Eadie* applied for a patent, 1885, No. 739, for "Improvements in the construction of the travellers used in machinery for spinning and doubling cotton, wool, silk, and other fibrous materials."

The invention as claimed by the specification consisted in travellers with *two* symmetrically disposed straight or slightly curved parts; and in travellers with only one straight or slightly curved part.

Bourcart and *Clark* opposed the grant upon two grounds—(1), that the invention or a material part thereof had been obtained from *Bourcart*; and (2) that the invention or a material part thereof had been patented by *Clark* (on communication from *Bourcart*) by two previous patents, 1882, No. 1602, and 1884, No. 4241.

It appeared that *Bourcart* and the applicants had been in communication with each other, and that *Bourcart* had communicated to them the idea of a traveller with a straight part for the thread to take two or more turns, and had suggested that a patent should be taken for it in their joint names.

The only apparent difference between the applicant's invention and that idea was the straightening of the symmetrically opposite portion of the traveller, the travellers being constructed with two straight or slightly curved parts instead of one. In use, the thread only passed round one of these straightened portions.

The C. G. decided that the invention in question was not wholly invented by the applicants, inasmuch as it appeared to him from the evidence filed that *Bourcart* first communicated to the *Eadies* the idea of a traveller with a straight part, upon which it appeared to him the applicants' specification was based, and he therefore decided to seal a patent for the invention to the Messrs. *Eadie* and *Bourcart* as joint inventors.

Agents, *Newton & Sons; A. M. & W. Clark*.

EVANS & OTWAY'S PATENT, 1884, No. 12415.

Opposition on ground of Fraud—Joint Inventors.

Evans applied for a patent for "Improvements in steam engines," and subsequently *Otway's* name was added to the application as a joint applicant and as a capitalist, and not as a part inventor.

Cutting opposed on the ground that the applicants had obtained the invention from him.

The evidence filed was of a very conflicting nature, and upon the case coming on for hearing before the Deputy-Comptroller the respective parties agreed that as it was absolutely necessary for the declarants to be cross-examined in order to arrive at the facts, and as the Deputy-Comptroller had no power to take *viva voce* evidence, that he should decide to seal a patent upon the application, without prejudice to the opponent upon appeal.

The Deputy-Comptroller acquiesced in this arrangement, and decided accordingly. The opponent appealed to the L. O., and the sole question was as to whether *Evans* or *Cutting* was the true and first inventor of the invention described in *Evans'* specification.

Cutting had applied for a patent, No. 2514 of 1885, for substantially the same invention as described in *Evans'* specification, and had obtained a patent for the invention, but *Evans* did not oppose *Cutting's* application.

It appeared that *Evans* and *Cutting* had known each other for some time, and had been jointly experimenting upon the invention.

A number of witnesses were called and cross-examined, the testimony being of a most contradictory nature.

WEBSTER, A. G., directed a patent to be sealed upon *Evans'* application, on the condition that *Evans* assigned one-half share of the patent to *Cutting*, and that *Cutting* assigned one-half share of his patent to *Evans*.

Each party to pay his own costs.

The sealing of *Evans'* patent to be delayed until an agreement was executed for such assignment, but if *Cutting* refused to assign, then the patent to *Evans* to be sealed forthwith. *Otray* was not present or represented at the hearing and could not be found, and the A. G. said that his rights, if any, were to be limited to *Evans'* half-share.

It was subsequently represented to the A.-G. that as *Otray's* name was included in *Evans'* application it would be necessary for him to be a party to the assignment, and as *Otray* could not be found, although diligent search and inquiry had been made for him, and as both parties agreed that the invention described in the specifications as substantially the same, the A. G. cancelled his previous order, and now directed that a patent be not sealed upon *Evans'* and *Otray's* application, on the condition that *Cutting* executed an assignment to *Evans* of one half the interest in his patent, No. 2514.

Provision to be made in the deed of assignment that each party should contribute half the necessary fees for maintaining the patent in force, and that in default of either party so paying his half share of the fees, the other party should be at liberty to pay the whole of such fees, and give notice to the defaulter, and that the patent should become the property of the party so paying the

whole of the fees as from the date of such payment, unless such defaulter paid his half share within one month from such notice.

Each party to pay his own costs of the assignment.

EDMUNDS' PATENT, 1886, No. 1292.

Fraud Abroad—Legal Representative.

On the 28th Jan., 1886, Edmunds applied for a patent (leaving a provisional) for "improvements in telephones" which had been partly communicated to him from abroad by one *Thornberry*, of Boston, U.S.A., and was partly his own invention. On the 29th Jan., 1886, *Thompson* applied for a patent for the same invention, on communication from *Gilliland*, of Suffolk, U.S.A., and filed a complete specification.

Thompson entered an opposition to the grant of the patent to Edmunds upon the grounds—

(1) That the invention was obtained by *Thornberry* from one *Gilliland*, by whom it was communicated to *Thompson*; and (2) upon the ground that an examiner had reported an interference between *Edmunds'* specification and *Thompson's* specification.

Previous to the hearing before the C. G., *Thompson* applied, with the consent of applicant, for leave to amend his grounds of opposition, and the C. G. allowed the second ground of opposition to be struck out, and the following ground substituted therefor:—
"And also upon the ground that the *applicant* obtained the invention from *Gilliland*, of Suffolk, U.S.A., of whom I (*Thompson*) am the legal representative."

Several declarations were filed in support of the allegations contained in the notice of opposition.

The applicant answered the opponent's declaration, but did not deny any of the allegations contained therein, as he did not consider such allegations relevant to the question.

Thompson had a power of attorney from *Gilliland*, and therefore urged that he was a legal representative within the meaning of s. 11, and that as he proved, by the evidence filed, that the invention had been obtained by *Thornberry* from *Gilliland*, and then communicated by *Thornberry* to the applicant, that the applicant had obtained the invention indirectly from a person of whom he (*Thompson*) was the legal representative.

The C. G. said the point he had to decide in this case was whether in proceedings under s. 11 it was competent to him to go into the question of fraud committed in a foreign country. The allegation of fraud had not been established against the applicant (*Edmunds*).

In the absence of evidence on the applicant's side (he relying on the point of law), there appeared to be some ground for the allegation that *Thornberry* obtained the invention from *Gilliland*, but it seemed to him that he could not take cognizance of that in dealing with the present case, because the section required fraud on the part of the applicant (*i.e.* *Edmunds*) to be proved, and that

had not been done—unless it were held that the applicant obtained the invention from *Gilliland* indirectly through *Thornberry*—which view he was not prepared to take. In all the cases decided by the Courts bearing upon the question of the first importer of an invention being entitled to be regarded as the true and first inventor within the meaning of the Statute of Monopolies, he did not find that in any case had the question of fraud on the part of an importer in connection with obtaining the invention been dealt with, the cases only deciding that so long as the invention imported was *novel* in this country, the first one to import the invention was the inventor within the meaning of statute of James.

He had grave doubts as to whether Mr. *Thompson* had a *locus standi* to come before him as an opponent upon the ground of the applicant having obtained the invention from some one of whom he was the legal representative, as it seemed to him that “*legal representative*” in s. 11 must be construed in its ordinary sense as meaning an executor or administrator of a deceased person, and not as including a person holding a power of attorney. S. 34 and r. 24 made thereunder appeared to support that view.

Therefore, without at all deciding upon the merits of the allegation of fraud as between *Thornberry* and *Gilliland*, he was of opinion that the opposition must fail for the reasons given, and a patent was directed to be sealed upon *Edmunds'* application.

Thompson appealed to the L. O., and after argument,

WEBSTER, A. G., reserved the preliminary question whether *Thompson* had any *locus standi*, and said he would consider whether he would allow the merits to be gone into. But if he decided to allow it, he should certainly give the applicant an opportunity of dealing with the matter on further evidence, and in that event all the evidence on both sides must be completed within six weeks.

Appeal dismissed.

WEBSTER, A. G.—The application was originally made on the 28th of Jan., 1886, by *Henry Edmunds*, as a communication from *H. S. Thornberry*, of Boston, in the United States, and for the purposes of my decision I will assume that the whole invention was communicated from America. On the 29th of Jan., 1886, an application, which for this purpose I will assume to be identical with that of *Edmunds*, was made by *Thompson*, of Liverpool, as a communication from *Gilliland*, of Suffolk, in the United States. *Thompson's* patent was sealed on the 7th of May, 1886, and he now opposes the sealing of *Edmunds'* patent upon the ground that *Thornberry* obtained the invention which he communicated to *Edmunds* wholly or in part from experiments which were being carried on by *Gilliland*, in whose employ *Thornberry* was. It was contended on behalf of *Thompson* that *Gilliland* was the person from whom *Thornberry* had obtained the invention within the meaning of s. 11, and therefore that it was competent for the C. G., or for the L. O., on appeal, to stop the sealing of *Edmunds'* patent.

The question, no doubt, is one of considerable difficulty, but

after careful consideration I am of opinion that that section was intended to apply to communications between persons in the United Kingdom and Isle of Man, and not to communications made abroad.

Prior to the passing of the Act of 1883 the law was well settled that a person importing into the realm an invention was the true and first inventor within the meaning of the statute of James, and it mattered not under what circumstances he had obtained the invention abroad. In my judgment the Act of 1883 has made no alteration of the law in this respect. In the case of an imported invention the merit of the invention is the importation—the communication to the public in the United Kingdom and the Isle of Man; and I think therefore the Comptroller has no jurisdiction to enquire as to the circumstances under which the invention was obtained by the importer. Of course there may be cases in which the relations between the parties are such that the person who has first imported the invention may be guilty of some breach of contract, or breach of duty, towards the person from whom he has obtained the invention abroad, and the importer may be liable to proceedings in respect of the breach of any such contract or duty; but in my opinion those are matters which the C. G. and the L. O. cannot enquire into, but must form the subject of independent proceedings between the parties either in this country or abroad as the case may be.

I was pressed with the decision of JAMES, A. G., in the case of *Fiechter* of 1882, No. 2485, which was said to be an authority in favour of the opponents. I need scarcely say that if such had been the case I should have hesitated very long before I came to a different conclusion. But upon examination of the papers I am satisfied that the ground of that decision was that the original applicant had based his right to the patent upon the ground that he had been instructed to obtain Letters Patent on behalf of the original inventor, and on the declarations which were filed it was clear that there was no foundation for such an allegation. The importer set up no title in himself or any right other than that to take out Letters Patent on behalf of the original inventor. I am satisfied therefore that that case has no application to the present. I am clearly of opinion that under the circumstances the C. G. was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas if the patent is sealed the question can be raised either in the proceedings to which I have already referred, or, it may be, in proceedings for revocation, should the parties be advised to institute any such proceedings.

As the case is one of considerable difficulty, and the applications are so nearly of the same date, I shall leave each party to pay their own costs.

Chadwyck Healey, instructed by *Johnson & Co.*, for applicant.
Bousfield, instructed by *Thompson & Boulton*, for opponent.

EDMUNDS' PATENT.

FIECHTER, 1882, No. 2485.

Fiechter, of Minneapolis, U.S.A., temporarily residing in Liverpool, applied for a patent for "Improvements in dust-collecting apparatus," a communication from *Kirk & Fender*, of Minneapolis.

Grant was opposed by *Dell* of London on the ground that *Fiechter* had not and never had authority from *Kirk & Fender* to apply for a patent for this invention, which was not communicated to him from abroad by *Kirk & Fender*, but which came accidentally to his knowledge when he visited their works.

Dell alleged that in May, 1882, when he was at Minneapolis, *Kirk & Fender* had instructed him to take a patent for this very invention, and filed a declaration of *Kirk* to the effect that *Fiechter* had in April, 1882, offered to become agent for the invention in England, and that *Kirk & Fender* had refused the offer.

Fiechter, on the other hand, asserted that *Kirk & Fender* had accepted his offer, and had agreed to his taking this patent on their communication.

JAMES, A.G., refused a patent. No costs.

Agents, *Thompson & Boulton*; *Abel & Imray*.

GARTHWAITE'S PATENT, 1886, No. 3124.

Opposition—Joint Inventors.

On the 5th March, 1886, *Garthwaite* applied for a patent for "fish biscuits for dogs and food for poultry and game."

The invention consisted in the use of fish cooked and dessicated to keep it from putrefying and ground into a powder convenient to mix with meal or flour, and then made into a paste and baked as biscuits for dogs.

King gave notice of opposition to the grant on the ground that *Garthwaite* had obtained the invention from him (*King*).

The case came on to be heard on evidence of a conflicting character. *Garthwaite* admitted that *King* had enquired of him in Sept., 1885, if he knew how to make a fish food for dogs, and that he (*Garthwaite*) suggested several ways of making such food, but *King* informed him that he had tried all the ways he suggested, but none of them would answer.

On the 8th April, 1886, *King* had applied for a patent No. 4932 for an invention which appeared to be identical with that described by *Garthwaite*, and an examiner reported to the C. G. that the two inventions appeared to him to be the same.

The C. G.—I am not satisfied upon the evidence before me that *Garthwaite* did obtain the whole of the invention from *King* as alleged, but at the same time it is quite clear to my mind that part at least of the invention originated with *King*, and therefore I regard the applicant and the opponent as joint inventors, and both are entitled to equal shares of any benefit which may accrue from the invention.

The C. G. suggested that the best way to carry out his decision would be for *King* to abandon his application, and for his name to be added to the documents filed by *Garthwaite*, and a patent granted to them jointly.

The applicant and opponent subsequently stated to the C. G.

that in their opinion *King's* specification contained further modifications not contemplated or included in *Garthwaite's* specification, and requested the C. G. to issue a patent in respect of *Garthwaite's* application, to them jointly, and to allow *King* to have a patent in respect of his application upon his striking out from his specification all matter covered by *Garthwaite's* specification.

The C. G. said he was unable to accede to this request, because he had decided that the parties were joint inventors, and therefore their interests must be equal. As, however, it was desired that separate patents should be granted upon *Garthwaite* and *King's* respective applications, he had no objection to doing so, but upon condition that each party agreed to assign to the other one half share of and in the respective patents, and to pay one half the necessary fees for maintaining the same in force, and in default of either party paying his half share of the fees the other party to be at liberty to pay the whole of such fees, in which event the whole interest of the patent was to become the property of the party so paying the whole of the fees.

Counsel, *Morton Daniel*.

Agents, *Herbert & Co.; George & Taylor*.

GLOSSOP'S PATENT, 1884, No. 6801.

Appeal—Who Entitled to be heard in Opposition—Decision of C. G. not clearly Wrong.

Application for patent for "Improvements in the valve motion of steam hammers." *Taylor*, the assignee of a patent, 3113, of 1872, opposed on the ground that the invention had been patented on an application of prior date, viz., the said patent of 1872. The patent of 1872 had lapsed, but the opponent had been manufacturing under it for 13 years.

The C. G. allowed the patent to be granted.

Appeal to the L. O.

A preliminary question was raised whether the opponent was entitled to be heard under s. 11 (3).

HERSCHELL, S. G.—I shall hesitate very much before I say that any member of the public can come in and oppose a patent and raise an enquiry and cause an appeal of this sort who has no interest in it, and who simply says, "Do not ask me what my interest is, because I have none, except that I am going to show you that this patent is the same as that." Because that system might be used so as to cause a vast amount of annoyance and expense of a most objectionable character to patentees. I know it was intended to prevent that, and I say I should hesitate very much before I permitted it, and, therefore, I think your case had better be rested not on that ground, but on the special ground that owing to your having had an interest in that very patent, and manufactured under it, you are entitled to be heard.

Appeal dismissed with costs.

HERSCHELL, S. G.—In the present case the opponent purchased a prior patent which he says has anticipated the present invention, and he has been working under it, and he is a manufacturer who has been making machines in accordance with that patent. Although that patent has now become public property, I do not think that I ought to hold, whatever might be my view upon the first point, that he is a person not entitled to be heard.

The question then comes whether the decision of the Comptroller ought to be affirmed. Now I own the case is to my mind by no means free from doubt. I think it is well open to argument, looking at the language at the earlier specification and seeing what must be included in the claim, that the present invention is not an independent invention. But, at the same time, when the matter has been before the Comptroller, and the Comptroller has allowed the grant, it is clear that, on an appeal of this description, the Law Officer ought not to interfere with the decision unless it is clearly established that the decision was wrong. I am not so clearly satisfied that the decision of the Comptroller was wrong as to justify me in reversing that decision and depriving the applicant of his right to the patent. By leaving the decision standing I do not deprive the opponent entirely of his rights, because he will have a right of course to use all that he has used hitherto under the former patent, and if that be a mere mechanical equivalent, if the second patent be not a good one, he will be in no practical danger from the existence of the patent. I quite agree, that if the things were clearly the same, I ought not on that ground to allow the second patent to proceed; but where the matter is in doubt and where the Comptroller has allowed the patent, I think I ought not to disallow the patent and reverse his decision unless the case is a perfectly clear one.

GREEN'S PATENT, 1885, No. 8178.

Patented, but Invention not in Provisional of Prior Patent.

Green applied for a patent for "Improvements in and connected with Fuel Economisers."

Lowcock and *Sykes* opposed the grant upon the grounds that a prior patent, *i.e.*, 2875, of 1885, had been granted to them for parts of the invention claimed by the applicant.

It is not necessary for a description of the respective inventions to be given, as the point for decision was a purely technical one, it being admitted by the applicant that the parts in his specification objected to by the opponents were included in their prior specification, but on behalf of the applicant it was contended that the parts of his invention which the opponents opposed, were not described in their provisional, but were fully described in his provisional, and although no fraud was or could be alleged against the opponents they had included such parts in

their complete, and had thereby extended their invention beyond what they had described in the provisional, to the detriment of the applicant.

The opponents' provisional was left 4th *March*, 1885, and complete 3rd *Dec.*, 1885, but no opposition was entered by *Green* to the sealing of a patent to the opponents.

The applicant's provisional was left 5th *July*, 1885, complete 2nd *April*, 1886.

The opponents' denied that any variation existed between their provisional and complete. The parts alleged by the applicant to be an extension, were modifications or developments of their invention and within the scope of the provisional.

The C. G. decided that it was quite clear that the parts of the applicant's invention objected to by the opponents were described and claimed by them in the specification of their prior patent, No. 2875, 1885, and he refused to seal a patent to the applicant until the claims to and description of those parts had been struck out from the applicant's specification.

Appeal to L. O., dismissed with costs.

WEBSTER, A. G.—It is not possible for me to interfere with the C. G.'s decision in this case. The arguments put forward for the applicant are objections to the opponents' patent. I frequently have to say in giving judgment in these cases that I am not deciding the rights of the parties in any matter, except that which is before me; and in this case the matter before me is whether I can allow the applicant to have a patent for the parts objected to.

Now the opponents' provisional was first in order of time, and therefore they were entitled to have their patent sealed as of the earlier date. It is said that the opponents have included in their complete subject-matter which was not in their provisional.

If that is so, that is an objection to the validity of the opponents' patent which will be available to the applicant or to anybody else in the event of any proceedings being taken; but it is wholly impossible for me on the present application to alter, deal with, or interfere with the specification of the opponents' patent, as allowed. It may be a misfortune, but the applicant is unfortunately in the position in which other applicants have been. It may be that the applicant will thereby lose the benefit of protection for something which he invented. That is a matter which I say again I cannot deal with. I can only deal with the application before me. Now, under s. 11, if an application for a patent is opposed on the ground that the invention has been patented in this country on an application of prior date, the opposition to that extent will be successful if proved. It is not denied that the opponents' patent does include the parts of the applicant's invention objected to. In fact his very fair argument before me is that the appeal is grounded not so much upon the reasons that those parts are not included by the opponents' patent, but that if the opponents' patent stands with its present specification the applicant will not be able to get a patent for those particular parts.

As I have said already, that may be a misfortune which has fallen upon him, but I cannot deal with it.

Counsel, *Henn Collins, Q.C.*
Agents, *Gardner; Newton & Son.*

HATFIELD'S PATENT, 1884, No. 14621.

Practice—Evidence—Appeal.

Application for patent opposed on the ground that applicant had obtained the invention from the opponent.

No evidence was filed by either side within the time allowed by Rules, and the applicant having applied for a hearing, an appointment was made at which both parties attended. The opponent then applied for leave to file declarations in support of his opposition. Leave granted him to do so conditional upon same being filed within one week and £2 2s. 0d. (the costs of the day) being paid to the applicant. Evidence having been filed by both parties a further hearing was appointed before the C. G.

The sole question was one of fact, whether the applicant or the opponent was the true and first inventor. The C. G. decided that owing to the conflicting nature of the evidence filed, and to his not being able to have the declarants cross-examined *visà voce*, he was unable to determine which side was speaking the truth, and he therefore directed a patent to be sealed to the applicant.

Appeal to the L. O.

The same evidence was used as before the C. G., but the respective declarants on both sides had been summoned for cross-examination and several witnesses were examined.

WEBSTER, A. G., suggested that some arrangement should be come to between the parties.

It appeared that the opponent had applied for a patent, but his application had not reached the opposition stage, and it was agreed between the parties that if the opponent withdrew his opposition, the applicant would not oppose the other application. The A. G. would not sanction these terms as L. O., because they might affect the rights of third parties and the rights of the public—he simply adjourned the case to enable the above arrangement to be carried out, saying, that “he thought the arrangement was a proper one to be adopted,” and that in sealing a patent to the applicant it was to be understood that he did not decide in his favour.

No order as to costs.

Agents, *Emmens & Co.; Herbert & Co.*

HEATH & FROST'S PATENT, 1886, No. 5222.

Opposition—Appeal—Person having interest—Costs.

Heath & Frost applied for a patent for “Improvements in blasting cartridges.”

Notice of opposition to the grant was given by *Hardingham*

upon the ground that the invention had been previously patented by *McNab*, 1876, No. 3150.

The applicant's invention related to an improvement in blasting cartridges, and consisted in constructing a cartridge case of strong paper or other suitable material, into the centre of which case the explosive (which might consist of dynamite or other suitable explosive) was placed with a detonator and safety fuse attached, so that it was completely surrounded by and in contact with a specially prepared compound of gelatinous consistence, and thereby was held in position in the centre of the case, and prevented from coming in contact with the sides. When the cartridge was full, a piece of twine was securely tied round its mouth. The gelatinous compound which the applicants preferred to use consisted of ninety-four parts of *water* to four of soap, one of starch, and one of glue melted together. The object of the gelatinous compound was to render water more readily serviceable in combination with cartridges so as to overcome the objection of water leaking from cartridges, or the objection of cartridges being imperfectly filled with water, and to make the cartridge more certain in practice. The instant the flame and heat generated by the firing of the explosive came in contact with the gelatinous compound, it was liquefied and the flame extinguished.

Claim.—The employment in a blasting cartridge of a gelatinous compound completely surrounding the explosive, by the explosion of which it is liquefied whereby all flame or fire is instantly extinguished substantially as and for the purposes hereinbefore described and illustrated.

McNab's specification described various improvements in blasting, including the construction of a mining cartridge in which the explosive was surrounded on its sides, and at one end by water.

Claim. The application and use to and in the mining, blasting, &c., of coal, &c., of water or other liquid in combination with gunpowder or other inflammable explosive agent.

Grant refused unless claim amended.

The C. G.—Owing to the incongruity which, in my opinion, exists between the description and claim of the applicant's specification, I have some difficulty in coming to a decision upon this case. It seems to me, the words "The employment in a blasting cartridge of a gelatinous compound," render the claim too wide and ambiguous when read in conjunction with l. 18 of page 1, where the gelatinous compound is stated to be "specially prepared," and further on in the same page, ll. 29—31, where the component parts and proportions of the ingredients constituting the "specially prepared" compound are described. But in the claim the broad words "a gelatinous compound" may include not only the "specially prepared" compound, but all and every gelatinous compound which now exists or may hereafter exist, and under it, it would be quite possible for a compound of (say) the consistency of glycerine to be employed, as coming under the term "gelatinous compound," and unless the claim be so amended as to put these

points beyond doubt, I cannot, in the face of *McNab's* specification seal a patent upon this application.

The applicant appealed to the L. O., and took a preliminary objection that *Hardingham* was not a person entitled to be heard by the L. O. within the meaning of s. 11 (3).

Hardingham admitted he had no interest whatever in the patent, except as the agent of the patentee. It had been common in opposition cases, for the sake of simplicity, for patent agents acting on behalf of clients, to oppose grants of patents in their own names.

CLARKE, S. G.—It seems to me perfectly clear from the Act that members of the public, as such, are not entitled to be heard in opposition before me. The Act expressly says that it must be “the person giving notice, and being in the opinion of the L. O. entitled to be heard in opposition,” so that besides being a person who gives notice of opposition, you must also be a person who for some reason or other comes within the class of those persons “entitled to be heard.” It appears to me that by s. 11 it is quite clear that the only class of persons who are entitled to be heard in opposition before the L. O., are persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who while they have not patented the invention have yet been the originators of it, from whom the person seeking the patent has obtained it. Therefore, I am sorry I must debar myself from hearing you on the substance of this application, by holding you are not “a person entitled to be heard.”

Hardingham applied for leave to amend the notice of opposition by striking out his own name and substituting that of the grantee of the patent upon which the opposition was founded, as this was the first decision on the point. The whole of the declarations in the case would remain the same. If leave to amend were not granted, it would inflict a great hardship on the prior patentee.

The S. G.—I do not think I can allow an amendment that goes to the substance of the matter in that way, and it appears to me that to grant such an application would leave the matter very much open to the danger against which Lord HERSCHELL when S. G. (in *Glossop's* case), and I now as S. G. desire to guard in the administration of this law. If I were to allow it, I should be setting a bad example. It is a legal point, and I think the objection fatal.

After hearing the applicant the S. G. said, that although he had felt obliged with reluctance to decide that he could not hear the opponent, having regard to that which he considered a valuable rule to be observed, at the same time he had to be satisfied before interfering with the C. G.'s decision, that looking at the substance of it, that decision should be interfered with. The applicant's specification seemed to him to adequately describe and to distinguish a particular mode of making cartridges, and he therefore

should order the patent to be sealed upon the specification without any amendment.

The S. G. declined to make any order as to costs, as he had not had the benefit of hearing Mr. *Hardingham*.

J. C. Graham (instructed by *Abel & Imray*) for applicant.
Opponent, in person.

HOSKINS' PATENT, 1884, No. 8922.

*Appeal—Applicant's invention an improvement upon prior invention—
Specification so to state.*

Hoskins applied for a patent for "Improvements in folding cots and hammock frames," and *Needham* opposed on the ground that the applicant had obtained the invention from him, and that it had been previously patented by the opponent, No. 3332, 1883.

It appeared that the opponent entered into negotiations with a firm, with the view of granting such firm a licence to work his invention, and a specimen cot was taken to them, but this specimen had several alterations in it including the addition of a certain curtain rod and loop, which were not described in opponent's specification. This firm sent the altered cot to another firm (of which the applicant was a member) for the purpose of ascertaining the price at which it could be put in the market.

On April 6, 1884, *Hoskins* sent back a manufactured sample, which was returned to him for alteration, and subsequently again returned by him to the firm on the 29th May, 1884.

On the 13th June in the same year, *Hoskins* applied for this patent.

The opponent alleged that the cot sought to be patented was slightly different in detail, but substantially the same as the invention patented by him in 1883, and that in particular the curtain rod shown and described in the applicant's specification was the opponent's invention, although not described in the specification of his prior patent.

The C. G. decided (1) that the invention had not been previously patented as alleged; and (2) that the applicant did not obtain the invention from the opponent, and directed a patent to be sealed.

The opponent appealed.

HERSCHELL, S. G.—I do not think this patent can be allowed to go, except as an improvement upon the opponent's. It is impossible to shut one's eyes to the fact that this improved cot which *Hoskins* is seeking to patent never would have been seen or heard of but for the fact that he had before him and had been employed to make the cot which *Needham* had patented. He gets that cot, and he finds that there is a cot which has certain advantages. All the elements which are to be found and which are described, as far as I can see, as the essential elements of *Needham's* invention are to be found in what *Hoskins* has produced. Of course the parts differ, and the mode of carrying out the idea differs, but

there is not a single idea to be found in the one that is not to be found in the other arrangement modified. The applicant's may be a very much better way—I do not know anything about that, and I do not say anything about it—I am willing to assume the statement is right, that it is a better way, but it is really doing in every detail precisely the same thing by a modification merely of the means used. Well then it comes to this—Can I allow, not as being an improvement or modification of the prior patent, but as an independent patent, which the person taking it out is entitled to work independently, this apparatus or cot? I am satisfied that I cannot. I am satisfied, moreover, that I should be doing a very cruel kindness to *Hoskins* if I were to allow him the patent upon his present specification, because I am satisfied there is neither any judge nor any jury who would not hold he was infringing *Needham's* patent, and therefore I should not be giving him any advantage if I were to allow the patent to go upon this specification. I should say there is no doubt that the applicant did apply a considerable amount of original thought, and I am quite prepared to believe invention in improving the opponent's and making a better cot. I do not of course say absolutely that it is a better cot, but it may be that it is so, and if so he ought to have the advantage of that—of all the invention that he applied to it—and so far as he has made it better he is entitled to a patent for the improvement.

The appeal will be allowed with costs, but I allow the grant upon condition that *Hoskins* inserts in his complete a statement that his invention is an improvement upon *Needham's*.*

Agents, *Payne & Talbot; Brown.*

HUTH'S PATENT, 1884, No. 1571.

Appeal—Evidence of Fraud—If not filed before Appeal, cannot be filed after—Costs.

Huth applied for a patent for “improvements in the manufacture of compounds of india-rubber, gutta-percha, and like materials.” The invention consisted in combining india-rubber, gutta-percha, or like material with—(1.) A mixture of gums and resins, and with sulphur, the proportions of the gums and resins being adjusted so that the mixture should have a melting point corresponding to the “curing” temperature; or (2.) A mixture of gums and resins previously freed from volatile oils, or such gums and resins separately after being so treated; or (3.) Resins and gums treated as in (2.) and insulite; or (4.) Sulphur and insulite.

The opponent (*Gerner*) alleged that the above invention was

* The following is the statement which was subsequently inserted with the S. G.'s approval:—

“This invention refers to improvements in the description of cots invented by Geo. Hy. Needham, for which invention a Patent, No. 3332, of 1883, has been granted to him, and it consists,” &c.

the same as the invention patented by him, 1882, No. 6232, which consisted in combining "india-rubber, gutta-percha, or any analogous gum" with (*a.*) sulphur and camphor; or (*b.*) farina; or (*c.*) gum kauri or analogous resinous gum, sulphur, and camphor; or (*d.*) the substances mentioned under (*c.*), together with farina.

No evidence was filed, and the C. G. decided that, as the opponent's invention consisted essentially in the combination of camphor, and camphor and certain farinas with india-rubber and the like, whereas in the applicant's specification no claim was made to the employment of camphor, that the opposition could not prevail.

The opponent appealed, and upon the hearing of the appeal (8th Aug. 1884) objection was taken to the peculiar wording of the notice of opposition upon the ground that it imputed fraud, and that as no evidence was tendered in support of such imputation, the opposition could not be entertained.

HERSCHELL, S. G., would not allow any imputation of fraud to be gone into, as there was no evidence filed in support of it, nor would he allow time for evidence as to fraud to be put in. The time for filing evidence had gone by, and as the opponent had not availed himself of the opportunity afforded by the Rules so to do, he could not be allowed to go into the question on appeal. The opposition must be confined to the question whether the applicant's invention had been previously patented as alleged. Eventually the S. G. affirmed the C. G.'s decision and dismissed the appeal with costs.

Agents, *Buckler; Carpmael.*

LANCASTER'S PATENT, 1884, No. 4571.

Opposition may be grounded on a Patent which has expired—Models not Exhibits allowed to be put in to enable Drawings to be better understood.

Application for a patent for "Improvements in pistons and plungers."

The specification described an arrangement of piston packing, in which two split packing rings with bevelled faces internally were pressed outwards and apart by a spiral spring bent round to form a ring, this spring acting on the bevelled face of the rings.

Notice of opposition was given by one *Buckley*, on the ground that he had a patent for the same invention of prior date, *viz.*, 1866, No. 1700, and his specification showed the same arrangement, but in the drawing the ends of the spiral spring were shown united, although the specification stated that this was only a form preferably adopted.

The contention on behalf of the applicant was that as he did not unite the ends of his spring his arrangement was different from the opponent's,

The C. G. held that the arrangements were the same, and refused to seal a patent.

The applicant appealed, and on the hearing of the appeal the applicant produced specimens of his alleged invention for the L. O.'s inspection, and objection was taken to their admission, as they were not exhibits.

GORST, S. G., said that the specimens not being exhibits could not be received as evidence, he would, however, look at them for the purpose of enabling him the better to understand the drawings.

It assisted him very much to see the specimens, but he did not go by them. When he came to determine whether the two inventions were the same he would go by the drawings and specifications.

An objection was taken by the applicant that the opponent had no *locus standi*, owing to the patent upon which the opposition was based, having expired.

GORST, S. G.—It makes no difference whether the patent has expired or not. The Act allows an application for a patent to be opposed on the ground that the invention has been previously patented, and so long as the opponent's invention has been patented—if it were a 100 years ago—it would not make any difference.

Eventually the appeal was dismissed with costs.

Agents, Dutton & Fulton; A. M. & W. Clark.

LUKE'S PATENT, 1885, No. 5156.

Jan. 30, 1886.

Joint Inventors—Fraud.

Samuel Arnold Luke applied for a patent for "Improvements in or applicable to machines for slubbing, roving, spinning, doubling, or winding fibrous materials."

William Tatham gave notice of opposition on the ground that *Luke* had obtained the invention from *Tatham* whilst in his employ and confidence. Evidence was filed on both sides of a very conflicting nature. On the case coming on before the C. G. both parties desired that he should not go into the merits of the case, but should allow a patent to be sealed without prejudice to the opponent's appeal to the L. O. The C. G. allowed this course to be pursued, and an appeal was entered by *Tatham* to the L. O.

The appeal came on before GORST, S. G., who directed the evidence for the opponent to be taken first as the *onus probandi* lay on him, as it was for him to show the fraud. The declarations were read over to the declarants after they had been sworn, they were then asked if they adhered to those statements, and after they had made any corrections they desired, they were then cross examined.

GORST, S. G.—It has not been proved to my satisfaction that *Luke* obtained the whole of the invention, which he seeks to patent, from *Tatham*, but I am at the same time convinced that the applicant is not the sole inventor, but that part, at least, of the merit of the invention is due to *Tatham*. Under these circumstances it appears to me that the justice of the case will be best met by following the principle of the precedent set in *Russell's Patent* by Lord CRANWORTH, vol. i., p. 589, with such modification as the present law requires. I think that *Luke* and *Tatham* should enter into an agreement by which the former should undertake to do all such acts as may be necessary for securing to the latter the full rights of a joint patentee in the invention in question, and the latter should undertake to take no proceedings for revocation of the patent when granted. On the filing of such agreement at the Patent Office, I determine that the grant shall be made, and that each party shall pay his own costs of the appeal to the L. O. In the event of *Luke* refusing to enter into such agreement, I determine that the grant shall not be made, and that *Luke* shall pay the costs of both parties in the appeal to the L. O. In the event of *Tatham* refusing to enter into such agreement I determine that the grant shall be made, and that *Tatham* shall pay the costs of both parties in the appeal to the L. O.

Counsel, *Aston, Q.C.*; *Wallace*.

Agents, *Brewer & Jensen*; *Haseltine, Lake & Co.*

PATERSON'S PATENTS, 1884, No. 15340; 1885, No. 7213.

DUNDON'S PATENT, 1885, No. 6832.

Cross-oppositions on ground of Fraud—Right to Oppose—No Patent Sealed—C. G. no power to direct an Examiner to Report—Considerations which guide the C. G.—Patent for an addition to prior Patent.

These cases were somewhat complicated by reason of the cross oppositions, and in order to prevent confusion in the report of the cases, the facts will be set out chronologically, so far as is material to the points at issue.

Paterson applied for a patent for "improved apparatus for expanding the ends of casks, firkins, or like packages," leaving a provisional (No. 15340) in which was described a firkin expander consisting of segments attached to the ends of arms radiating from a central hub and worked by bevil gearing. 21st Nov. 1884.

Dundon applied for a patent, leaving a provisional (No. 6832) in which he described a firkin expander consisting of a hoop with the ends overlapping, one end being in gear with a toothed wheel worked from the other end. 5th June, 1885.

Paterson applied for a patent, leaving a provisional (No. 7213) in which the invention described by *Dundon* in 6832 was described, but in connection with other improvements. 13th June 1885.

The Examiner reported that it appeared to him to comprise the same invention as 6832.

29th July,
1885.

Paterson filed his complete specification in respect of 15340, and in this specification was included the invention described in *Dundon's* provisional 6832.

Dundon opposed the sealing of a patent to *Paterson* on 15340 upon the ground that the invention had been obtained from *Dundon*.

The evidence filed in the case was of a very conflicting nature on the question whether the one had obtained the invention of the overlapping band from the other, but the grant was not opposed so far as the segmental apparatus described by *Paterson* in his provisional 15340 was concerned.

10th Feb.
1886.

At the hearing of *Dundon's* opposition to the grant of No. 15340 before C. G., the opponent pointed out that not a word was to be found in the provisional about the overlapping band—which *Dundon* had described in his provisional 6832, and he contended that the evidence filed showed that *Paterson* had seen and heard of *Dundon's* invention in the Cork Butter Market, and now sought to include it in his complete.

The applicant contended that *Paterson* was the first and true inventor of the principle of opening firkins by means of an expandible ring, and that although only a segmental apparatus was described in the provisional, *Paterson* was entitled to include in his complete modifications of that arrangement such as the overlapping band—which he contended was shown by the evidence to have been known to him (*Paterson*) at the date of his application.

At the date of the hearing, 10th Feb., 1886, notice of opposition had been given by *Paterson* to the grant of a patent to *Dundon* upon 6832, and that fact being brought to the notice of the C. G., he reserved his decision as to 15340 until the cross opposition had been heard.

12th Jan.
1886.

On the 12th Jan., 1886, *Paterson* filed a notice of opposition to the grant of a patent to *Dundon* on No. 6832 upon the grounds (1) that the invention sought to be patented had been obtained from *Paterson*, and (2) that it was substantially the same or a mere modification of the invention described and claimed in the specification of Letters Patent No. 15340 of 1884. Letters patent had not been granted on 15340, as the C. G. had reserved his decision upon that case until after he had heard the present case: *Paterson* asked the C. G. to direct the Examiner to report that 15340 and 6832 comprised the same invention, and to permit the second ground of opposition to be struck out, and the ground of such report having been made to be substituted.

The C. G. had no objection to allow the notice of opposition to be amended by omitting the second ground, but he had no power (even if he thought it necessary) to direct an Examiner so to report to him. As no patent had been granted in respect of No. 15340, he could not hear an opposition upon the second ground. On the 21st July, 1886, at the hearing of *Paterson's* opposition

to *Dundon's* application 6832 before the C. G., the evidence and arguments were very similar to those adduced in the previous case, and the decision was again reserved; and on the 27th Aug., 1886, the C. G. gave his decisions in both cases.

As to *Paterson's* application 15340, he said:—I have had great difficulty in arriving at a decision upon this case owing to the conflict of testimony and to the various peculiar circumstances connected with the case. In the first place it seems to me that if *Paterson* had really invented the overlapping band machine at the date he was instructing his patent agent (*Thompson*) to apply for a patent for the segmental apparatus, he would certainly have mentioned it to Mr. *Thompson*, so that that gentleman might have decided whether to mention it or not in the provisional.

It is also clear to my mind that *Paterson* could not have instructed *Thompson* to secure the principle of opening firkins as well as the apparatus for so doing, nor could he have hinted at or given any indication whatever to *Thompson* that he thought he was the first to expand a firkin in the manner proposed, for had he done so *Thompson* would have taken care to frame both the title and provisional—so to embrace it—but, on the contrary, both title and provisional only relate to the apparatus.

The evidence filed is very conflicting, and in the absence of cross-examination it is difficult to act upon it, but after careful consideration I incline to accept *Dundon's* evidence, and that of the declarants who have made declarations in his behalf, as being more probable and likely than the evidence given by and on behalf of *Paterson*. Therefore I am of opinion that *Dundon* is the true and first inventor of the overlapping ring apparatus as described in his specification, and that as *Paterson* has included such apparatus in his complete, I require him to so amend it as to confine it to the segmental apparatus only, and when the specification has been so amended to my satisfaction a patent will be sealed upon this application in due course.

As to *Dundon's* application No. 6832 the C. G. said:—I am of opinion that *Dundon* did not obtain his invention, or any part thereof, from *Paterson*, and therefore a patent will be sealed to *Dundon*.

Appeal to L. O. as to No. 15340, but not as to No. 6832. CLARKE, S. G., confirmed the decision of the C. G. *Dundon* had also opposed *Paterson's* application No. 7213 upon the ground of the Examiner's report. The applicant's specification included an overlapping band arrangement as described in 6832, but means for detaching the handle employed for actuating the band, and for retaining it in position when expanded were included in addition, as well as an apparatus for manipulating firkins, and the C. G. decided that *Paterson* was only entitled to have a patent for the special detachable handle he employed for actuating the expanding apparatus, and the means by which the apparatus was retained in position when expanded, and of course for the manipulating apparatus, and he required the claims to be

amended so as to limit them to the special mechanism as above stated; and in view of the fact that that mechanism was especially designed for use with the ring overlapping at the ends, which formed the subject of *Dundon's* patent 6832, he directed *Paterson* to so state in his specification. *Paterson* appealed to the L. O., but *CLARKE, S. G.*, affirmed the C. G.'s decision with costs.

Agents, Thompson & Boulton for Paterson; G. F. Redfern for Dundon.

STUBBS' PATENT, 1884, No. 2100.

Opposition on ground of Prior Patent unsuccessful before C. G.—Appeal—Appeal a Rehearing—Patent not refused unless Inventions Identical—Costs.

The invention related to "improvements in apparatus for removing the dust from carpets or other similar articles," and the opponent alleged that the invention had been previously patented in 1880, No. 5010.

The question depended upon a comparison of the two specifications.

The C. G. allowed the patent. Appeal to L. O.

Appeal dismissed with ten guineas costs to applicant.

WEBSTER, A. G.—As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course I need not remind you that stopping a patent is a very serious step, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical. I shall not hesitate to stop it if I can see clearly they are identical.

I further desire to say that I regard these appeals as rehearings; but it must not be thought that I mean thereby to encourage appeals, because it would not be a right thing to do.

In cases before me where there is no fresh evidence, or where on the merits either the opponent succeeds or the applicant succeeds, I shall, as a general rule, allow costs to follow the event, because I think it only right that, apart from special circumstances, costs should follow the event, but I wish it to be understood that that will not apply to cases where there may be further evidence brought forward, or special matters which ought to influence the judgment of the L. O.

Agents, J. T. King; Thompson & Boulton.

TEAGUE'S PATENT, 1884, No. 15973.

Specification describing but not claiming Prior Invention.

Teague applied for a patent for "improvements in rock drills," and the invention consisted in forming the end of the piston rod of a rock drill (of the percussive class) larger than the piston rod,

but solid therewith and within the enlarged end a conical hole was formed to receive the conical end of the tool or drill. The cylinder cover and the stuffing-box and gland were made in halves, and a wrought iron ring was interposed between the cylinder and the cover to hold an india-rubber cushion. The invention also comprised an arrangement for retaining the cylinder upon the cradle.

For the purpose of showing the application of his invention, *Teague* had described in his specification, and had illustrated in his drawings, a complete rock drill.

Parnell opposed the grant upon the ground that the invention had been patented by him, 1878, No. 629.

The applicant had described and shown on his drawings certain parts of a rock drill which were protected by the opponent's patent, but these parts were not claimed.

The Deputy C. G. (before whom the case was heard) thought that under the circumstances a disclaiming clause should be inserted in the applicant's specification, and reserved his decision for the purpose of enabling the parties to agree upon the form of such clause.

As they could not agree, the Deputy C. G. decided to seal a patent conditional upon the insertion in the applicant's specification of the following clause:—

“I wish it to be understood that I make no claim as to novelty for the particular form of piston and valve herein described and shown, *such piston and valve being merely given as a general illustration of a rock drill of the percussive class in order to clearly show and explain the combination of my invention therewith*, nor do I make any claim to a piston and valve of the particular form shown in the specification of letters patent, No. 629 of 1878; but it will be obvious that my said invention may be equally well combined, if desired, with any form of rock drill of the percussive class other than that shown in the drawings herewith.”

The opponent appealed to the L. O. against this decision on the ground that he was dissatisfied with the clause directed to be inserted by the Deputy C. G., “as the piston and the portways in the valve case and main cylinder of *Teague's* drawings remain the same as before, and they constitute the vital elements of the patent No. 629 of 1878.”

WEBSTER, A. G.—If the opponent will consent to the following disclaiming clause, which is a slight alteration of that directed to be put in by the Deputy C. G. (the A. G. read the disclaiming clause as above, but omitting the words in italics), I will allow the patent to be sealed without any alteration of the drawing and description, but I will allow the opponent to exercise an option as regards that. If he does not consent, I shall direct the patent to be sealed on the specification being altered by the omission of that part of it which describes the shape of the valve port and the part of the drawing which describes the valve and the sides of the piston with its ports. If those parts be omitted, no disclaiming

clause and no reference to the opponent's patent need be put in the applicant's specification. I shall not make *Teague* do both.

In the event of the opponent electing to adopt the latter course, the agents had better meet and agree to the amendment and then submit the same for my approval. If there is any dispute between them I will settle it. I do not think it is a case for costs.

The opponent elected to have the specification amended by the omission of the parts ordered, and the parties agreed upon the form of the amendment, which was approved by the A. G., and a patent was sealed upon the amended specification.

Agents, Myall; De Pass.

WELCH'S PATENT, 1884, 15275.

Opponent's and applicant's patents nearly identical—Disclaiming clause.

Welch applied for a patent for "Improvements in the utilization of a waste product, and in the manufacture of bricks, tiles, and other articles therefrom," and stated in his specification that he ground refuse slate into powder of the required degree of coarseness or fineness, and then "slightly moistened the same with water, but not sufficiently to change its condition as powder." The damped powdered slate was then placed in suitable moulds in a machine and pressed into forms of bricks, tiles, and other articles "in a similar manner to what is known as the 'dust process' in the pottery manufacture," and after its removal from the mould, dried in a similar manner to that adopted by potters in drying their goods preparatory to their being placed in the kiln. The goods when sufficiently dried were then placed in a kiln, and submitted to heat for a considerable period. *Claims*:—(1) The utilization of waste or refuse slate by grinding or disintegrating the same, moistening it, then submitting it to heavy pressure in suitable moulds, and afterwards baking or firing the same substantially as herein described and for the purpose stated. (2) The manufacture of bricks, tiles, and other articles from ground slate, moistened, submitted to heavy pressure in suitable moulds, fired to the biscuit form, then, in some cases dipped into potter's glaze or other suitable colouring material, and afterwards fired or baked substantially as herein described.

Notice of opposition to the grant of the patent was given by *The Patent Slate, Brick and Sanitary Tube Company Limited*, upon the ground that the invention had been previously patented by *Evans*, 1878, No. 431, of which patent the said company were owners. The object of *Evans*' invention was the same as *Welch*'s, i.e., the making use of refuse slate for manufacturing bricks and other articles. *Evans* took the refuse slate and ground it up to a suitable fine state in suitable crushing apparatus—the degree of fineness to which the slate was to be ground depending upon the nature of the article to be made. The ground slate was "then

mixed with a sufficient quantity of water to render it plastic, and the mass then well worked up and moulded into bricks or other articles either by hand or in a suitable machine. The specification further stated:—"The articles when they have been made by hand are placed in a stove or other suitable drying apparatus until sufficiently dry to be placed in a kiln. The machine-made articles will not require drying, but are placed at once in the kiln."

Claim: "Manufacturing bricks, tiles, quarries, pipes, mouldings, and similar articles used for building purposes and also articles usually made in earthenware from slate refuse in the manner above set forth."

The opponents contended that the semi-dry process sought to be patented by the applicant was included in *Evans*' specification. It was not possible to make bricks in a machine except by the semi-dry process, and therefore, they relied upon the words "the machine made articles will not require drying, but are placed at once in a kiln," as clearly showing that *Evans* intended to, and did in fact, include the semi-dry process—it being well known in the trade that if the bricks were moulded by hand, a considerable amount of water would be required, and if moulded by machinery little or no water would be used.

The applicant argued that the words "The machine-made articles will not require drying" in *Evans*' specification were governed by the description which preceded them, "that the ground slate is mixed with a sufficient quantity of water to render it plastic," and that the specification referred to an ordinary plastic clay brick-making machine.

The C. G. not being satisfied that *Evans* described the same process as that sought to be patented, directed a patent to be sealed.

Appeal to the L. O.

At the hearing the opponents offered to withdraw the opposition if the applicant would insert a disclaiming clause; but as the applicant would not accept the clause proposed by the opponents, the case proceeded.

WEBSTER, A. G.—I have had very considerable doubt in this case whether I should allow this patent to go, and my only object in making any observations in confirming the C. G.'s decision is that I wish it to be distinctly understood that I give no opinion as to the validity of the patent.

I think there is some ground for saying that *Evans*' specification may be read in such a way as to include the process which *Welch* has described, but if there is any doubt in the matter, I think it is now the well-recognized practice that the doubt should be given in favour of the sealing of the patent, because if I stop it there is no appeal, whereas if I grant it there is not very much harm done, considering that *Evans*' patent has long been in existence.

The line between plastic on the one hand, and such an amount of moistening as will not go beyond the condition in which bricks

do not require to be dried on the other, seems to me to be a very small dividing line.

Under these circumstances I shall allow the patent to be sealed, but I shall require *Welch* to insert these words in his specification, "I am aware that the utilization of slate *débris* for the manufacture of bricks, tiles, and other articles is not new, and that a process for this purpose is described in the specification of *Thos. Evans*, dated 1st *Feb.*, 1878, No. 431, and I make no claim to the process therein described."

I am aware the applicant objected to those disclaiming words at the end, but I think if the specification is referred to by name it is also right that the natural sequence should follow, that it should be absolutely disclaimed.

I shall allow no costs on either side. I cannot give the opponent his costs, because he sought to stop the patent, and has failed. I do not think this is a case in which the respondent is entitled to have costs from the appellant, because, having regard to *Evans'* specification, I think it would have been wiser if a disclaiming clause had been put in so as to leave no doubt in the minds of the public as to what *Welch's* patent really was for.

Counsel, *Bousfield* ; *Aston*, Q.C.

Agents, *Brewer & Son* ; *Harris & Mills*.

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AMENDMENTS.

CHEESBROUGH'S PATENT, 1878, No. 4847

Amendment—Terms—Articles in Stock.

This was a request for leave to amend the patent mentioned, *ante*, p. 90. It was made by the assignee.

Notice of opposition was given, and the case was heard before the C. G., who gave a leave, subject only to the term, that no action was to be brought for infringements committed prior to 1st Jan., 1884.

The opponents appealed to the L. O. and objected to the omission of the words "and purifying the same" from the title, as making the amendment different from what had been advertised. It appeared that the applicant had not originally by his request proposed to strike out these words.

HERSCHELL, S. G., said the omission of those words made the grant less and not greater. As the retention of those words had been objected to by the opponents before the C. G., and he had struck them out, the opponents could not now object to their omission.

The S. G.'s attention was directed to the condition imposed by the C. G., and a question was raised whether the continued use of lamps made by the opponents prior to that date was protected by the above condition.

HERSCHELL, S. G., was of opinion that the C. G. intended the condition to extend to the continued use of lamps so made.

On behalf of the applicant it was contended that protection should only be given to lamps made and sold prior to 1st Jan., 1884, and not to those in stock after that date.

HERSCHELL, S. G., did not see why lamps made prior to the 1st Jan. and *unsold* should not be protected. If the opponents had been making lamps after notice that the patentee was going to disclaim, there would be a great deal to be said for not protecting lamps in stock. But, supposing before they had any idea of any disclaimer on the part of the patentee, and at a time when the patentee could not have stopped it under his patent, the opponents had made lamps *bond fide*, they would now be left on their hands as useless, and they would be put to expense, so the equity of the thing would seem to be rather in favour of their being protected.

Appeal dismissed with costs, an order being made that an

affidavit should be filed to show how many lamps were in stock undisposed of which had been made prior to the 1st of Jan., 1884.

COCHRANE'S PATENT, 1885, No. 5003.

Amendment—"Substantially Different"—"*Proceedings*" Pending—S. 18 (10)—*Amendment and Opposition Contemporaneous.*

Cochrane applied for a patent for "An improvement in moulds for cooling and discharging slag;" and one *Birkbeck* gave notice of opposition, upon the grounds that the invention had been obtained from him, and that the invention had been previously patented by No. 3812, of 1880.

Subsequent to notice of opposition to the grant, and prior to the hearing of such opposition by the C. G., Cochrane applied under s. 18, for leave to amend his specification, for the reason that "he had been advised that the subject-matter of the invention had been too broadly stated and claimed" therein.

The invention related to that construction of moulds for receiving liquid slag from blast furnaces in which a core was employed for facilitating the cooling, and breaking up of the mass, and according to the improvement, the applicant constructed the core with a "semi-circular, or otherwise rounded shape" on the one side, and of "angular shape" at the other. A core so constructed was shown in the drawings which accompanied the specification.

After describing the advantages of this construction, the specification went on to say, "*Although I prefer to make the part A of a rounded shape, yet it will be evident that it may be of other configuration, so long as the angular or wedge-shape of the part A be retained.*"

Claim.—"Constructing cores for slag-moulds of an angular or wedge shape, whereby they are rendered of increased strength, and are made to operate with a wedging action upon the slag, and to effect the complete discharge thereof substantially as herein described."

By his amendment he sought to omit the words in italics above, and to insert in his claim, after the words "wedge-shape" the words "on the one side, and of rounded shape on the opposite side."

The application for leave to amend was also opposed by *Birkbeck*, upon the grounds:—(1) that the proposed amendment would make the claim of invention substantially different from the invention originally claimed; and (2) that the grant of the patent had been opposed by him, and that the allowance of the amendment sought until after the said opposition had been heard and decided upon would be contrary to law.

Both the opposition to the grant, and the opposition to the amendment, were fixed for hearing before the C. G. on the same

day, and the question arose as to which of the two cases should be heard first. The applicant urged that the amendment should be heard first, on the ground that he thought it probable if the amendment were allowed, the sting would be taken out of the opposition to the grant of the patent. The C. G. took this view, and the amendment case was taken first.

A preliminary objection was taken on behalf of the opponent, that as an opposition had been entered to the grant of the patent, a "legal proceeding" within the meaning of s. 18 (10) was pending, and that therefore the applicant had no right to apply for leave to amend.

The C. G. held that the terms of the sub-section did not relate to "proceedings" before him, but only to "proceedings" in courts of law, after the sealing of a patent.

The C. G. reserved his decision, and postponed the hearing of the opposition to the grant until after the decision as to the amendment was given.

By his decision the C. G. allowed the lines in italics to be struck out, but refused the proposed amendment of the claim, being of opinion that, as in the original claim, the angular or wedge-shaped end only of the mould was claimed, and the proposed amendment would (if allowed) alter the claim, so as to make it claim the entire configuration of the mould, it would make the specification "claim an invention substantially larger than the invention claimed by the original specification."

The applicant appealed. Appeal allowed.

DAVEY, S. G.—It seems to me that if the original specification claims all angular or wedge-shaped slag boxes—and then words are put in which confine it to the angular or wedge-shaped boxes which have a rounded back—the invention is thereby confined to a particular class of slag-box, which was included with a number of other slag boxes in the previous claim.

If you have got a claim for A, B, C, D, E, and F, and you confine it to F, that is a narrower claim than the original, and it is not different, because it is included in the old claim.

The S. G. allowed the specification to be amended as proposed. He directed the opponent to pay 5*l.* 5*s.* costs to the applicant.

Agents, Abel & Imray : Johnson & Co.

CODD'S PATENT, 1870, No. 3070.

Amendment under s. 19—More than one Action Pending—Order of the Court must be obtained in each Action—Practice—Terms.

The patentee had commenced separate actions against A. and B. Subsequent to the commencement of such actions he obtained on 25th March, 1884, an order in respect of the defendant A. only, that he might be at liberty to apply at the Patent Office for leave to disclaim. Application for leave to disclaim was made 3rd April,

1884, but the patentee neglected to file with such application an office copy of the order of the Court as required by r. 55.

The application for leave to amend was opposed by the defendants *A.* and *B.* in the respective actions.

The matter came on for hearing before the C. G., 7th *July*, 1884, when preliminary objections were taken: (1) on behalf of opponent *A.*, that as the order of the Court had not been filed with the application as required by r. 55, it was not competent to the C. G. to allow same to be filed at the hearing; and (2) with respect to opponent *B.*, that as an action for infringement between the applicant and opponent was pending, and the leave of the Court had not been obtained in that action, the C. G. had no power to entertain the application.

The C. G. held, 10th *July*, 1884, that as there were two actions pending at the time of the application for leave to amend, and leave to apply had only been obtained on one of such actions, the applicant's proceedings were irregular *ab initio*, and therefore the application for leave to amend must be dismissed.

Subsequently on 30th *July*, 1884, the patentee again applied for leave to amend, and filed with such application an office copy of the order obtained in respect of defendant *A.* on the 25th *March*, 1884, and also an office copy of an order of the Court as regarded defendant *B.*, which had been obtained since the dismissal of the former application for leave to amend.

Oppositions were again entered by *A.* and *B.* respectively, and the case came on for hearing before the C. G. on the 13th *Oct.*, 1884. A preliminary objection was taken on behalf of *A.* that in the present application no order of the Court existed owing to the order which had been obtained on 25th *March* being exhausted by an application for leave to amend having been made and disposed of; but the C. G. held that such order was not exhausted, as the application for amendment had not been refused upon its merits, but upon a technical point.

The opponents did not object to the proposed disclaimer, but opposed for the purpose of getting terms imposed upon the patentee.

An objection was taken on behalf of the applicant that the opponents had no *locus standi* to oppose, inasmuch as the notices of opposition which were filed within the time (one month from advertisement) allowed by s. 18, were not signed by the opponents at that time as required by r. 49.

The C. G. had, under r. 18, allowed the notices of opposition to be signed by the opponents subsequent to their being accepted by him, but as it appeared to the C. G. that the applicant was not in any way prejudiced by the fact that the notices were not signed when left at the office he over-ruled the objection.

With regard to the terms to be imposed it appeared that with reference to defendant *B.*, it was ordered (*inter alia*) that "in the event of the disclaimer being allowed such amendment by disclaimer shall not be put in evidence at the trial, and that no

evidence of infringement prior to disclaimer shall be given," and that the costs of the application to the Court, and of the application of the plaintiff to the C. G. for leave to amend which was refused, should be the defendant's in any event.

The order in the other action as regards the defendant *A.* simply gave the plaintiff liberty to apply, and the costs of the application to the defendant, and on behalf of this opponent *A.* the C. G. was asked to impose the same terms upon the patentee with respect to this opponent, as were imposed by the Court in respect of the other opponent *B.*, and in both oppositions it was sought to get protection for articles in stock or contracted to be made.

The C. G. decided to allow the specification to be amended upon condition—

(1.) That no proceedings be taken against opponent *A.* in respect of infringements committed prior to 1st Jan., 1884.

(2.) That the applicant pay to opponent *A.* 10*l.* 10*s.* as and for his costs of and incident to his opposition to the abortive application of 10th July, 1884.

No other conditions were imposed.

DART'S PATENT.

Complete filed with more limited Title than Provisional—Practice—Amendment.

In this case provisional protection had been granted for an invention for "improved means for regulating the action of dynamo-electric machines *and motors.*"

Nearly a month before the expiration of the nine months allowed for leaving the complete, the applicants left their complete, in which the title was "improved means for regulating the action of dynamo-electric machines," *i.e.*, differing from the title in the application and provisional specification by the omission of the words "*and motors.*" The C. G. refused to accept this complete with the restricted title, and the applicants were therefore required by him to either make the title in the complete agree with the title in the application and provisional, and to insert in the specification a clause disclaiming that part of the invention relating to motors or to apply under s. 18 upon Form F. bearing a 30*s.* stamp for leave to amend the original title. The agents in the case (*Messrs. Newton & Son*) appealed against this decision to the L. O. and stated that the reason for dropping the words "*and motors*" from the title in the complete was that it had been found that the original title was rather larger than the invention their clients dare claim owing to its having transpired in practice that a portion of the invention which at the date of the application for the patent was thought to be applicable to a certain purpose was not in fact so applicable. Consequently the complete was drawn on narrower lines than the provisional and the necessity arose of narrowing the title accordingly.

WEBSTER, A. G.—The question of the amendment of title is not directly dealt with by any section of the Act. S. 5 (5) provides that a specification, whether provisional or complete, must commence with the title. Under ordinary circumstances this title is intended to be in accordance with the title quoted in the application for Letters Patent. Under s. 7 (1) if the title does not sufficiently indicate the subject-matter of the invention the C. G. may require that the application be amended. In my judgment this section empowers the Comptroller to order an amendment of the title in the application if, in his opinion, the title does not sufficiently indicate the invention described in the provisional specification.

The question, however, in this particular case is—what is the proper course to be adopted where the applicant desires to omit a part of his invention as covered by his original title prior to the time that the complete specification has been accepted by the office.

If the applicant merely desires to omit part of the invention described in the original title and provisional specification, I do not see that any amendment of the title and provisional specification is, of necessity, required, as I think that a proper disclaiming clause might be inserted in the complete indicating that part only of the invention originally covered by the title of the provisional was intended to be claimed, but should the applicant think that some risk to the validity of his patent might be occasioned by such a course being adopted it is open to him to lodge a complete omitting the part desired to be left out, and open to the Patent Office, under the powers of ss. 7 and 9, to permit the original application and provisional to be amended by striking out the part which it is no longer desired to retain.

It must, however, be distinctly understood that such an amendment in the title and provisional ought, in my opinion, to be confined to excision only, and not to amendment or other explanation, and the excision must be such as does not extend the scope of the title.

This being so, I think the refusal of the Patent Office to accept Messrs. *Newton's* specification was, in this case, wrong, and that they should have given the applicants the option either of filing the specification with the original title, and inserting a disclaiming clause;* or if the applicants were unwilling to adopt that course, should, under the powers of ss. 7 and 9, have amended the original title in the application and the provisional specification.

An incidental question having arisen respecting the payment of a fee required by the Patent Office on the application in question,

THE A. G.—The matter is not exactly for me to determine, but

* The C. G. had in fact given the applicants an opportunity of inserting a disclaiming clause, with the original title, as suggested by the A. G., but the fact was not brought to the notice of the A. G. at the hearing.

in the view which I take, viz., that this matter ought to be dealt with under ss. 7 and 9, and not under s. 18, I am of opinion that no fee was properly chargeable as in the case of an application to amend.

GARE'S PATENT, 1882, No. 5229.

[1884. 26 Ch. D. 105.]

Petition by *Thomas Gare*, grantee of letters-patent, dated 2nd Nov., 1882, 5229, to the M. R., praying that various clerical errors in his provisional and in his complete specifications might be corrected. The provisional was left at the Patent Office the 2nd Nov., 1882, and the complete filed on the 2nd May, 1883.

The petition was served on the A. G., who did not appear.

BRETT, M.R.—Held that s. 18 of the Patents Act, 1883 (*supra*, p. 8), did not affect his power to allow amendments in a specification filed under ss. 27 and 28 of the Act of 1852, or which is otherwise to be considered as a record under the authority of the M. R. He further held that so long as the specification is in the Patent Office, and before the patent is sealed the proceedings under s. 18 should be the only proceedings taken by anyone asking for amendment within that section.

Considering the amendments would not in any way alter the meaning of the specifications, he allowed them.

HEARSON'S PATENT.

[1884. 1 O. R. 213.]

Disclaimer in Action—Terms imposed by L. O.

In June, 1883, an action was commenced by the owners of a patent granted to *T. A. Hearson*, 31st March, 1881, No. 1419, for "improvements in reservoir penholders" against the *Grapho Pen Manufacturing Company and Others*, for infringement of the patent. The action was nearly ready for hearing on the 1st Jan., 1884. In March, 1884, the plaintiffs obtained, under s. 19 (*supra*, p. 9), an order from FIELD, J., in Chambers, giving them liberty to apply at the Patent Office for leave to amend the specification of the said patent, and that meantime the trial of the action should be postponed, and that the costs of the application at Chambers and those thrown away (if any), in the event of the amendment being allowed, should be the defendants'.

The plaintiffs then applied to the C. G. for leave to amend, and the defendants opposed.

The C. G. gave the leave asked, and imposed no conditions. The defendants appealed to the L. O.

HERSCHELL, S. G., in the course of the argument, said:—The A. G. and I considered this point some little time ago, and we considered it a matter not without doubt, owing to the wording of

the sections of the Act, but we came to the conclusion on the whole that the C. G. had power to impose conditions, reading sub-sections 3, 4, and 5, in fact taking the whole of the sub-sections of s. 18 together, that he must hear and decide the case, and that the decision of the case did not involve necessarily an absolute refusal or an absolute allowance, but hearing and deciding the case when it was opposed would enable him to impose conditions.

In his judgment, the S. G. said:—FIELD, J., imposed no condition as regards the use of the amended specification in or as regards the proceeding with the pending action. From this order the defendants might have appealed, and in the Court of Appeal they would probably (see p. 207) have obtained an amendment of the order, adding a condition against the use of the disclaimed specification in the action. But they took no such step. Under these circumstances, I do not think it would be right for me to impose any condition relating to the action in addition to those which the Court has thought proper to impose as the terms of allowing an application to amend whilst the action was pending. But it was further urged before me that after the amendment was allowed other actions might be commenced against the opponents by the applicants in respect of infringements prior to the 1st Jan. last, and that I ought to impose as a condition of the amendment that no such actions should be brought. It is not perfectly clear that if such an action was brought, even though it appeared that at the time of the infringement the patent was invalid, and that under the then existing law a right of action could not be acquired by a subsequent disclaimer, the defendants could obtain on that ground any relief from liability in the action.

I have, after consultation with the A. G., arrived at the conclusion that, as a general rule, and apart from exceptional circumstances, it is proper that when desired a condition should be imposed that no action shall be brought or other proceeding taken in respect of any infringement prior to the 1st Jan., 1884. The order in the present case will be without prejudice to any question in the pending action. But I must not be understood as entertaining an opinion different from that expressed in the Court of Appeal (in *Singer v. Stassen*, p. 207), as to the protection afforded to the defendants in the action by s. 113 of the Act.

Order:—Application allowed on condition that the applicants shall not bring any action or take any proceeding in respect of an infringement of the patent prior to the 1st Jan., 1884; this condition to be without prejudice to the pending action or any question arising therein. No costs of the appeal.

HEATH AND FROST'S PATENT, 1885, No. 6039.

Amendment—Patent not Sealed—Disclaiming Main Invention leaving an alternative.

On the 16th May, 1885, Messrs. *Heath* and *Frost* applied for Letters Patent for "An improved method of blasting and shot

firing in mines," leaving a provisional which stated that the object of the invention was the construction of a safety cartridge or charge for the purposes of blasting in mines, &c., especially serviceable wherever inflammable gases were present, as by its employment perfect safety from flame or fire was secured, while at the same time the full force of the explosion was retained.

For the purposes of the invention they used preferably dynamite, a charge of which was enclosed "in a case surrounded by a water-tight cartridge containing water or other extinguishing liquid and sealed up."

The complete specification described the explosive as contained in two cases, an inner and an outer, and water was placed between the two, the inner case being held in a central position. The specification went on to say that when the explosive was as dynamite impervious to water, the inner case could be dispensed with. There were three claims: *Claim 1.* The construction of a simple and practicable water-tight cartridge for blasting purposes in which the explosive substance is entirely surrounded by and in immediate contact with water, substantially as and for the purposes hereinbefore described, set forth, and fully illustrated in the drawings annexed.

On the 30th *March*, 1886, opposition to the grant of the patent was entered by *Settle*, on the ground that the invention had been patented by him, 1882, No. 4945.

On the 12th *June*, 1886, the applicants applied under s. 18 for leave to amend their specification for the following reasons, *i.e.*, "Since the said specification was filed, it has come to our knowledge that blasting cartridges having water surrounding the explosive have been proposed or used, we therefore desire to confine our invention to a simple and cheap construction of water-cartridge, and to render the description thereof clear and precise." By their amendment they proposed to strike out the whole of the specification except that which related to the cartridge without the inner case; to amend claim 1 so as to limit it to such cartridges, and to strike out claims 2 and 3.

Settle also opposed the amendment upon the grounds—

1. That the proposed amendments would make the invention substantially larger or substantially different.
2. That they would make the complete describe and claim an invention not the same or substantially the same as the invention described in the provisional.
3. That the complete as proposed to be altered would describe and claim an invention the same or substantially the same as an invention for which *Settle* had a patent, 1882, No. 4945.

By request of the parties, the opposition to the grant and the opposition to the amendment both came on on the same day, the amendment being taken first.

The C. G. refused to allow the proposed amendments to be made.

By arrangement the hearing of the opposition to the grant then stood over till after an appeal to the L. O.

The appeal came on and was dismissed with costs.

CLARKE, S. G.—I have been anxious to hear this thoroughly threshed out, because on looking at the papers I was interested in it, and it seemed to me it was a question of difficulty. I am of opinion that I ought not to allow the amendments to be made, for in my judgment the specification, assuming it to be amended in the way now proposed, would be substantially different from the original specification.

It appears to me that Mr. *Aston* is right when he says that the disclaimer is disclaiming down to that which is an obvious alternative, and that alternative rests practically upon the part which it is proposed now to leave out. If there had been a patent existing at the time of this specification (not belonging to either of these gentleman but somebody else's patent), for the case and for things that required to be contained in a case, I can hardly imagine that the very obvious expedient of putting a thing which did not want a case at all, in without one would have been supposed by any one to be subject matter for a patent. I feel bound to refuse the amendment, and I therefore dismiss the appeal with costs.

The opposition to the grant then came on before the C. G. It appeared that *Settle* by his specification proposed to insert the explosive in a case, and then surround it completely with water in an outer case. *Claim.* The construction of water-cartridges (substantially as hereinbefore described and illustrated by the drawings annexed) in such manner, that the case containing the explosive charge is completely surrounded on all sides and at both ends by water.

Grant refused.

The C. G.—The first point is whether there is any difference between charging a case with an explosive, and then surrounding such charged case with water, and the dispensing with the case and surrounding the explosive itself with water.

It is quite true as alleged on behalf of the applicants that *Settle* does not in his specification state that he surrounds the explosive itself with water, and that both in the specification and claim he refers to surrounding the case containing the explosive with water, but when regard is had to the object of *Settle's* invention, and to the object of the applicant's alleged invention, it is quite clear that they both have the same object in view, *i.e.*, to completely extinguish the flame arising from the combustion of explosive substances by surrounding the explosive with water, and whether the explosive be contained in a case and the charged case surrounded by water, or the explosive itself be placed in the water—the object remains the same, and is in my opinion, effected by the same means. *Settle's* inner case does not assist the object of his invention, and it seems to me that the proper construction of his claim is to regard it as being for the use of water in a cartridge in

such a manner that the explosive substance (whether the same is contained in a case or not) is completely surrounded by the water. *Settle's* specification shows that he was aware at the date of his patent that cartridges having water at but one end had been used, and that, in my opinion, supports the above construction of the specification by making it clear that his object was to surround the explosive in his cartridge with water in such a manner that when the explosion took place, the flame engendered thereby was immediately extinguished by the water on all sides, and in my opinion that is what *Settle* has patented and what the applicants seek to patent.

As regards the other alleged difference, the mere use of a water-proof bag filled with water in which the explosive is immersed in immediate contact with the water in the manner described in *Heath and Frost's* application, this does not appear to me to constitute a sufficient difference from *Settle's* specification to entitle the applicants to a patent.

Counsel, *Moulton, Q.C., Graham, Aston, Q.C.*
Agents, *Abel & Imray; Day, Davies & Hunt.*

JONES' PATENT.

Amendment before Acceptance.

In this case a complete was filed after a provisional, the full time (nine months) allowed by the Act for so doing being taken advantage of by the applicant. Ten weeks subsequent to the filing of the complete, and prior to its acceptance by the Patent Office, an application was made upon Form F, bearing a 30s. stamp, for leave to amend the complete specification. The C. G. did not require the application for leave to amend and the nature of the amendment to be advertised, as the complete was not accepted, and therefore not open to public inspection at the date of the application for leave to amend.

Certain of the proposed amendments were allowed by the C. G. and others refused under sub-s. 8 of s. 18. An appeal to the L. O. against the refusal to allow the whole of the proposed amendments was entered by the applicant.

At the hearing on appeal, the question as to whether the C. G. was right in refusing certain amendments was not gone into owing to a preliminary question arising as to whether, under the circumstances, any amendment of the specification could be admitted except under s. 18, and consequently as the application to amend had not been advertised, whether *any* amendment could properly be made.

WEBSTER, A. G.—The language of s. 18 of the Act is somewhat obscure; but I am of opinion, having regard to the earlier sections, particularly 7 and 9, that s. 18 was intended to apply to the amendment of specifications after they had become public pro-

perty. Any other amendments must, in my opinion, be dealt with under ss. 7 and 9, and not under s. 18.

Under these circumstances I am of opinion that the fact that the office had not signified its acceptance of the complete specification as lodged is immaterial, and that any proceedings for amendment must be taken in pursuance of s. 18.

Mr. A. J. Boulton appeared on behalf of the appellant.

PIETSCHMANN'S PATENT, 1884, No. 7756.

Application to amend—C. G. cannot give Costs as condition of allowing Amendment.

The invention related to "improvements in barrel organs," and the patentee applied to amend under s. 18 (*supra*, p. 8); the amendments sought to be made were numerous. Opposition was entered to their allowance by one *Ehrlich*.

At the hearing before the C. G. the applicant abandoned a number of the proposed amendments, and did not insist upon their allowance.

The C. G. allowed the remaining amendments, but as it appeared to him that the opponent ought to be compensated for having been brought before him, he only allowed such amendments to be made upon condition that *Pietschmann* paid to *Ehrlich* or his solicitor the sum of £10 10s.

Pietschmann appealed against the imposition of the condition.

WEBSTER, A. G.—This case depends entirely upon the construction which is to be put on the language of s. 18 with regard to the power of the C. G. I adhere to and agree in the decision of my predecessors that the C. G. has, by implication under sub-s. 3, the power of imposing such conditions as the L. O. on appeal could impose. The sole question in this particular case is not whether the powers of the C. G. are limited with reference to the conditions which he can impose, but whether as a condition he can award a sum of money which really is *nomine expensarum*, or to compensate the opponent for the trouble he has had in coming to oppose. Now it has been admitted, and rightly, I think, that the C. G. could not dismiss an application for amendment with costs, and it seems to me that, in that case, the opponent would have succeeded to the full. It would be somewhat of an extraordinary conclusion if, where the opponent has succeeded to the full, the C. G. could not give him anything, either as costs or in the shape of costs, but that where the applicant has partly succeeded, or, in other words, the opponent has only partly succeeded, the C. G. could give him something in the shape of costs. In addition I adopt the argument that the subject of costs with regard to the power of the L. O. is dealt with specifically by s. 38, and is not one of the conditions which the L. O. can control by virtue of the power given to him under sub-s. 7. I desire it to be understood that I do not in any way deal with any case which has

been brought before the C. G. of an opponent having been put to expense on the faith of a patent being invalid, or having any reasonable claim for money compensation in respect of the previous defective condition of the patent. That is a matter which will be inquired into by the C. G. in the same way as by the L. O.; but I am clearly of opinion that if it is once admitted that the claim to the money is not supported on that ground, as has been fairly admitted here, but comes within the definition of expenses, for the short reason which I have given, namely, that if the opponent is wholly successful he cannot get his costs, it seems to me to follow that if partly successful the C. G. has also no power to give him costs. I therefore shall vary the decision of the C. G. with reference to the imposing of the condition of 10 guineas, and I shall give no costs of this appeal.

Counsel, *Bousfield; Larson.*

Agents, *Haseltine, Lake & Co.; J. H. Johnson & Co.*

WESTINGHOUSE'S PATENT, 1874, No. 1540.

Amendment—Terms—Marking articles protected.

This was a request for leave to amend the specification of the patent No. 1540 of 1874, granted for "improvements in apparatus for working brakes and communicating signals on railway trains," by striking out claims 1, 4, and 5.

The request was made the 28th *Oct.* 1884. The patent had been held bad in an action decided in *Dec.* 1883. The application was opposed by various railway companies.

The C. G. on 2nd *March*, 1885, gave leave subject to certain terms.

The opponents appealed to the L. O., and urged that in consequence of the delay they should be protected up to the date of the leave granted. On the other hand it was urged that the applicant who had to sign the request was in America during the early part of 1884.

The applicant had brought an action against the opponents, *The Midland Railway Company*, for infringement, which did not go to trial, but an order was made therein on the 28th *Oct.* 1884, upon the application of the plaintiff, discontinuing the action. The plaintiff withdrew all claims upon the defendants for infringement in respect of apparatus manufactured by them up to 28th *Oct.* 1884, the defendants consenting not to ask for costs.

JAMES, A. G., allowed the amendment as from 2nd *March*, 1885, subject to the following conditions:—

1. That no action for infringement or other proceeding shall be brought or taken by *Westinghouse*, or any person or persons claiming under him, against any or either of the said opponents in respect of any apparatus made in alleged accordance with the said specification and fitted to rolling stock prior to 1st *Jan.* 1884.

2. That each such opponent shall, within six weeks of the date

of this order, furnish to *Westinghouse*, at the office of his solicitors, a full and particular statement of the locomotives and other vehicles belonging to them respectively, which have been fitted with any such apparatus as specified in the last preceding paragraph, and referring to such locomotives and other vehicles by the numbers or other distinguishing marks borne by the same respectively, and setting forth the nature or kind of brake apparatus fitted prior to the said date to each of such locomotives or other vehicles. And that each of the said opponents shall from time to time during the subsistence of the patent give immediate notice to *Westinghouse* as aforesaid of any change in any apparatus so fitted, except mere renewals of parts; and all such statements shall be signed by the proper officer of the opposing companies respectively.

3. Nothing contained in these conditions shall be construed as limiting the scope of the order dated 28th Oct. 1884, made in the action of *Westinghouse v. Midland Railway Company*.

4. That *Westinghouse* shall, within eight weeks from the date hereof, deposit in the patent office an undertaking to accept the amendment upon the conditions above written.

No order as to costs.

PRIVY COUNCIL RULES.

[These Rules were made to regulate procedure under the Act 5 & 6 Will. 4, c. 83. As no Rules have been made under s. 25 (6) of the Act of 1883, these Rules, which form part of the existing procedure and practice in patent matters, regulate the applications under the Act of 1883.]

1. (Applied to confirmation of patents only.)

2. A party intending to apply by petition under s. 4 of the said Act, shall in the advertisements directed to be published by the said section,* give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day *caveats* must be entered; and any person intending to enter a *caveat*, shall enter the same at the Council Office on or before such day so named in the said advertisements; and having entered such *caveat*, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

3. Petitions under s. 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

4. All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of s. 4 of the said Act, and the second of these rules; and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

5. All persons entering *caveats* under s. 4 of the said Act shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

6. All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

7. Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

8. The Registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

9. A party applying for an extension of a patent under s. 4 of the said Act must lodge at the Council Office six printed copies of the specification, and also four copies of the balance-sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in the rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other counsel on behalf of the Crown, against granting any application made under s. 4 of the said Act, in case it shall be thought fit to oppose the same on such behalf.

* The section directed the petitioner to advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resided in case he carried on no such manufacture, or published in the county where he carried on such manufacture or where he lived, in case there shall not be any paper published in such town, that he intended to apply to H. M. in Council for extension.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

Power to appeal to the L. O. is given under ss. 7, 9, 11, 18, but not under ss. 17, 86, 116, and s. 3 of the Act of 1885. Where the C. G., under s. 33, has refused a patent for more than one invention, there have been (see pp. 265—267) appeals to the L. O., but these are to be regarded as references under s. 95. The rules are made under s. 38.

I. When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within 14 days from the date of the decision appealed against file in the Patent Office, a notice of such his intention.

See From T., Fee 4. Patent Rules, 10, 19.

II. Such notice shall state the nature of the decision appealed against and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

See R. 14.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

In cases in which the parties reside abroad the C. G. has extended the time for appealing.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the Comptroller and

the appellant; and, when there has been an opposition before the Comptroller, to the opponent or opponents; and, when the Comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer, shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

See s. 38. When it is desired to obtain an order for the attendance of declarants for cross-examination, a list of such persons must be left with the L. O.'s clerk with a request for an order for their attendance: copies of the request and list should be sent to the other side. The L. O. then requests the attendance of both parties before him with reference to the application, and if satisfied that an order should go, directs that summonses should be issued, which the L. O.'s clerk thereupon issues in due course.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

See note to s. 38, p. 16.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of s. 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

See s. 97.

Revocation.—When it is desired to obtain the A. G.'s authority under s. 26 (4 b), *supra*, p. 12, it is necessary to send the following papers to the Patent Clerk (Mr. James Abbs) at Room 549, Royal Courts of Justice, London:—(1) Memorial to the A. G. asking for his authority, and stating all the circumstances; (2) Statutory declaration verifying the statements in the memorial; (3) Two copies of the proposed petition and of the particulars proposed to be delivered with it under s. 26 (5);

- (4) Certificate of a barrister that the petition is proper to be authorised by the A. G. ;
 (5) Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

The A. G. sometimes gives or refuses his authority *ex parte*. In some cases he directs notice to be given to the patentee and directs the parties to be heard before him.

Seven of these applications have occurred since the new Act. The more important are the following :—

1. The *Haslam Foundry Co.* applied for authority as regards a patent, 1877, No. 1034, of *Bell & Coleman*. Notice was directed to be given to *Bell & Coleman*, as an action for infringement against the applicants was then pending in Scotland. Messrs. *Bell & Coleman* objected that as they were resident in Scotland, the application should have been made to the Lord Advocate. JAMES, A. G., refused to give authority pending the result of the action in Scotland, but gave leave to renew the application if necessary.

2. *Welch* applied for authority as regards *Martin's* patent, 1882, No. 5334. *Welch* was a licensee. Notice was directed to be given to *Martin*. The application was eventually abandoned ; but the parties came before JAMES, A. G., on the question of costs, who said that, after consultation with HERSCHELL, S. G., he had come to the conclusion that he had no power under s. 38 to give costs in these cases.

3. Messrs. *Vickers* applied for authority as regards *Siddell's* patent, 1885, No. 6205. Notice was directed to be given to *Siddell*, and voluminous declarations were filed on both sides. At the hearing before RUSSELL, A. G., the application was directed to stand over generally on *Siddell's* undertaking to bring an action against the applicants within a month ; costs of this application to be by consent costs in that action.

4. *Bayley* applied for authority as to *Walling's* patent, 1879, No. 2886. The applicant was a defendant in *Walling v. Stevens*, *supra*, and this application was made in the interval after the judgment against *Bayley* in the Court below and before the hearing in the C. A. The A. G. directed that *Walling* should have notice, but he did not appear at the hearing. RUSSELL, A. G., granted authority.

5. *Ferranti* applied for authority as regards *Garland & Gibbs'* patent, No. 4362 of 1882. No other proceedings were pending. WEBSTER, A. G., gave authority without directing notice to be given to *Garland & Gibbs*.

6. *King's* trustees applied for authority as regards *Rothwell's* patent, 1880, No. 4420. *King* had been sued by *Rothwell* in the Palatine Court for infringement : such action had, after defence delivered, been abandoned. The trustees carried on *King's* business, with which it was said *Rothwell's* patent interfered. *Rothwell* had made application (which was pending) at the Patent Office for leave to amend. WEBSTER, A. G., gave unconditional authority without directing notice to be given to *Rothwell*.

PATENTS RULES, 1883.

[These Rules purport to be made under s. 101, p. 23, by the Board of Trade, and are signed by the President of the Board. As pointed out in a note to s. 82, there is no definition in the Act of the words "Board of Trade," and their meaning is therefore settled by 24 & 25 Vict. c. 47, s. 65, to be "The Lords of the Committee of Privy Council appointed for the consideration of matters relating to Trade and Foreign Plantations." Cf. 22 Geo. 3, c. 82, ss. 1, 15. Who compose this body, and whether they in fact had any voice in the making of these and the subsequent Rules, are questions which must be left for determination to the time when they are raised by some one who desires to question the validity of the Rules. If they are not validly made, sub-sec. 3 of s. 101 will not, it is apprehended, save them.]

SHORT TITLE.

1. These Rules may be cited as the Patents Rules, 1883.

COMMENCEMENT.

2. These Rules shall come into operation from and immediately after the 31 Dec. 1883.

INTERPRETATION.

3. In the construction of these Rules, any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively.

The definition sections of the Act are ss. 46, 117; and see s. 82.

FEES.

4. The fees to be paid under the above-mentioned Act, in addition to the fees mentioned in the Second Schedule thereto, so far as it relates to patents, shall be those specified in the list of fees in the First Schedule to these Rules.

R. 3 of 1885, p. 335. S. 24. They are paid by stamps impressed on the Forms as obtained. See Fees, *infra*.

FORMS.

5. The Forms A, B, and C in the First Schedule to the said Act shall be altered or amended by the substitution therefor respectively of the Forms A, A1, B, and C in the Second Schedule hereto.

6. (1.) An application for a patent shall be made either in the Form A or the Form A1 set forth in the Second Schedule hereto as the case may be.

- (2.) The Form B in such Schedule of provisional specification and the Form C of complete specification shall respectively be used.

- (3.) The remaining forms set forth in such Schedule may, as far as they are applicable, be used in any proceedings under these rules.

These rules are repealed as from the 14th Aug., 1885.

For Forms now in use, see rr. 4, 5, of 1885, p. 335.

GENERAL.

Hours of
business.

7. The Patent Office shall be open to the public every week day during the hours of ten and four, except on the days and times following :—Christmas Day, Good Friday, the day observed as Her Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Cf. s. 98, r. 75.

Agency.

8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller and all attendances by the applicant upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and if he so require resident in the United Kingdom.

For the general practice on applications, see note to r. 22. For form suggested for agent's authority, see *infra*, p. 338. When the applicant desires to change his agent, the words "and I hereby cancel all previous authorisations" should be inserted in the authorisation to the new agent.

Statement
of address.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this Rule be in the United Kingdom.

This should be on a separate sheet, complying with r. 10, but it may be on the back of the application.

Size, &c.,
of docu-
ments.

10. All documents and copies of documents sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters in the English language upon strong wide ruled paper (on one side only), of a size of 18 inches by 8 inches, leaving a margin of 2 inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

Cf. rr. 28—31.

Exercise of
discre-
tionary
power by
Comp-
troller.
Notice of
hearing.

11. Before exercising any discretionary power given to the Comptroller by the said Act adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

See s. 94, p. 21 ; and r. 15.

Notice by
applicant.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

This can be done by letter ; no fee is payable : see r. 15.

13. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Comptroller may require statement, &c.

The C. G. does not usually require the applicant to be present, but will decide in his absence if he notifies to the C. G. that he does not wish to be heard : and see r. 15.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby.

Decision to be notified to parties.

15. The term "applicant" in Rules 11, 12, and 13 shall include an applicant whose specification bears a title the same as or similar to that of the specification of a prior applicant, and has been reported on by the examiner.

Definition of "applicant."

This rule has never been acted upon : a patent has never been stopped in the provisional stage on the ground that an examiner has made such a report, as would appear to be contemplated by the Act, s. 7 (5), and by these rr. 15, 16. As a fact, the examiner only makes a report after a complete specification has been left in respect of both patents ; and the practice is now for the question to be decided on an opposition by one or other of the parties under s. 11 (1).

16. Such prior and second applicant respectively may attend the hearing of the question whether the invention comprised in both applications is the same, but neither party shall be at liberty to inspect the specification of the other.

Prior and second applicant may attend hearing.

17. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after having obtained from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the Comptroller seven days' notice of his intention to exhibit, publish, or use the invention, as the case may be.

Industrial or International Exhibitions.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the Comptroller a brief description of his invention accompanied, if necessary, by drawing, and such other information as the Comptroller may in each case require.

See s. 39, p. 16, and s. 3 of Act of 1885, p. 33. Form O. Fee 31.

18. Any document for the amending of which no special provision is made by the said Act may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

Power of amendment, &c.

This is an extremely wide power, and it may be contended is *ultra vires* the Board of Trade to confer. No appeal is given from the C. G. to the L. O. It may be convenient, therefore, to deal at length with the power of amendment given by the Act. This rule does not apply to any document for which there is special provision in the Act. The first document, therefore, excepted from this rule is a specification. For by ss. 18—21 there is special provision for the

amendment of complete specifications after acceptance, and every amendment must therefore be made under those sections. Then, again, s. 91 (a) gives the C. G. power to correct a clerical error in an application for a patent, or in connection with an application for a patent (for that seems the proper reading). The words "in connection with" an application are vague, but would probably include all the documents left at the office in connection with the application. It is submitted that the power of the C. G. to correct clerical errors in these documents is limited to the time prior to the acceptance of the complete; after that is accepted, any error, clerical or otherwise, in it must, it is conceived, be corrected under ss. 18—21; see Form P. The C. G. has also power under ss. 7 and 9 to require the application, specification, or drawings to be amended; and, further, by s. 91 (b) he may correct any clerical error in the name, &c., of the registered proprietor. This would seem to imply that the C. G. has no other power to correct the register except by direction under s. 90.

The documents, therefore, to which this rule cannot apply are applications, specifications, and drawings, and the register. For as to all these the C. G. has a limited special jurisdiction.

It appears also (see p. 309) that the powers of the M. R. are not taken away by the Act. He could correct clerical errors in specifications after enrolment. It is difficult to see that any one has power to correct a patent, though amendments of patents are mentioned in s. 23 (1).

Docu-
ments by
post.

19. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

See s. 97.

Affidavits.

20. Affidavits may, except where otherwise prescribed by these Rules, be used as evidence in any proceedings thereunder when sworn to in any of the following ways, viz. :—

- (1.) In the United Kingdom before any person authorised to administer oaths in the Supreme Court of Judicature or before a justice of the peace for the county or place where it is sworn or made.
- (2.) In any place in the British dominions out of the United Kingdom before any court, judge, or justice of the peace or any person authorised to administer oaths there in any court.
- (3.) In any place out of the British dominions before a British minister, or person exercising the functions of a British minister, or a British consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

Statutory
declara-
tions.

21. Where any statutory declaration prescribed by these Rules, or used in any proceedings thereunder, is made out of the United Kingdom, the words, "and by virtue of the Statutory Declarations Act, 1835" must be omitted, and the declaration shall (unless the context otherwise requires) be made in the manner prescribed in Rule 20, subsection (3).

APPLICATION WITH PROVISIONAL OR COMPLETE SPECIFICATION.

22. Applications for a patent sent by prepaid letter through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post. Order of recording applications.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

The Form is now prescribed by r. 4 of 1885, and will be found at p. 338. Fees 1, 3, p. 337. The Form *must* be signed by the applicant, r. 8, *supra*. It is difficult to see how a company could be sole applicant (except on communication, r. 27) : but it could apply in conjunction with the inventor. In the case of application by a company, the form should be signed by the secretary and two directors, and the common seal must be affixed to the document. As to joint applications, see s. 4 and the Act of 1885, s. 5. It will be noticed that this Form differs from the previous one in that it is not a statutory declaration, but only a mere statement on which perjury could not be assigned. This change was introduced in consequence of the Act of 1885, s. 2. One only of a number of joint applicants need be the inventor ; the others may be only interested in the invention and not inventors ; see s. 5 of the Act of 1885.

Before sending in an application consult also ss. 5, 6, 82, 86, 97, 99 ; rr. 8, 9, 19, 28—31.

23. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the Comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly. Application for separate patents by way of amendment.

Every such application shall bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Act and by these Rules, as if every such application had been originally made on that date for one invention only.

This is an endeavour to carry out s. 33. The rule seems to conflict with s. 13, and is possibly *ultra vires*. The Act gives the C. G. no power to refuse an application on this ground except impliedly under s. 33. If the C. G. refuses on this ground, there does not seem to be any power of appeal to the L. O., s. 7 (2) apparently referring only to cases in which the refusal to accept is on the report of the examiner. As a fact, appeals have been heard by the L. O. on the question whether the application was for one or two inventions. These cases lay down useful rules as to what is one invention ; they will be found *ante*, pp. 265—7.

24. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative. Application by representative of deceased inventor.

See s. 34. If the applicant dies before sealing, a patent may be sealed to his legal representative, *i.e.*, his executor or administrator ; s. 12 (3 b). If the applicant dies after provisional and before complete accepted, the practice is for the other stages to be carried out by the executor or administrator in his own name, after producing to the C. G. for his inspection probate of will or letter of administration.

25. On the acceptance of an application with a provisional or complete specification the Comptroller shall give notice thereof to the applicant. Notice and advertise-

ment of
accept-
ance.

cant, and shall advertise such acceptance in the official journal of the Patent Office.

Ss. 7 (4), 10.

Inspection
on accept-
ance of
complete
specifica-
tion.

26. Upon the publication of such advertisement of acceptance in the case of an application with a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

S. 10; Fee 32.

APPLICATION ON COMMUNICATION FROM ABROAD.

Communi-
cation
from
abroad.

27. An application for a patent for an invention communicated from abroad shall be made in the form A1 set forth in the Second Schedule hereto.

When application is made on communication, the communicatee must reside in the U. K. or the Isle of Man. The Form now in use is prescribed by r. 5 (1) of 1885.

SIZES AND METHODS OF PREPARING DRAWINGS ACCOMPANYING PROVISIONAL OR COMPLETE SPECIFICATIONS.

[Rr. 28—31 of the Rr. of 1883 were repealed by Rr. dated 16th Sept., 1886, which latter were substituted for them, and are as follows.]

Drawings
for specifi-
cations.

28. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 31. No drawing or sketch such as requires a special engraving for letter-press should appear in the specification itself.

29. Where drawings accompany the specification, they must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

Require-
ments as
to paper,
&c.
Size of
drawings.

They must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface and good quality,* and where possible without colour or Indian-ink washes.

They must be on sheets of one of the two following sizes (the smaller being preferable), 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be $\frac{1}{2}$ an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

Quality of
ink.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour*

* As the drawings are copied at the Patent Office for publication by the process of photo-lithography, this rule must be *strictly* observed in order that good copies may be made.

of fine and shade lines to be maintained throughout. Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is annexed in illustration of this requirement. Reference figures and letters must be bold, distinct, not less than $\frac{1}{8}$ of an inch in height, and of the character shown in the specimen; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the figure, and connected with the part referred to by a fine line.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c. need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Scale of drawings.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

Drawings to bear name of applicant, &c.

No written description of the invention should appear in the drawings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Restrictions as to wood engravings.

30. A *facsimile* of the original drawings but *without* colour or Indian ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 29, must accompany the originals, and be marked "true copy."

Copies of drawings.

31. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

Provisional drawings used for complete specification.

See s. 2 of the Act of 1886, p. 32.

31*a*. The above rules shall be in force as from the day of the date hereof, and Rules 28, 29, 30, and 31 of the Patents Rules, 1883, shall be and they are hereby repealed without prejudice, nevertheless, to any application now pending. Notwithstanding such repeal the Comptroller shall be at liberty during a period of three months from the date hereof (or in special cases during such further time as the Comptroller may think fit) to accept drawings prepared in accordance with such repealed Rules.

Repeal.

OPPOSITION TO GRANTS OF PATENTS.

32. A notice of opposition to the grant of a patent shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the grant, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

Notice of opposition.

Fee 5; Form D. It *must* be signed by the opponent, but see s. 99. The C. G. may allow it to be signed after delivery under r. 18. R. 8 does not apply in terms to an opponent; but, as a fact, the C. G. permits agents to act for oppo-

nents as for applicants. The opposition must be within 2 months, and this time cannot be extended, ss. 11, 98. Any person may oppose before the C. G., see note s. 11 (3); but care should be taken that the person opposing has interest, so as to be able to appeal to the L. O. if necessary. The grounds of opposition are three, s. 11 (1):—

I. (a.) "That the invention was obtained from opponent;" see r. 40. Unless evidence is filed, it is impossible for the C. G. to entertain opposition on this ground, and the L. O. will not allow evidence to be filed before him, see p. 293.

For cases of opposition on this ground, see pp., 279, 281, 284, 288, 294.

(b.) "That the invention was obtained from a person of whom the opponent is the legal representative," i.e., administrator or executor.

II. That the invention has been patented on a prior application. A prior applicant whose specification has been accepted may probably oppose (s. 15); but that section does not seem to give any other person the right to oppose on the ground that a complete specification for an identical invention has been accepted on an application of prior date, unless an examiner has reported under s. 7 (5) and (6). See as relating to this ground rr. 34, 40. To succeed on this ground it is necessary to show an identical invention described *and* claimed. Unless it has been claimed it has not been patented, and therefore in *Dobson's* patent the C. G. refused to take cognisance of a specification in which the identical machine was described and shown but not claimed. The question being as to identity, mere mechanical or chemical equivalence will not be sufficient. It may be doubted whether it is possible for the C. G. or for the L. O. on appeal to listen to any argument on this ground unless evidence is filed in support of it; see on this point *Betts v. Menzies*, vol. i., p. 50.

III. The report of an examiner; see s. 7 (5) and (6), s. 9 (5), and R. 15.

Copy for applicant. 38. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant.

Particulars of prior patent. 34. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the title, number, and date of the patent granted in such prior application shall be specified in the notice.

See r. 40. An omission will be curable under r. 18 if the C. G. is satisfied it is *per incuriam* and not wilful, subject to costs of the day if the correction necessitates an adjournment at the hearing.

Opponent's evidence. 35. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent shall leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof.

If the time be not sufficient the C. G. can extend it under r. 47. There is no form or fee, but the application should be accompanied if possible by the written consent of the other side, and good reason should be given for the extension, as the application is by no means granted as of course. Models should be made exhibits, for if they are not, the C. G. may, of his own motion, or on objection raised, refuse to permit them to be used, but see p. 294. Statutory declarations cannot be made before a commissioner to administer oaths.

Applicant's evidence. Evidence in reply. 36. Within 14 days from the delivery of such list the applicant shall leave at the Patent Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent shall leave at the Patent Office his statutory declarations in reply, and deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Copies of the declarations mentioned in this and the last preceding

rule may be obtained either from the Patent Office, or from the opposite party.

See note to r. 35. If the declarations in reply do not conform to the condition, they are liable to be ordered to be removed from the file.

37. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application made to him for that purpose. Closing of evidence.

See next rule. The C. G. requires to be satisfied that the further evidence it is desired to leave was not reasonably obtainable, or was not within the knowledge of the party within the previous times allowed by rr. 35, 36.

38. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

39. On the completion of the evidence the Comptroller shall appoint a time for the hearing of the case, and shall give to the parties seven days' notice at the least of such appointment Notice of hearing.

The parties need not necessarily both or either attend before the C. G. If notification is given to the C. G., he will decide the case in their absence; and see Fee 6, Form E.

40. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the title, number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition. Disallowance of opposition in certain cases.

41. The decision of the Comptroller in the case shall be notified by him to the parties. Decision to be notified to parties.

CERTIFICATES OF PAYMENT OR RENEWAL.

42. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to make the prescribed payment for keeping the same in force, he shall seven days at least before such expiration give notice to the Comptroller of such intention, and shall, before the expiration of such fourth or eighth year, as the case may be, leave at the Patent Office a form of certificate of payment, duly stamped, subject as hereinafter provided, with the prescribed fee of 50*l.* or 100*l.*, as the case may be. Payment of fees of 50*l.* and 100*l.* for continuance of patent.

Sa. 17, 24, 98. Form T. Fees 14, 15. See r. 46 as to extension of time.

43. In the case of patents granted before the commencement * of the said Act, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year." As to patents granted before commencement of Act.

* 31 Dec., 1883. S. 3, p. 3, *supra*.

44. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of 50*l.* and 100*l.*, he shall seven days at least before the expiration of the fourth and each succeeding year during the term of Payment of annual fees in lieu

of 50% and 100% the patent, until and inclusive of the 13th year thereof, give notice to the Comptroller of such intention, and shall, before the expiration of such respective periods as aforesaid, leave at the Patent Office a form of certificate of payment, duly stamped with the fee prescribed to be paid at such periods respectively.

See note to r. 42. Fees 16—25.

Certificate of payment. 45. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall give to the patentee a certificate that the prescribed payment has been duly made.

Thereupon entry is made in register, r. 72. Cf. r. 73.

ENLARGEMENT OF TIME.

Enlargement of time for payments. 46. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

No enlargement of time is granted after 3 months; s. 24 (3 a). Form K. Fees 26—28.

In other cases. 47. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

This only applies to the times prescribed by the rules. There is no power to enlarge the times prescribed by the Acts. See also s. 98.

AMENDMENT OF SPECIFICATION.

Request for leave to amend. Advertisement. 48. A request for leave to amend a specification shall be signed by the applicant or patentee, and accompanied by a copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.

See ss. 18—21. Applicant does not include a person whose specification is not accepted, see p. 313. The request is made on Form F., see r. 19. It must be signed by the applicant or patentee. The subsequent proceedings may be carried on by an agent; the authority to such agent should be in writing, and should comply with r. 10, and see note to r. 8. The copy of the specification need not be a MS. one, but should be a Blue book of the specification certified by the C. G. to be a true copy, see r. 76. If the drawings are also to be amended, such amendments should be shown on a *certified* copy of the drawings, but this is not necessary where the only amendment is in reference letters or numbers. It should be noted that under s. 18 (1) reasons must be given, and these, together with the proposed amendments, are advertised. The C. G. usually requires an advertisement in the *Times* and in the leading journal circulating in the trade to which the invention relates, at the cost of the person making the request. It not unfrequently happens that where an amendment is opposed, the applicant

or patentee, to meet the views of the opponent, agrees to make modifications in his amendments. When these are not of large extent the C. G. does not require the application to be advertised again; but in *Bradley's* patent, where they were considerable, the C. G. refused the request, and required it to be made *de novo*.

49. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and shall be signed by him. Such notice shall state his address for service in the United Kingdom. Notice of opposition.

The notice must, by s. 18 (2), be given within one month of the first advertisement, and this time cannot, under any circumstances, be extended, as r. 47 does not apply. It should be on Form G. with Fee 9. It must be signed by the opponent, and care should be taken that he is a person entitled to be heard under s. 18 (4); see note to s. 11 (3). The grounds of opposition to amendment are unlimited.

50. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant or patentee, as the case may be (hereinafter called the applicant). Copy for the applicant.

51. Within 14 days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent shall leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof. Opponent's evidence.

See note to r. 35.

52. Upon such declarations being left, and such list being delivered, the provisions of rr. 36, 37, 38, and 39 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated. Further proceedings.

53. The decision of the Comptroller in the case shall be notified by him to the parties. Decision to be notified to parties.

The C. G. may impose conditions, see pp. 309, 314.

54. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with rr. 10, 28, and 29. Requirements thereon.

55. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office. Leave by order of Court.

See note to s. 19. The C. G. does not impose special terms on a person making a request under an order as regards any opponent who is a party to the proceedings in which the order is made, leaving the Court to deal with the parties before it as it sees fit.

56. Every amendment of a specification shall be forthwith advertised by the Comptroller in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may direct. Advertisement of amendment.

See s. 21.

COMPULSORY LICENSES.

57. A petition to the Board of Trade for an order upon a patentee to grant a license shall show clearly the nature of the petitioner's interest, Petition for com-

pulsory
grant of
licenses.

and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

There has been no application such as this up to the present date, and no unwritten practice has therefore arisen. See s. 22, and note at head of these rules. See Forms H, H 1, Fee 12, and r. 10.

To be
left with
evidence
at Patent
Office.

58. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

See rr. 10, 19.

Directions
as to
further
proceed-
ings,
unless
petition
refused.

59. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the Comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure.

Petition-
er's evi-
dence.

60. If and when a *prima facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Patentee's
evidence.

61. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

The patentee must oppose on Form I., Fee 13; rr. 10, 19.

Evidence
in reply.

62. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the petitioner; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

Further
proceed-
ings.

63. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition.

REGISTER OF PATENTS.

[Ss. 23, 85—93.]

Entry of
grant.

64. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request
for entry
of subse-
quent
proprietor-
ship.

65. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom, and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in

the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

See ss. 85, 87; Form L., Fee 29; rr. 10, 19.

66. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the Comptroller, and in case of a body corporate by their agent, authorised in like manner.

Signature of request.

67. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

Particulars to be stated in request.

68. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall be produced to the Comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

Production of documents of title and other proof.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the Comptroller.

69. There shall also be left with the request an examined copy of the assignment or other document above required to be produced.

Copies for Patent Office.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an examined copy.

70. A body corporate may be registered as proprietor by its corporate name.

Body corporate.

71. Where an order has been made by Her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent or the rectification of the register under s. 90 of the said Act or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Entry of Orders of the Privy Council or of the Court.

See ss. 25, 26; and rr. 10, 19. It is a question under this rule whether, in an action for infringement where the patent has been held invalid, the defendant should not give notice thereof at the office. There does not seem in any case any means of enforcing this rule with effect.

72. Upon the issue of a certificate of payment under r. 45, the Comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

Entry of payment of fees on issue of certificate.

73. If a patentee fails to make any prescribed payment within the

Entry of

failure to
pay fees.

prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of
licenses.

74. An examined copy of every license granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original license shall at the same time be produced and left at the Patent Office if required for further verification.

Form M., Fee 29 ; rr. 10, 19.

Hours of
inspection
of register.

75. The register of patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and at the times following :—

- (a.) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England ; or
- (b.) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office ;
- (c.) Times when the register is required for any purpose of official use.

Certified
copies of
docu-
ments.

76. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

A document to be certified should be left (r. 19) at the Patent Office with Fee 35 and a request (r. 10) that it may be certified.

POWER TO DISPENSE WITH EVIDENCE, &c.

77. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

See s. 99.

REPEAL.

Repeal.

78. All general rules made by the Lord Chancellor, or by any other authority, under the Patent Law Amendment Acts, and in force on the 31 Dec., 1883, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to any application then pending.

Dated the 21 Dec., 1883.

PATENTS RULES, 1885.

(Dated 15th Aug., 1885.)

[These rules, which purport to be made by the Board of Trade under s. 101, *supra*, p. 23 (as to which see note, *supra*, p. 321), were made in consequence of the passing of the Act of 1885, p. 31.]

SHORT TITLE.

1. These Rules may be cited as the Patents Rules, 1885.

COMMENCEMENT.

2. These Rules shall come into operation from and immediately after the 14 Aug., 1885.

FEES.

3. In addition to the fees mentioned in the 2nd Schedule to the principal Act so far as it relates to Patents, and in the list of Fees contained in the 1st Schedule to the Patents Rules, 1883, there shall be paid under the said Act and the Patents, Designs and Trade Marks (Amendment) Act, 1885, the fees specified in the 1st Schedule to these Rules.

See Fees, *infra*. They were Fees 39 and 40.

FORMS.

4. The Forms A, B, and C in the 1st Schedule to the principal Act shall be altered or amended by the substitution therefor respectively of the Forms A, A1, B, and C in the 2nd Schedule hereto.

5. (1.) An application for a Patent containing the declaration mentioned in sub-s. 2 of s. 5 of the principal Act shall be made either in the Form A or the Form A1, set forth in the 2nd Schedule hereto, as the case may be. Application.

Up to the date of these rules application for a patent was made by a statutory declaration. The Act of 1885, s. 2, *supra*, p. 31, altered this, and the present form of application is merely a statement in writing; see Forms A, A1, *infra*, pp. 338, 339.

(2.) The Form B in such Schedule of provisional specification and the Form C of complete specification shall respectively be used. Specification.

See these Forms, *infra*, pp. 340, 341.

(3.) The remaining Forms other than A, A1, B, and C, set forth in the 2nd Schedule to the Patents Rules, 1883, and in the 2nd Schedule

hereto respectively, may, as far as they are applicable, be used in any proceedings under these Rules.

See the various Forms, *infra*, pp. 340—347.

EXTENSION OF TIME.

Extension
of time
for leaving
and accept-
ing com-
plete
specifica-
tion.

6. An application for extension of time for leaving or accepting a complete specification shall be in writing and shall state in detail in what circumstances and upon what grounds such extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as the Comptroller may think necessary.

Power to extend these times is given to the C. G. by s. 3 of the Act of 1885, p. 31. From his refusal there is no appeal to the L. O. The times were fixed by Act of 1883, s. 8, p. 5, for leaving, s. 9 (4), p. 5, for accepting a complete specification. The Forms are U, V, and the Fees 39, 40.

REPEAL.

7. Rr. 5 and 6 of the Patents Rules, 1883, shall be and they are hereby repealed as from the 13 Aug., 1885, without prejudice, nevertheless, to any application then pending.

F E E S.

[These fees are paid by stamps impressed on the Forms as obtained. Forms can be obtained by order at any Money Order Office in the United Kingdom. The fees in the Second Schedule to the Act of 1893 were Fees 1, 2, 3, 14—25. See s. 24. Those in the First Schedule of the Rr. of 1883 were Fees 1—38. See R. 4. Fees 59, 49, were added by the Rr. of 1885, R. 3. The C. G. has no power to remit or reduce these fees.]

LIST OF FEES PAYABLE ON AND IN CONNEXION WITH LETTERS PATENT.

Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection	1	0	0			
2. On filing complete specification	3	0	0			
				4	0	0
or						
3. On filing complete specification with first application				4	0	0
4. On appeal from Comptroller to Law Officer. By appellant				3	0	0
5. On notice of opposition to grant of patent. By opponent				0	10	0
5. On hearing by Comptroller. By applicant and opponent respectively				1	0	0
7. On application to amend specification :—						
Up to sealing. By applicant				1	10	0
After sealing. By patentee				3	0	0
9. On notice of opposition to amendment. By opponent				0	10	0
10. On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
11. On application to amend specification during action or proceeding. By patentee				3	0	0
12. On application to the Board of Trade for a compulsory license. By person applying				5	0	0
13. On opposition to grant of compulsory license. By patentee				5	0	0
14. On certificate of renewal :—						
Before end of 4 years from date of payment				50	0	0
15. Before end of 7 years, or in the case of patents granted under the Patents Act, 1883, before the end of 8 years from date of patent				100	0	0
or in lieu of the fees of £50 and £100, the following annual fees :—						
16. Before the expiration of the 4th year from the date of the patent				10	0	0
17. " " 5th " " " "				10	0	0
18. " " 6th " " " "				10	0	0
19. " " 7th " " " "				10	0	0
20. " " 8th " " " "				15	0	0
21. " " 9th " " " "				15	0	0
22. " " 10th " " " "				20	0	0
23. " " 11th " " " "				20	0	0
24. " " 12th " " " "				20	0	0
25. " " 13th " " " "				20	0	0

* In the case of patents dated prior to 1884, on which £50 fee was paid, the annual fees are :—Before the end of 7th year, £10; of 8th year, £10; of 9th year, £10; of 10th year, £15; of 11th year, £15; of 12th year, £20; of 13th year, £20.

On enlargement of time for payment of renewal fees :—		£	s.	d.
26. Not exceeding 1 month		3	0	0
27. „ 2 months		7	0	0
28. „ 3 months		10	0	0
29. For every entry of an assignment, transmission, agreement, licence or extension of patent		0	10	0
30. For duplicate of letters patent	each	2	0	0
31. On notice to Comptroller of intended exhibition of a patent under section 39		0	10	0
32.* Search or inspection fee	each	0	1	0
33. For office copies	every 100 words (but never less than one shilling)	0	0	4
34. „ of drawings, cost according to agreement.				
35.* For certifying office copies, MSS. or printed	each	0	1	0
36.† On request to Comptroller to correct a clerical error		0	5	0
37.* For certificate of Comptroller under section 96		0	5	0
38. For altering address in register		0	5	0
39. For enlargement of time for filing complete specification not exceeding one month		2	0	0
40. For enlargement of time for acceptance of complete specification—				
Not exceeding 1 month		2	0	0
„ 2 months		4	0	0
„ 3 months		6	0	0

* See note to Form Q. Any person wishing to know at what stage an application for a patent is, or whether any given patent is in force, may get a copy of an extract from the Registers of Applications or Patents containing the desired information on sending a request (rr. 10, 19), with a fee of 1s. to the C. G.

† Fee 36 has been altered, and is now up to sealing, 6s. ; after sealing, £1.

FORMS.

Fee 1, 3.

The Form at present used for Application is settled by the Rr. 4 and 5 of 1885, and is as follows :—

FORM A.

APPLICATION FOR PATENT.

(a) Here insert name and full address and calling of applicant or applicants. (b) Here insert title of invention.

(a) I, do hereby declare that in possession of an invention for (b) that (c) , the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of knowledge and belief; and humbly pray that a patent may be granted to for the said invention.

Dated day of , 188 .

(d)

NOTE.—Where application is made through an agent (Rr. 8 and 9 of Patents Rules, 1883), the authorisation on the back (if used) should be signed by the applicant or applicants.

On the back of the Form as printed is found the following :—

For the convenience of applicants, suggested forms of authorisation to an agent and statement of address respectively are printed below. They are not, however, to be deemed to be binding upon applicants, no particular form of these documents having been prescribed by the Act or Rules.

(I.) Where application is made through an Agent (Rr. 8 and 9 of Rules, 1883).

hereby appoint , of , to act as agent in respect of the within application for a patent, and request that all notices, requisitions, and communications relating thereto may be sent to such agent at the above address.

day of , 188 .

* To be signed by applicant or applicants.

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(2.) Where application is made without an Agent (R. 9 of Rules, 1883).

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to , at , day of , 188 .

† To be signed by applicant or applicants.

The Form given in the First Schedule to the Act of 1883, referred to in s. 5, was as follows :—

FORM OF APPLICATION FOR PATENT.

I, (a) *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, do solemnly and sincerely declare that I am in possession of an invention for (b) "*Improvements in Sewing Machines*;" that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

(a) Here insert name, address, and calling of inventor.

(b) Here insert title of invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(c) *John Smith*.

(c) Signature of inventor.

Declared at *Birmingham*, in the county of *Warwick*, this day of , 188 .

Before me,

(d) *James Adams*,
Justice of the Peace.

(d) Signature and title of the officer before whom the declaration is made.

NOTE.—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act, 1835," must be omitted; and the declaration must be made before a British consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.

The Form in the Act was altered by the Rr. 5, 6, of 1883, which prescribed the following Form :—

APPLICATION FOR PATENT.

(a) , do solemnly and sincerely declare that , in possession of an invention for (b) , that , the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of knowledge and belief; and humbly pray that a patent may be granted for the said invention.

(a) Here insert name, full address, and calling of applicant or applicants.

(b) Here insert title of invention.

(c) Signature of applicant or applicants.

(d) If declared by more than one applicant and at different times or places, insert after "Declared" the words "by the above-named."

(e) Signature and title of the person before whom the declaration is made.

(f) If not required as in note (d), strike out part within brackets.

And make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at (d) , in the , this day of , 18 .

[Declared at (d) , in the , this day of , 18 .
Before me, (e) (f)].

A note was appended identical with the note on the Form given in the Act, *supra*.

There was no form given in the Act of 1883 special to applications on communications from abroad. Such a form was given in the Rr. of 1883. That at present in use is prescribed by the Rr. 4, 5, of 1885, and is as follows :—

FORM A1.

APPLICATION FOR PATENT FOR INVENTIONS COMMUNICATED FROM ABROAD.

I (a), of , in the county of , do hereby declare that I am in possession of an invention for (b), which invention has been communicated to me from abroad by (c), that I claim to be the true and first inventor thereof; and that the same is not in use within this realm by any other person or persons

(a) Here insert name, and full address and calling of applicant.

(b) Here insert title of invention.

(c) Here insert name, address, and calling of communicant.

FORM 1, 8.

to the best of my knowledge and belief; and I humbly pray that a Patent may be granted to me for the said invention.

Dated day of , 188

(d) To be signed by applicant or applicants.

(d)

NOTE.—When application is made through an agent (Rules 8 and 9 of Patents Rules, 1883) the authorization on the back (if used) should be signed by the applicant or applicants.

On the back is given a suggested form of authorisation identical with that on the back of Form A., *vide supra*, p. 338. It is not binding on applicants to use it. The form of application on communication given by the Rr. 5, 6, of 1883, was as follows :—

(a) Here insert name, full address, and calling of applicant.

(b) Here insert title of invention.

(c) Here insert name, address, and calling of communicant.

(d) Signature of applicant.

(e) Signature and title of the officer before whom the declaration is made.

I, (a) , of , in the county of , do solemnly and sincerely declare that I am in possession of an invention for (b) , which invention has been communicated to me from abroad by (c) , that I claim to be the true and first inventor thereof; and that the same is not in use within this realm by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835. .

Declared at , in the county of , this day of , 18 .
Before me,
(e)

A note was appended identical with the note on Form A., as given in 1st Schedule to the Act, *supra*, p. 339.

The Form of Provisional Specification is prescribed by the Rr. 4, 5, of 1885, and is as follows, being identical with that prescribed in Rr. 5, 6, of 1883 (except that in the latter the form ran "declare the nature of said invention," instead of as below :—

To be issued with Form A. or A1.

FORM B.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(a) Here insert title as in declaration.

(b) Here insert name, and full address and calling of applicant or applicants as in declaration.

(c) Here insert short description of invention.

(a) , (b) , do hereby declare the nature of this invention to be as follows :—(c)

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows :—

"Dated this day of , 18 ."

(a) Here insert title as in declaration.

(b) Here insert name, address, and calling of inventor as in declaration.

(c) Here insert short description of invention.

(d) Signature of inventor.

The Form given in the 1st Schedule to the Act was :—

Improvements in Sewing Machines. (a)

I, (b) *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, do hereby declare the nature of my invention for "*Improvements in Sewing Machines*," to be as follows (c) :—

Dated this day of , 18 .

(d) *John Smith.*

NOTE.—No stamp is required on this document

The Form of Complete Specification is prescribed by the Rr. 4, 5, of 1885, and is :

Where provisional specification has been left, quote No. and date.
No. _____
Date _____

FIG 2, 3.

FORM C.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

(a) _____, (b) _____, do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :—
(c) _____

NOTE.—This document must form the commencement of the Complete Specification ; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Complete Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows :—

"Dated this _____ day of _____, 18 ____."

The Form given with the Rr. of 1883, was similar, except that it ran : "do hereby declare the nature of _____ invention for _____ and in what manner."

The Form given in the 1st Schedule to the Act was :—

Improvements in Sewing Machines. (a)

I, (b) *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, do hereby declare the nature of my invention for "*Improvements in Sewing Machines*," and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (c) :—

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I declare that what I claim is (d)

- 1.
- 2.
3. &c.

Dated this _____ day of _____, 18 ____.

(c) *John Smith*.

(a) Here insert title as in declaration.

(b) Here insert name, and full address and calling of applicant or applicants as in declaration.

(c) Here insert full description of invention, which must end with a distinct statement of claim or claims in the following form :—

"Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is :—"

- Here state distinctly the features of novelty claimed.
- 1.
- 2.
- 3.

(a) Here insert title, as in declaration.

(b) Here insert name, address, and calling of inventor, as in declaration.

(c) Here insert full description of invention.

(d) Here state distinctly the features of novelty claimed.

(e) Signature of inventor.

FORM D.

(This is Form given by R. 5 (3) of 1885, being that in the 2nd Schedule of Rules of 1883. Cf. s. 11 ; Rr. 32, 34.)

FORM OF OPPOSITION TO GRANT OF PATENT.

[To be accompanied by an unstamped copy.]

* I _____, hereby give notice of my intention to oppose the grant of Letters Patent upon application No. _____, of _____, applied for by _____, upon the ground† _____.

(Signed)‡ _____.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FIG 5.

* Here state name and full address.

† Here state upon which of the grounds of opposition permitted by s. 11 of the Act the grant is opposed.

‡ Here insert signature of opponent or agent.

FEE 6.

(This Form is given by R. 5 (3) of 1885, being that in the 2nd Schedule to the Rules of 1883. Cf. s. 94.)

FORM E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In Cases of Refusal to Accept, Opposition, or Applications for Amendments, &c.

(a) Here insert address.

SIR,
of (a) , hereby apply to be heard in reference to , and request that I may receive due notice of the day fixed for the hearing.

Sir,
Your obedient Servant,

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

FORM F.

(This Form is given by R. 5 (3) of 1885, being that in the 2nd Schedule to the Rules of 1883. Cf. s. 18 and R. 48.)

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

* Here state name and full address of applicant or patentee.

† Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the letters patent.

* , seeks leave to amend the specification of Letters Patent No. , of 188 , as shown in red ink in the copy of the original specification hereunto annexed . My reasons for making this amendment are as follows†
(Signed) .

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

FORM G.

(This Form is given by R. 5 (3) of 1885, being that in 2nd Schedule to Rules of 1883. Cf. s. 18; R. 49.)

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

[To be accompanied by an unstamped Copy.]

* Here state name and full address of opponent.

† Here state reason of opposition.

* hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. of 188 , for the following reason:†
(Signed)

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

FORM H.

(This Form is that given by R. 5 (3) of 1885, being that in 2nd Schedule to Rules of 1883, s. 22; R. 58.)

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENSE.

[To be accompanied by an unstamped copy.]

* Here state name and full address of applicant.

† Here state name and address of patentee, and number and date of his patent.

* hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a license to me by†
(Signed)

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. See H1.

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

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FORM H1.

(This Form is in the 2nd Schedule to the Rr. of 1883, and is continued by R. 5 (3) of 1885. Cf. s. 22; R. 57.)

FORM OF PETITION FOR COMPULSORY GRANT OF LICENSES.

To the Lords of the Committee of Privy Council for Trade.

The petition of (a) , of , in the county of , being a person interested in the matter of this petition as hereinafter described :—
Sheweth as follows :—

1. A patent dated , No. , was duly granted to , for an invention of (b) .
2. The nature of my interest in the matter of this petition is as follows :—(c) .
3. (d) .

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licenses on reasonable terms (e) . Your petitioner therefore prays that an order may be made by the Board of Trade (f) or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.

(e) Here state the ground or grounds on which relief is claimed in the language of section 22, sub-sections (a), (b), or (c), as the case may be.

(f) Here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

(a) Here insert name, full address, and description.

(b) Here insert title of invention.

(c) Here state fully the nature of petitioner's interest.

(d) Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licenses on reasonable

FORM I.

(This Form was in 2nd Schedule of Rr. of 1883, and is continued by R. 5 (3) of 1885. Cf. s. 22; R. 61.)

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENSE.

* hereby give notice of objection to the application of for the compulsory grant of a License under Patent No. of 188 .
(Signed)

* Here state name and full address.

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

FEES 13.

FORM J.

(This was the Form in 2nd Schedule of Rr. of 1883, and is continued by R. 5 (3) of 1885. Cf. s. 17; Rr. 42—45.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

hereby transmit the fee prescribed for the continuation in force of Patent No. , of 18 , for a further period of .
Name* .
Address .

* Here insert name and full address of patentee or his agent.

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

CERTIFICATE OF PAYMENT OR RENEWAL.

Letters Patent No. , of 188 .
This is to certify that did this day of , 18 , make the prescribed payment of £ in respect of a period of from , and that by virtue of such payment the rights of remain in force.*
Patent Office, London.

FEES
14—25.

* See s. 17 of the Patents Act, 1883.

Seal.

FEES
26-28.

FORM K.

(This Form was in the 2nd Schedule of Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. s. 17; Rr. 46, 47.)

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

SIR, I HEREBY apply for an enlargement of time for month in which to make the payment of £ upon my Patent, No. of 188 .

I am,
Sir,

Your obedient Servant,

(a) Here insert full address to which receipt is to be sent.

(a)
To the Comptroller
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FEES 29.

FORM L.

(This Form was in the 2nd Schedule of Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. ss. 23, 87; Rr. 65, 66, 67.)

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS, AND OF DECLARATIONS IN SUPPORT THEREOF.

(a) Or We.
Here insert name, full address, and description.

(b) My or our.
(c) Or names.
(d) I or We.
(e) Here insert the nature of the claim.

(f) Here give name and address, &c., of Patentee or Patentees.

(g) Here insert title of the invention.

(h) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.

(i) Here insert the nature of the document.

(j) Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an examined copy must be left.

I (a), hereby request that you will enter (b) name (c) in the Register of Patents:—
(d) claim to be entitled (e) of the Patent No. of 188 , granted to (f) for (g) by virtue of (h) . And in proof whereof I transmit the accompanying (i) with an examined copy thereof (j).

I am,
Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM M.

(This Form was in the 2nd Schedule of Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. R. 74.)

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENSE IN THE REGISTER OF PATENTS.

SIR,

I HEREBY transmit an examined copy of a license granted to me by under Patent No. of 188 , as well as the original license for verification, and I have to request that a notification thereof may be entered in the Register.

I am,
Sir,

Your obedient Servant,

FEES 29.

(a) Here insert full address.

(a)
To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

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FORM N.

(This Form was in 2nd Schedule of Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. s. 37.)

APPLICATION FOR DUPLICATE OF PATENT.

Date .

SIR,

I REGRET to have to inform you that the Letters Patent, dated * , No. , granted to for an invention of † , have been ‡ . I beg therefore to apply for the issue of a duplicate of such Letters Patent. §
[Signature of Applicant.]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FEE 30.

* Here insert date, No., name, and full address of Patentee.
† Here insert title of invention.
‡ Here insert the word "destroyed" or "lost," as the case may be.
§ Here state interest possessed by applicant in the Letters Patent.

FORM O.

(This Form was in 2nd Schedule of Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. s. 39; R. 17.)

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

* hereby give notice of my intention to exhibit a of at the Exhibition, which † of 18 , under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

‡ herewith enclose .

(Signed) .

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FEE 31.

* Here state name and full address of applicant.
† State "opened" or "is to open."
‡ Insert brief description of invention, with drawings if necessary.

FORM P.

(This Form was in 2nd Schedule of Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. s. 91; R. 18.)

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

SIR,
I HEREBY request that the following clerical error (a) may be corrected in (b)

Signature
Full Address

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FEE 36.

(a) or errors.
(b) Here state whether in application, specification, or register.

FORM Q.

(This Form was in 2nd Schedule to Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. ss. 88, 89, 96; R. 76. Any person desiring to know the date when the complete specification of any application shall be accepted, or the date when the application to amend any particular specification is left at the Patent Office, may get the information by forwarding to the C. G. a request (see Rr. 10, 19) for such information, with a Form Q. impressed with 5s. stamp. See note to Fee 36.)

FEE 37.

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office,
London,

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

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FEE 38.

FORM R.

(This Form was in 2nd Schedule to Rr. of 1883, and was continued by R. 5 (3) of 1885.)

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

(a) Here state name or names and full address of applicant or applicants.

(b) Here insert full address.

SIR,

(a) , hereby request that address now upon the Register may be altered as follows :—

(b)

Sir,

Your obedient Servant,

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

FEE 29.

FORM S.

(This Form was in 2nd Schedule to Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. R. 71.)

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

(a) Here state name and full address of applicant.

(b) Here state the purport of the order.

(a) hereby transmit an office copy of an Order in Council with reference to (b)

Sir,

Your obedient Servant,

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

FEE 4.

FORM T.

(a) Here insert name and full address of appellant.

(b) Here insert "the decision" or "that part of the decision," as the case may be.

(c) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.

(d) Insert number and year.

(This Form was in 2nd Schedule to Rr. of 1883, and was continued by R. 5 (3) of 1885. Cf. ss. 7, 9; L. O., R. 1.)

' FORM OF APPEAL TO LAW OFFICER.

I, (a) , of (a) , hereby give notice of my intention to appeal to the Law Officer from (b) of the Comptroller of the day of , 188 , whereby he (c) No. (d) of the year 188 (d).

Signature
Date

N.B.—This notice has to be sent to the Comptroller General at the Patent Office, London, W.C., and a copy of same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

FEE 39.

FORM U.

(This Form is given in 2nd Schedule to Rr. of 1885. Cf. Act of 1885, s. 3, p. 31; and R. 6 of 1885.)

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION.

SIR,

hereby apply for extension of time for one month in which to leave a Complete Specification upon application No. , dated .

The circumstances in and grounds upon which this extension is applied for are as follows (a) :—

(a) See rule 6 of Patents Rules, 1885.

Sir,
Your obedient Servant,
(b)

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

(b) To be signed by applicant or applicants or his or their agent.

FORM V.

(This Form is given in 2nd Schedule to Rr. of 1885. Cf. Act of 1885, s. 3, p. 31; and R. 6 of 1885.)

Fee 40.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR ACCEPTANCE OF A COMPLETE SPECIFICATION.

SIR,

hereby apply for extension of time for month for the acceptance of the Complete Specification upon application No. , dated .

The circumstances in and grounds upon which this extension is applied for are as follows (a) :—

Sir,
Your obedient Servant,
(b)

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

(a) See Rule 6 of Patents Rules, 1885.

(b) To be signed by applicant or applicants or his or their agent.



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